Industry Canada

Canadian Intellectual Property Office

Canadian Patent Office

Manual of Patent Office Practice

Ottawa-Hull, Canada
K1A 0C9

March 1998

MANUAL OF PATENT OFFICE PRACTICE

FOREWORD

This Manual of Patent Office Practice has been prepared by the Canadian Patent Office staff in consultation with members of the patent profession. It is intended as a guide to practice under the amended Patent Act and the amended Rules which came into force on October 1, 1996. The present manual will replace previous versions of the Manual of Patent Office Practice with respect to practices for applications filed on or after October 1, 1989. Certain practices which apply only to applications filed prior to October 1, 1989, such as conflict or the restrictions regarding applicable prior art, are not covered by this manual. An older version must therefore be consulted for guidance in those instances.

This manual is to be considered solely as a guide, and should not be quoted as an authority. Authority must be found in the Patent Act, the Patent Rules, and in decisions of the Courts interpreting them.

This manual has been prepared with little benefit of practical experience related to the amended Act and Rules. It will therefore require periodical revisions as experience is gained. Suggestions for improvement or amendment of this document will be welcome. The suggestions should ideally, include draft wording for insertion in the manual and not merely be criticism or comment of the existing text.

All suggestions should be directed to:

Attention: Dave Cillis
Industry Canada
Canadian Patent Office
50 Victoria Street
Place du Portage I
Room 611C
Hull, Quebec K1A 0C9

Tel: 819-997-2816
Fax: 819-994-1989
E-mail:cipo.contact@ic.gc.ca

When any amendment of the text has been made, the amendment will be highlighted under the "What's New" section in the CIPO website http://cipo.gc.ca. The list of chapters which precedes the text of the Manual will indicate the presence of an amended version of that chapter with the appropriate date.

For the present time, the March, 1998 version of The Manual of Patent Office Practice is being made available only in electronic form. Should there be sufficient demand for a paper version to warrant publication, such a publication will be prepared and notification of its availability will be made in the "What's New" area of the CIPO website and in the Canadian Patent Office Record.

Pierre Trépanier
Director, Patent Branch

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CHAPTER 1

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CHAPTER 1
CONTACTING THE PATENT OFFICE

1.01
LOCATION OF THE PATENT OFFICE

The Patent Office is located at Place du Portage I, 50 Victoria Street, Hull, Quebec. The most usual telephone numbers of the Patent Office are:

General information: (819) 997-1936
General information facsimile: (819) 953-7620
Mail room: (819) 997-1727
Finance: (819) 994-4682

1.02
CORRESPONDENCE IN PERSON OR BY MAIL

All mail correspondence[1] for the Commissioner of Patents or for the Patent Office should be addressed to:

The Commissioner of Patents
Canadian Intellectual Property Office
Place du Portage I, 3rd Floor
50 Victoria Street
Hull, Quebec K1A OC9

All such correspondence shall be considered to be received by the Commissioner on the day that it is delivered to the Patent Office, designated Industry Canada Regional Offices or designated courier services where delivery is made during the business hours of those establishments. These designated establishments are[2]:

1. The Registered Mail Service of Canada Post.

2. Industry Canada
   Journal Tower South
   365 Laurier Avenue West
   Ground Floor
   Ottawa, Ontario K1A 0C8
   Tel.: (613) 990-4582

3. Industry Canada
   5 Place Ville-Marie, Suite 700
   Montreal, Quebec H3B 2G2
   Tel.: (514) 496-1797

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[1] For the purposes of subsection 5(2) of the *Patent Rules*

[2] For the purposes of subsections 5(4) and 54(3) of the *Patent Rules*

4. Industry Canada
   151 Yonge Street, 4th Floor
   Toronto, Ontario M5C 2W7
   Tel.: (416) 973-5000

5. Industry Canada
   Canada Place
   9700 Jasper Avenue, Suite 540
   Edmonton, Alberta T5J 4C3
   Tel.: (403) 495-4782

6. Industry Canada
   Library Square
   300 West Georgia Street, Suite 2000
   Vancouver, B.C. V6B 6E1
   Tel.: (604) 666-5000

Changes to these designated establishments will be identified in the *Canadian Patent Office Record*. At each of the above establishments, all correspondence will be date-stamped on receipt during their business hours. This date will serve as the basis for all time related requirements under the *Patent Act* and *Patent Rules*, including filing dates of patent applications.

Correspondence arriving physically at the Patent Office, elsewhere than at the mail receiving unit, is forwarded to the mail receiving unit where it will be then, date-stamped with the date of receipt by the mail receiving unit during the Patent Office business hours. Until it is date-stamped by the mail receiving unit or a designated establishment, correspondence does not have an official date.

1.03
FACSIMILE TRANSMISSIONS

The CPO accepts facsimile transmissions in respect of applications or other correspondence. Facsimile have to be addressed to the Commissioner of Patents using the following numbers[3] (facsimile equipment of the mail receiving unit):

(819) 953-CIPO (953-2476) or
(819) 953-OPIC (953-6742)

1.04
CORRESPONDENCE ELECTRONICALLY TRANSMITTED VIA THE CANADIAN INTELLECTUAL PROPERTY OFFICE (CIPO) WEBSITE

Correspondence addressed to the Commissioner of Patents for filing patent applications

[3] In accordance with section 8.1 of the *Patent Act* and for the purpose of subsections 5(6) and 54(5) of the *Patent Rules*

may be sent electronically via the CIPO website at the following addresses[4]:

https://strategis.ic.gc.ca/patbrev-filing/application/engdoc/ pt_filing_form-e.html
or in French to:
https://strategis.ic.gc.ca/patbrev-filing/application/frndoc/pt_filing_form-f.html

Any other correspondence addressed to the Commissioner of Patents relating to applications and patents (e.g. fee payments, registering documents, requesting national entry of an international application), may be sent electronically via the CIPO website at the following addresses:

https://strategis.ic.gc.ca/patbrev-filing/application/engdoc/pt_correspondence-e.html
or in French to:
https://strategis.ic.gc.ca/patbrev-filing/application/frndoc/pt_correspondence-f.html

The document presentation requirements related to *Patent Rules* 68, 69 and 70 apply to electronically submitted correspondence, including facsimile. The acceptable file format for documents submitted electronically via the CIPO website, such as assignments or specifications are: multi-page TIFF CCITT Group 4, black and white, at 300 DPI or in PDF format. Sequence listings will have to be provided in both a multi-page TIFF or PDF file and in an ASCII file. Documents received electronically that do not meet these requirements will have to be replaced and submitted in an acceptable format.

1.05
DATE OF RECEPTION

In accordance with the above:

- Mail intended for the Patent Office and delivered, during business hours, to CIPO's offices in Hull will be accorded the date of reception by CIPO.
- Mail intended for the Patent Office and delivered, during business hours, to one of Industry Canada's regional offices listed above, will be considered to be received on the date of reception in that office, only if it is also a day on which CIPO's offices in Hull are open. Mail delivered to a regional office on a day when CIPO's offices in Hull are closed will be considered to be received on the next working day for CIPO. If, for example, mail intended for the Patent Office is delivered to Industry Canada's regional office in Toronto on June 24, it will not be considered to be received on June 24 as this is a day on which CIPO's offices in Hull are closed. Mail delivered to regional offices outside of Quebec on June 24 will be considered to be received on the next working day for CIPO.
- Mail intended for the Patent Office and delivered through Canada Post's Registered Mail Service will be considered to be received on the date stamped on the envelope

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[4] In accordance with section 8.1 of the *Patent Act* and for the purpose of subsections 5(6) of the *Patent Rules*

by Canada Post Corporation, if it is also a day on which CIPO's offices in Hull are open. If the date stamp on the Registered Mail is a day when CIPO's offices in Hull are closed, the mail will be considered to be received on the next working day for CIPO.

- Mail intended for the Patent Offices and delivered, by electronic means of transmission, including facsimile, will be considered to be received by the Commissioner on the day that it is transmitted if received before midnight, local time at the Patent Office in Hull. When the Patent Office is closed for business, correspondence received on that day will be considered to be received on the next working day.

1.06
INTERVIEWS

Subject to the conditions imposed by subsection 6(3) of the *Patent Rules*, authorized correspondents, applicants and patent agents may meet with examiners about pending applications. Appointments should be made in advance so the examiner will be available and prepared to discuss the prosecution. Interviews concerning the prosecution of applications, including applications that have received final action, may be requested at any stage of the prosecution, and are conducted by the examiner in charge of the application. Where an agent has been appointed, the agent must be present at the interview or must have given authorization for it. In the case of an interview with a new examiner still under training, other more experienced members of the CPO staff should be asked to assist or should be consulted. Problems that do not concern the examination process are referred to the appropriate section of the Patent Branch.

The Commissioner does not meet with agents or inventors about prosecution problems related to specific applications.

1.07
PUBLICATIONS RELATED TO CANADIAN DOCUMENTS

The Canadian Patent Office Record (CPOR) is published weekly every Tuesday. It contains a list of all the published patent applications and all the patents granted for the week ending with the Tuesday of the publication. It contains also important notices. Copies of the CPOR are available via the CIPO website at the following addresses:

http://strategis.ic.gc.ca/patents/record
or in French at:
http://strategis.ic.gc.ca/brevets/gazette

Copies of the CPOR are also available in public and university libraries in many Canadian cities and towns as well as in the regional offices of Industry Canada.

Copies of Canadian patents and opened applications as filed, can be downloaded in Adobe Acrobat format via the CIPO website at the following address:

http://patents1.ic.gc.ca/intro-e.html
or in French at:
http://patents1.ic.gc.ca/intro-f.html

These copies may also be purchased via the Data and Documentation Services of CIPO via the CIPO website using the Patents Electronic Service Delivery at the following addresses:

http://strategis.ic.gc.ca/patentsorder
or in French at:
http://strategis.ic.gc.ca/brevetscommande

or in person or by mail to:

Data and Documentation Services
Canadian Intellectual Property Office
Industry Canada
Place du Portage I
50 Victoria, Room C231-1
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CHAPTER 2

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CHAPTER 2
OPENING AND INSPECTION OF DOCUMENTS

2.01
INSPECTION OF DOCUMENTS

In accordance with Section 10 of the Patent Act, all applications that have been opened to public inspection, protests when associated with an opened application file and prior art filed pursuant to Section 34.1 of the Patent Act when associated with an opened application file, patents and re-examination files, and all documents associated with any of the above, shall be available for inspection on request in the CPO. This information will also be made available via Techsource at designated Industry Canada Offices across Canada.

A patent application open to public inspection will be called "opened" throughout this Manual. A patent application not opened to inspection by the public will be called "unopened" in this Manual.

2.01.01
Opening of Applications

All patent applications, except those filed prior to October 1, 1989 and documents on file in connection therewith, shall be open to public inspection after the expiration of an eighteen-month confidentiality period (subsection 10(2) of the Patent Act). The confidentiality period is one of

i) eighteen months from the Canadian filing date, or

ii) where a request for priority has been made, eighteen months from the earliest filing date of any previously regularly filed application on which the request is based.

Applications filed under the Patent Cooperation Treaty (PCT) that include a designation for Canada and have not entered the national phase in Canada and documents on file in connection therewith will be available for inspection in the CPO as soon as possible after the expiration of eighteen months from the international filing date or the priority date thereof.

In accordance with subsection 10(2) of the Patent Act, an applicant may make a written request to have an application opened to public inspection before the expiry of the confidentiality period.

An application will not be laid open to public if it has been withdrawn at least two months prior to the expiration of the confidentiality period or a later date if the technical preparations to open the application to public inspection can be stopped (Sections 91, 92

and 145 of the Patent Rules).

A listing of applications opened to public inspection each week will appear in the Canadian Patent Office Record.

PCT applications entering the national phase in Canada after the date of publication by the International Bureau of the World Intellectual Property Organization in English or French will bear, as the laid-open date, the date of publication of the international application. This date will normally be within thirteen days after the expiry of eighteen months from the priority date or filing date of the international application.

2.01.02
Confidentiality of Unopened Applications

Unopened applications are confidential. Sections 10 and 11 of the Patent Act and sections 11, 91 and 92 of the Patent Rules apply. The CPO is required to protect the interest of the applicant by ensuring that only authorized persons are allowed to inspect unopened files. Individuals authorized to see the file by the applicant or the applicant's agent are permitted to do so. Individual persons, not known to the CPO, requesting access to a file must provide evidence that they have the right to see a file. A letter of introduction and authorization from the applicant or the applicant's agent, for example, would suffice. Inventors who have assigned all interest in their invention to others will not have access to the unopened file without authorization from the assignee or agent. If an agent has been appointed and the inventor has retained some interest in the application, the inventor may see the file and discuss the case with the examiner in general terms, but in accordance with subsection 6(3) of the Patent Rules an interview including a detailed discussion of the prosecution is permitted only in the agent's presence or with the agent's consent. An examiner will not discuss matters relating to the prosecution of an application with persons other than the agent or those who have the agent's permission to discuss the application.

2.01.03
Effect of Withdrawal of Priority on Opening to Public Inspection

A request for priority may be withdrawn at any time before a patent is issued. If the applicant withdraws a request for priority before the expiry of the confidentiality period it may be possible to delay the opening of the application to public inspection (subsection 10(4) of the Patent Act). The withdrawal must be made within sixteen months of the filing date of the priority application, or a later date if the technical preparations to open the application to public inspection can be stopped (sections 91 and 145 of the Patent Rules). The application will then be laid open to public inspection at the end of the new confidentiality period (eighteen months from the Canadian filing or eighteen months from the earliest of any other priority date, if more than one priority was claimed).

2.01.04
Legal Implication of Date of Opening to Public Inspection

The opening to public inspection starts the protection period for a patentee in accordance with subsection 55(2) of the Patent Act, provided that the opened application is subsequently issued to patent.

2.02
INFORMATION ON APPLICATIONS

Opened applications for patents may be accessed through use of the INQUIRE/Text database which provides the capability of searching for applications by cover page information, such as by number, the inventor's name or the international patent classification, or alternatively any such document may be located by conducting a word search of the text's subject matter.

2.02.01
Numbering of Applications

Applications for patents filed after October 1,1989 are given unique numbers at filing. This number will be in the two million series of numbers and any patent issuing from such applications will bear the same number. A reissued patent and a reexamined patent will bear the same number as the original patent. Divisional applications are given a number in the two million series but different from the number of the original patent application.

Applications for patents filed prior to October 1, 1989 bear unique numbers. Patents issuing from these applications are given unique numbers in the one million series. Divisional applications arising from such applications will be given numbers that are different from those given the original patent applications. Applications for reissue will also be given unique numbers that are different from their original patent numbers.

2.02.02
Status Information Relating to Applications Identified by Serial Numbers

On payment of the fee set out in Schedule II, item 24, the CPO will indicate whether a Canadian application identified by serial number has issued to patent.

2.03
SEARCHES BY THE PUBLIC

It is a function of the Information Branch to help agents and members of the public in their searches by providing the necessary search tools and explaining their use. Searchers unfamiliar with CPO's classification systems and those searchers requiring further assistance are referred to the Classification Division where classification examiners will recommend a search pattern. In case of any doubt about a search pattern, the classification examiners may suggest that searchers consult examiners in a particular field. Examiners are expected to give such searchers specific directions where to search

in their particular field of technology, but are not expected to carry out these searches themselves.

2.04
OPINIONS ON OPENED APPLICATIONS

The CPO Staff will not express any opinion with respect to the claims of an opened application except on examination of the application, nor will they give any opinion concerning the final scope of those claims. Furthermore, they will not express a view as to whether any proposal presented would infringe the claims of an opened application.

2.04.01
Validity and Interpretation of Patents

Issued patents granted by the CPO are presumed valid under section 43 of the Patent Act until such time as the Courts decide otherwise or the patent is made subject to reissue or re-examination procedures. Employees of the CPO may not comment on the validity of any issued patent, nor may they discuss how claims of any issued patent should be interpreted, or express a view as to whether they would be infringed by any proposal presented. Any member of the public requesting information of this type is advised to seek advice from a registered patent agent or a patent lawyer.

CHAPTER 3

INQUIRIES AND INFORMATION ON PENDING APPLICATIONS

3.01 INQUIRIES BY APPLICANTS
- 3.01.01 Status Inquiries
- 3.01.02 Action Inquiries

3.02 INQUIRIES ON PENDING APPLICATIONS (SECTION 11 OF THE PATENT ACT)
- 3.02.01 Searches Based on Foreign Patents Only
- 3.02.02 How the Search is Conducted

CHAPTER 3
INQUIRIES AND INFORMATION ON PENDING APPLICATIONS

3.01
INQUIRIES BY APPLICANTS

On occasion applicants, authorized correspondence or persons authorized by an applicant or authorized correspondent may wish to inquire about the status of their applications or ask when they will be acted upon. The procedure for handling such inquiries is outlined below.

3.01.01
Status Inquiries

While applicants may inquire by letter about the status of their application, such inquiries should be kept to a minimum. The letter asking for status information should be restricted to the matter of status and not cover other subjects, since it will be stamped to indicate status only and returned to the applicant. If no examination has been requested on the application, the letter is stamped: "EXAMINATION NOT YET REQUESTED". If examination has been requested and the examination process has been started, the letter is either stamped: "UNDER EXAMINATION - NO OUTSTANDING ACTION - APPLICATION IN GOOD STANDING" or "UNDER EXAMINATION - THERE IS AN OUTSTANDING ACTION ON THIS APPLICATION - SEE ( ) MAILED ( )". The letter is initialled by the clerical staff.

When an inquiry is made by an inventor not represented by a patent agent, the CPO does not return the inquiry letter but writes to the inventor, explaining the status of the application.

When it is found that an application is not in good standing (i.e. it is abandoned), the applicant is advised of its present status by letter, and the reason for its abandonment. For example, the applicant will be told that it is abandoned for "failure to reply to the report of...". A letter would also be sent under other special circumstances, for example, if the application is before the courts.

Information about the status of unopened applications is given only to the authorized correspondent for the application, to the applicant or to a person authorized by the authorized correspondent or the applicant to receive the information.

3.01.02
Action Inquiries

Applicants may ask by letter when the next examiner's action may be expected. Normally the applicant's letter will be returned after it has been stamped with the information: "THE EXAMINER EXPECTS TO REACH THIS APPLICATION IN ABOUT ( ) MONTHS". The blank space is filled in by the examiner. In those instances where examination has not yet been requested the applicant will be so informed.

3.02
INQUIRIES ON PENDING APPLICATIONS (SECTION 11 OF THE PATENT ACT)

Under section 11 of the Patent Act information may be given to inquirers as to whether there is filed and pending in Canada an application, opened or unopened, that corresponds in subject matter and is related to a foreign patent by common inventors or applicants. No information is released about Canadian applications of different inventors/applicants directed to the same subject matter, nor is any search made to locate corresponding Canadian patents of the same inventors. However, information is supplied when there is at least one inventor or applicant common to both the foreign patent and a Canadian application.

Since the claims in a pending application may be changed at any time prior to issue, an affirmative reply is given to an inquiry under section 11 when there is a corresponding Canadian application disclosing but not necessarily claiming the invention in the foreign patent. The CPO looks to the description of the application, as it stands at the time of the inquiry. Matter which may have been deleted from the description is not considered.

Requests under section 11 must be made in writing and accompanied by the fee prescribed in Schedule II item 23 of the Patent Rules.

3.02.01
Searches Based on Foreign Patents Only

When an inquirer only makes reference to a foreign patent application or other specification that is not a patent, a search is not carried out under section 11 of the Patent Act. Only foreign patents (including petty patents, utility models and inventors' certificates) may form the basis of an inquiry under section 11. "Design patents" are not included. Therefore, a requester should make certain that a document presented for section 11 search is in fact an issued patent.

3.02.02
How the Search is Conducted

Normally, an inquirer provides the CPO with the number of the foreign patent which includes the name of the inventor and/or the name of the applicant. A search is then made of all Canadian applications filed by the same inventor or by the same applicant.

Failure to indicate the name of the inventor reduces the likelihood of locating a corresponding application. The search covers all pending applications, including allowed applications and applications abandoned for less than 12 months. It also includes reissue applications. Applications filed abroad under the Patent Cooperation Treaty (PCT) and designating Canada will not be included in the search unless they have entered the national phase in Canada. A PCT application designating Canada can enter the national phase in Canada up to 42 months after its international filing date or its priority date, if any (subparagraph 58(3)(b)(ii) of the Patent Rules). In assessing pending Canadian applications, the examiner compares the invention claimed in the foreign patent with what could be claimed in the Canadian application. Thus, where the substance of the foreign patent is disclosed in the application as prior art, the pending application is not considered as being a corresponding application. Nor is a Canadian application considered to correspond to a foreign patent when the latter is a selection or improvement of the invention in the application.

Where the Canadian application discloses at least all of the invention of the patent and disclaims none of the subject matter, even tacitly, then the application is considered to correspond to the foreign patent and the inquirer is advised that an application for the same invention is pending in Canada. When the Canadian application discloses only part of the invention of the foreign patent (although other matter may also be described) the inquirer is advised that there is pending an application for part of the same invention but no further details may be supplied. Otherwise, the applicant is advised that a search of the records has failed to reveal a copending application in the name of the inventor (or applicant) that corresponds in subject matter to the identified foreign patent.

CHAPTER 4

PETITIONS AND APPOINTMENT OF AGENTS OR REPRESENTATIVES

4.01 THE PETITION
- 4.01.01 Amendment to the Petition
- 4.01.02 The Title
- 4.01.03 Public Servants Inventions Act

4.02 APPOINTMENT OF AGENTS
- 4.02.01 Appointment of Associate Agents

4.03 APPOINTMENT OF REPRESENTATIVE

4.04 STATUS OF SMALL ENTITY

4.05 REPRESENTATIVE DRAWING

4.06 JURISPRUDENCE

CHAPTER 4
PETITIONS AND APPOINTMENT OF AGENTS OR REPRESENTATIVES

4.01
THE PETITION

While the abstract, description, claims and drawings of a patent application must be individually, or taken together, wholly in English or wholly in French (subsection 71(3) of the Patent Rules), the petition, assignment and other documents may be in either English or French but do not have to be all in the same language or in the same language as the specification (section 71 of the Patent Rules). The petition is a statutory requirement under section 27(2) of the Patent Act and must follow the format given in Schedule I, Form 3 of the Patent Rules (section 77 of the Patent Rules). The petition must commence on a new page (section 72 of the Patent Rules), must not contain drawings (section 74 of the Patent Rules) and must conform to the specific requirements of document presentation set forth in section 68 of the Patent Rules.

4.01.01
Amendment to the Petition

The CPO will accept amended petitions subject to any other provision in the Patent Act and Patent Rules. No changes may be made to inventors or applicants unless to comply with sections 31, 49 or 50 of the Patent Act. The petition may be amended to correct clerical errors under section 35 of the Patent Rules. The CPO will not require the applicant to submit an amended petition to supply additional or corrected information. Such corrections or additions may be provided in a separate document. The original petition will be retained in the correspondence file of the application.

The requirement in subsection 27(2) of the Patent Act that an application contain a petition does not apply to PCT applications filed under the provisions of the Patent Cooperation Treaty (PCT). These applications are filed with a request in accordance with Article 4 of the PCT.

4.01.02
The Title

In accordance with Form 3, an applicant must include in the petition or the request an appropriate title for the invention described in the application. Under paragraph 80(1)(a) of the Patent Rules, the title must be short and precise. The examiner will requisition an amendment of a title which does not conform to paragraph 80(1)(a) of the Patent Rules.

4.01.03
Public Servants Inventions Act

Under section 4 of the Public Servants Inventions Act, a public servant who makes an invention is required to advise the appropriate Minister of the invention and is required to disclose in any Canadian patent application that the applicant is a public servant. Public servants may not file an application for a patent outside Canada without written ministerial permission.

In the case of an invention by a public servant, the petition for patent must indicate that the inventor is a public servant.

4.02
APPOINTMENT OF AGENTS

Individual inventors may prosecute their own applications provided they have retained some interest in the invention. This does not extend to successors in title. However, an inventor may chose to be represented by a patent agent whose name appears on the register of patent agents which permits the agent to act on behalf of the inventor. Whenever all rights have been assigned and the assignment has been recorded in the CPO, an application must be prosecuted by a registered patent agent (see sections 20, 21, 22, 23 and 24 of the Patent Rules).

A patent agent may be appointed in the petition itself or separately by submitting to the Commissioner of Patents, a notice signed by the applicant (subsection 20(2) of the Patent Rules). The appointment must clearly identify the application to which it refers and the application serial number should be given, if known. When a change is made in the appointment of an agent, a notice signed by the applicant or agent must be submitted (subsection 20(3) of the Patent Rules, see also sections 23, 24 and 40 of the Patent Rules).

4.02.01
Appointment of Associate Agents

An agent who does not reside in Canada cannot prosecute applications directly, but must appoint an associate agent who is a resident of Canada (subsection 21(1) of the Patent Rules). An agent who resides in Canada may also appoint an associate agent provided the associate agent has a Canadian residence (subsection 21(2) of the Patent Rules). Changes in the appointment of agents and associate agents may be effected by the applicant, the agent or associate agent (subsections 6(2), 20(3) and 21(4) of the Patent Rules.

4.03
APPOINTMENT OF REPRESENTATIVE

An applicant who is the inventor and who does not appear to reside or carry on business at a specified address in Canada shall, on the filing date of the application appoint as a representative a person who resides or carries on business at a specified address in Canada (subsection 29(1) of the Patent Act). The appointee is deemed to be the representative of the applicant for all purposes of the Patent Act (subsection 29(2) of the Patent Act). However, correspondence from the Patent Office is not sent to the representative but directly to the inventor at the foreign address of the inventor. This includes examiner's reports, correspondence from the Commissioner and the patent grant. A representative may be appointed either in the petition (Schedule I, Form 3 of the Patent Rules) or by means of a separate document (section 78 of the Patent Rules). If applicant fails to appoint a representative, the application will be considered incomplete (paragraph 94(1)(i) of the Patent Rules).

A new representative may be appointed by the applicant or patentee at any time and must be appointed where requested by the Commissioner of Patents in accordance with section 29(3) of the Patent Act.

4.04
STATUS AS SMALL ENTITY

Individual inventors, small businesses and universities may be entitled to reduced fees for filing applications for patents provided that the criteria defining a "small entity" in Section 2 of the Patent Rules are met. Any applicant who desires to claim small entity status must so indicate in the request for obtaining a patent or in paragraph 7 of the formal petition, if one is filed.

4.05
REPRESENTATIVE DRAWING

A single figure of the drawings is selected by the applicant or alternatively by an officer in the CPO to be representative of the drawings illustrating an invention. It is intended that an appropriately reduced version of this figure will be illustrated on the cover page of the opened patent application and the cover page of any patent which may issue from the application. The purpose of this drawing is to assist anyone searching the Canadian patent literature. The applicant is requested to identify what is considered to be the figure most representative of the invention in paragraph 7 of the formal petition.

4.06
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

petition

Beloit v Valmet	78 CPR (2d)	1	1984
Speery v John Deere	82 CPR (2d)	1	1984
Rothmans, Benson and Hedges	35 CPR (3d)	417	1991
Mobil Oil v Hercules	63 CPR (3d)	473	1995
	57 CPR (3d)	488	1994

assignment

Speery v John Deere	82 CPR (2d)	1	1984
Signalisation v Services	46 CPR (3d)	199	1992
Procter Gamble v Kimberly	40 CPR (3d)	1	1991
Positive Seal v M&I Heat	33 CPR (3d)	417	1991
Signalisation v Services	46 CPR (3d)	199	1992
Forget v Specialty	62 CPR (3d)	537	1995
	48 CPR (3d)	323	1993

license

Marchand v Peloquin	45 CPR (2d)	45	1978
Lubrizol v Imperial Oil	33 CPR (3d)	11	1990
	45 CPR (3d)	449	1992
Positive Seal v M&I Heat	33 CPR (3d)	417	1991
Signalisation v Services	46 CPR (3d)	199	1992
Forget v Specialty	48 CPR (3d)	323	1993
	62 CPR (3d)	537	1995

CHAPTER 5

FILING AND COMPLETION REQUIREMENTS

5.00 SCOPE OF CHAPTER
5.01 FILING OF APPLICATIONS
5.02 REQUIREMENTS FOR A FILING DATE
5.03 COMPLETING THE APPLICATION
5.03.01 Completing Applications Filed Prior to October 1, 1996
5.04 JURISPRUDENCE

CHAPTER 5
FILING AND COMPLETION REQUIREMENTS

5.00
SCOPE OF CHAPTER

This chapter applies to applications other than PCT national phase applications.

For applications filed under the provisions of the Patent Cooperation Treaty (PCT), see Chapter 22 of this Manual.

5.01
FILING OF APPLICATIONS

An application for a patent shall be addressed to "The Commissioner of Patents" and shall be considered to be received by the Commissioner (i.e. filed) on the day that it is delivered to the Canadian Patent Office or to an establishment that is designated by the Commissioner in the *Canadian Patent Office Record* as an establishment to which correspondence addressed to the Commissioner may be delivered.

5.02
REQUIREMENTS FOR A FILING DATE

To obtain a filing date under subsection 28(1) of the Patent Act an application must conform to the requirements of Section 93 of the Patent Rules. It must include:

(a) an indication in English or French that the granting of a Canadian patent is sought;

(b) the name of the applicant;

(c) the address of the applicant or of a patent agent of the applicant;

(d) a document, in English or French, that on its face appears to describe an invention; and

(e) the application fee referred to in subsection 27(2) of the Patent Act and set out in Item 1 of Schedule II of the Patent Rules.

5.03
COMPLETING THE APPLICATION

Subsection 27(2) of the Patent Act requires that an application be filed in accordance with the Regulations. Section 93 of the Patent Rules specifies the items required to be given a filing date. However, section 94 of the Patent Rules provides that even though an application has been given a filing date under section 93 of the Patent Rules it is incomplete unless it meets the requirements of sections 68, 69, 70 and subsection 94(1) of the Patent Rules at the time of filing.

Sections 68, 69 and 70 of the Patent Rules set forth the requirements for the presentation of documents and include items such as paper size, margins, line spacing and text character size.

Subsection 94(1) of the Patent Rules requires that certain information and documents, if not supplied at the time of filing, be supplied in order to complete the application. The information and documents required are as follows:

(a) a petition complying with section 77 of the Patent Rules;

(b) an abstract;

(c) a sequence listing, where required by paragraph 111(a) of the Patent Rules;

(d) a copy of a sequence listing in computer readable form, where required by paragraph 111(b) of the Patent Rules;

(e) a claim or claims;

(f) any drawing referred to in the description;

(g) an appointment of a patent agent, where required by section 20 of the Patent Rules;

(h) an appointment of an associate patent agent, where required by section 21 of the Patent Rules;

(i) an appointment of a representative, where required by section 29 of the Patent Act.

In all cases of incomplete applications, the office will make every effort to inform the applicant of the reasons for noncompliance by means of a courtesy letter. The letter will specify a time limit prior to which the application can be completed free. The time limit will be a date fifteen months from the filing date, or from the date of the earliest previously regularly filed application on which a request for priority is based, if any. The purpose of not requiring a fee for completing an application during the above period is to encourage applicants to provide the CPO with electronically scannable pages for TECHSOURCE and to ensure that all documents listed in (a) to (i) in the previous paragraph arrive at the CPO in a timely manner for laying open to public inspection under section 10 of the Patent Act.

If at the expiration of a time period of fifteen months from the filing date, or the priority date, if any, the application is still not complete, a Commissioner's Notice will be sent under subsection 94(1) of the Patent Rules. The Notice will requisition the applicant to complete the application within a period ending the later of three months after the date of the notice and twelve months after the filing date of the application. Completing the application after the notice has been received will require the payment of the completion fee specified in Item 2 of Schedule II of the Patent Rules. Failure to complete the application or to pay the fee within the time period specified in the notice will result in abandonment of the application.

5.03.01
Completing Applications Filed Prior to October 1, 1996

Section 148 of the Patent Rules specifies that where an application other than a PCT national phase application did not, on the filing date of the application, contain the information and documents listed below, the application shall, for the purposes of section 73(2) of the Patent Act, be deemed to be abandoned if, after the expiry of the twelve-month period after the filing date, the applicant has not paid the fee set out in item 2 of Schedule II and filed the following information and documents:

(a) an abstract;

(b) an appointment of a patent agent, where required by section 20 of the Patent Rules;

(c) an appointment of an associated patent agent where required by section 21 of the Patent Rules; and

(d) an appointment of a representative, where required by section 29 of the Patent Act.

The reinstatement procedures set forth in subsection 16(4) of the Patent Cooperation Treaty Regulations as they read immediately before October 1, 1996 apply to an international application that was, before that date, deemed to be abandoned pursuant to subsection 16(3) of these Regulations.

5.04
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

filing date (extension of time)

Alexander v Canada	31 CPR (2d)	24	1976
Chinoin v Canada	31 CPR (2d)	32	1976
Didier-Werke v Canada	42 CPR (2d)	69	1978
Re: Procter & Gamble Co.	39 CPR (2d)	269	1979

CHAPTER 6

OWNERSHIP AND REGISTRATION

6.01 INTRODUCTION
6.02 EVIDENCE
6.03 REGISTRATION
6.04 APPLICANT FOR PCT APPLICATIONS AT NATIONAL ENTRY
6.05 REFUSAL OF A JOINT INVENTOR TO PROCEED
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6.07 CERTIFICATE OF REGISTRATION
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6.09 MAINTAINING CHAIN OF TITLE
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CHAPTER 6
OWNERSHIP AND REGISTRATION

6.01
INTRODUCTION

Making an invention confers a property right on the inventor or in some cases on an employer of an inventor where the invention was made in the normal course of employment. This right includes the entitlement to apply for a patent and such right may be transferred to another person at any time with proper documentation (sections 49 and 50 of the Patent Act). As defined in section 2 of the Patent Rules a "transfer" means a change in ownership of a patent, of an application or of an interest in an invention and includes an assignment. Such a transfer may be effected at any time beginning at the date of invention and during the term of any patent which may issue in respect of that invention.

The history of transferring or passing on the right to a patent or an application is called the chain of title. The chain of title reflects any document that transfers ownership or that change the name of the owner. Such documents are, for example, assignments, mergers, change of name documents or wills.

By virtue of Section 50(1) of the Patent Act, the owner of a patent may assign the right, either wholly or partially, either generally or subject to territorial limitations, and either for the whole term of the patent or for any part thereof. A patent right may be regarded as divisible as to content, territory, or time, and in each case the assignee is to be regarded as the owner of the part assigned, and the assignor as the owner of the part not assigned. There may thus be more than one owner of the rights in a patent at one time.

6.02
EVIDENCE

Where an application is filed in the CPO by a person who is not the inventor the applicant must, before a patent issues, file evidence that the applicant is a legal representative of the inventor and copies of documents effecting transfers relevant to the applicant's entitlement to file the application. The documentation and the fee for registration of the ownership should preferably be provided at the time of filing. In this case, the requirements of section 37 of the Patent Rules are complied with and the ownership documentation will be registered by the CPO and a certificate of registration will be sent to the applicant.

If the ownership documentation is not present or is incomplete the CPO will notify the applicant and will indicate the documents required for registration. This notification will be included in a courtesy letter which will inform the applicant of any deficiencies regarding the formal requirements of the application. The documentation required to establish ownership is <u>not</u> a completion requirement and is not subject to the same time

limits as provided under section 94 of the Patent Rules for incomplete applications. However, as a matter of office practice, if the ownership documentation is not provided within 12 months of the Canadian filing date, or the national entry date of an application filed under the provisions of the PCT, the Commissioner will requisition the applicant to submit such documentation, requiring registration of the documents and the registration fee within 3 months of the requisition. If the applicant fails to reply in good faith to this requisition, the application becomes abandoned in accordance with section 97 of the Patent Rules. This 3 month time limit may be extended under section 26 of the Patent Rules.

In the case where an application is allowed, a patent shall not be granted to a transferee of said application unless the request for registration of the transfer is filed on or before the final fee is paid and the patent will issue in the name of the applicant as it existed at the time the final fee was paid. Transfers requested after the final fee is paid will not be processed until after the patent has issued (section 41 of the Patent Rules).

6.03
REGISTRATION

With the exception of transfers and exclusive license agreements, the Commissioner must register any document relating to a patent or an application upon the request of any person and upon payment of the fee set out in item 21 of Schedule II to the Patent Rules (section 42 of the Patent Act). Transfer documents relating to exclusive license agreements must be accompanied by proof of execution in accordance with subsection 49(3) and subsection 50(3) of the Patent Act. The following are examples of the type of proof that will be accepted for the purposes of section 49(3) and 50(3) of the Patent Act:

* an affidavit of a subscribing witness,

* the signature of a witness on the document, or

* the signature of the assignor if either the assignor or the agent of record indicates on the covering letter that the transfer or agreement was signed by the assignor,

* a corporate seal on the document.

In accordance with section 71 of Patent Rules, all documents submitted for registration must be in English or French or be accompanied by a translation into English or French.

Copies or photocopies of any document purporting to transfer ownership of a patent application will be registered by the CPO without requiring certification.

The following are required to proceed to register a transfer:

* the document must be signed and dated,

* a person signing on behalf of a company must specify his/her position and capacity to sign

* the complete address of the new owner must be given,

* all previous steps in the chain in title must have been recognized by the Commissioner of Patents;

* the document must identify the application or patent, either by the application or patent number, by priority information or any other suitable way that will allow the CPO to positively identify the correct document,

* the document must be specific with respect to which Canadian rights are being transferred and for amalgamations, mergers and consolidations it is not necessary to submit the entire document but only the relevant extracts and provide a precise statement of the portion of interest transferred.

In the case where there appears to be insufficient documentation, the CPO will send an office letter requisitioning clarification.

The following is a list of examples of various document types which can be registered:

(A) TRANSFER

Transfer per se
* assignment of all interest
* assignment of partial interest
* transfer of assets
* court orders
* wills* amalgamations
* mergers
* consolidations

Updates
* change of names
* marriage certificates
* changes of incorporation
* affidavits

Other documents
* writ of Fieri Facias
* seizures
* court orders
* disclaimers

(B) AGREEMENTS

* notice of license agreement
* exclusive license agreement
* license agreements
* security agreements
* debentures
* compulsory licenses
* release of security agreements

6.04
APPLICANT FOR PCT APPLICATIONS AT NATIONAL ENTRY

Upon entry into the national phase in Canada an applicant who has filed an international application under the provisions of the Patent Cooperation Treaty (PCT) must comply with the requirements specified in subsection 58(1) of the Patent Rules.

The CPO requires certain documents concerning ownership for the granting of patents. The following situations may occur as outlined below.

1. The applicant who originally filed an international application requests entry into the national phase and provides the CPO with evidence by way of affidavit, statuary declaration or copies of documents effecting transfers or changes of names that the applicant is a legal representative of the inventor and copies of documents effecting transfers relevant to the applicant's entitlement to file the application (subsection 37(b) of the Patent Rules). No further documentation will be required by the CPO respecting ownership of the rights to the invention in this case, but the applicant will be requisitioned to register the necessary documentation in the CPO.

2. The applicant who originally filed the international application requests entry into the national phase but provides no documentation relating to ownership of the invention. In this case the CPO will advise the applicant by way of a courtesy letter that evidence meeting the requirements of section 37 of the Patent Rules as outlined above must be provided within 12 months of the date of national entry. If the ownership documentation is not provided within that time period, the Commissioner will requisition the applicant to submit such documentation, requiring registration of the documents and the registration fee within 3 months of the requisition. If the applicant fails to reply in good faith to this requisition the application becomes abandoned in accordance with section 97 of the Patent Rules. This three month time limit may be extended under section 26 of the Patent Rules.

3. If the applicant entering the national phase is different from the applicant who filed the original international application, evidence that the applicant requesting national entry is the legal representative of the originally identified applicant must be provided (subsection 58(5) of the Patent Rules), if not already on file. Such evidence may be provided at the time of requesting national entry. If such evidence is not provided at that time, the Commissioner will requisition the necessary documents under section 25 of the Patent Rules which prescribes a three month time limit for compliance. The evidence required to satisfy subsection 58(5) of the Patent Rules must be provided to permit national entry. When this evidence is provided, the applicant will be accorded

the national entry date on which the requirements of subsection 58(1) were satisfied. Although the form IB/306 is sufficient to satisfy the national entry requirement specified in subsection 58(5) of the Patent Rules, there will be a subsequent requirement to register the documents required by section 37 of the Patent Rules. The documents to be registered for that purpose must be such that the chain of title from the inventor to the present applicant is complete (sections 37, 38 and 39 of the Patent Rules and section 51 of the Patent Act).

4. In each of the situations outlined in 1, 2 or 3 above, the applicant will be notified by means of a courtesy letter of the action that must be taken to satisfy the CPO requirements concerning ownership.

6.05
REFUSAL OF A JOINT INVENTOR TO PROCEED

When two or more persons jointly make an invention, all the inventors must join in applying for a patent and a patent is granted to them jointly. In case of disputes between joint applicants, Section 31 of the patent Act applies, as follows:

(A) A joint inventor who refuses to file an application for patent;

By virtue of Section 31(1) of the patent Act, If an invention is made by two or more inventors, and if one refuses to apply for a patent or if his whereabouts cannot be ascertained, the other inventor(s) may apply for a patent, and a patent may be granted in the names of those who apply, provided the Commissioner is satisfied that the joint inventor has refused to apply or cannot be found. Evidence to satisfy the Commissioner may be submitted by way of affidavit or statutory declaration.

(B) A joint applicant who refuses to further proceed with the application;

In accordance with section 31(2) of the Patent Act if an applicant who agrees in writing to assign his rights to another person and subsequently refuses to proceed with the application, or if disputes arise between joint applicants with respect to proceeding with an application, the Commissioner may allow that other person or joint applicant to proceed alone. To satisfy the Commissioner that one or more of the applicants ought to be allowed to proceed alone, evidence by way of affidavit or statutory declaration may be provided. All persons interested are entitled to be heard before the Commissioner.

6.06
CORRECTION OF TRANSFER DOCUMENTS

The CPO will not require correction of minors errors in transfers or minor discrepancies

between the transfer document and the petition. For example, company's abbreviations are not questioned such as Co. for Company, Inc. for Incorporated or LTD for Limited.

Any transfer of ownership which has been registered in the CPO may be corrected under the provisions of section 8 of the Patent Act.

6.07
CERTIFICATE OF REGISTRATION

Upon registration of a transfer including mergers, amalgamations and consolidations, a certificate of registration is produced and identified by number. The documents submitted for registration are scanned and annexed to the corresponding application file. The certificate and the documents submitted are returned to the sender.

No certificate is produced for a change of name.

The Federal Court has jurisdiction, on the application of the Commissioner or of any person interested, to order that any entry in the records of the Patent Office relating to the title to a patent be varied or expunged (section 52 of the Patent Act).

6.08
CERTIFIED COPIES

Certified copies bearing the seal of the office may be obtained upon specific request and payment of the fee prescribed under item 26 of Schedule II of the Patent Rules. Certified copies of the certificate of registration or any document registered in CPO may be obtained in a similar manner.

6.09
MAINTAINING CHAIN OF TITLE

In accordance with Rule 38 of Patent Rules, no transfer of a patent or application to a new owner is recognized by the Commissioner unless a copy of the document effecting the transfer from the currently recognized owner to the new owner has been registered in the Patent Office in respect of that patent or application.

6.10
OWNERSHIP RIGHTS

Once a transfer of ownership has been recorded, the application may not be withdrawn without the consent in writing of every currently recognized owner (subsection 49(2) of the Patent Act).

Revocation of the agent or representative and appointment of the new agent or representative has to be signed by the currently recognized owner or the patent agent

currently of record (Section 20(3) of the Patent Rules).

6.11
OWNERSHIP INFORMATION

The CPO maintains a register listing the names and addresses of all the owners of each application or patent. The ownership register may be consulted in the Public Search Room.

CHAPTER 7

INTERNAL PRIORITY AND CONVENTION PRIORITY

7.01 FILING REQUIREMENTS WHEN PRIORITY IS REQUESTED
- 7.01.01 Internal Priority
- 7.01.02 PCT Priority

7.02 TIME LIMITS FOR REQUESTING PRIORITY UNDER THE PARIS CONVENTION

7.03 PRIORITY AND OPI DATE IN CANADA
- 7.03.01 Withdrawal of Priority

7.04 PETTY PATENTS AND AUTHORS' CERTIFICATES

7.05 U.S. CONTINUATION-IN-PART APPLICATIONS

7.06 MULTIPLE PRIORITIES

CHAPTER 7
INTERNAL PRIORITY AND CONVENTION PRIORITY

7.01
FILING REQUIREMENTS WHEN PRIORITY IS REQUESTED

For applications filed after October 1, 1996:

The requirements for requesting priority in respect of a patent application are set out in section 28.4 of the Patent Act and sections 65, 88 and 89 of the Patent Rules. A request may be relied upon only if an application has been filed in Canada within 12 months of the earliest date on which any corresponding application has been filed in Canada or in any country belonging to the Paris Convention or in any World Trade Organization (WTO) member country (subparagraph 28.1(1)(a)(ii) and paragraph 28.1(1)(b) of the Patent Act).

Priority for applications filed under the provisions of the Patent Cooperation Treaty (PCT) is recorded in accordance with the procedures outlined in Section 7.01.02 below.

An application is not entitled to the "claim date" conferred by Section 28.1 of the Patent Act, unless the applicant requests priority based on a previously regularly filed application before the expiry of four months after the filing date of the application in Canada (paragraph 88(1)(b) of the Patent Rules).

The request for priority may be made in the petition or in a separate document (paragraph 88(1)(a) of the Patent Rules).

The applicant must provide the Commissioner with the date and country of each previously regularly filed application on which the request for priority is based, before the expiry of the four-month period after the filing date of the application in Canada (paragraph 88(1)(c) of the Patent Rules).

The applicant provide the Commissioner with the application number of each previously regularly filed application on which the request for priority is based, before the expiry of the later of the four-month period after the filing date of the subject application in Canada, and the twelve-month period after the date of filing of the previously regularly filed application (paragraph 88(1)(d) of the Patent Rules).

No extension of time is permitted for requesting priority and providing the Commissioner with the date and country of each previously regularly filed application and for providing the application number of such applications (subsection 88(2) of the Patent Rules).

An applicant will be afforded the benefit of a request for priority only if the priority document adequately discloses at least part of the invention described in the subject application. Where a previously regularly filed application on the basis of which a request

for priority is based is taken into account pursuant to sections 28.1 to 28.4 of the Patent Act, the applicant may be required to file a certified copy of such application and a certification from the patent office in which the application was filed, indicating the actual date of its filing (section 89 of the Patent Rules). If the previously regularly filed application is not written in either English or French, the applicant will be requisitioned to provide a translation in one of these languages (section 71 of the Patent Rules).

The benefit of a request for priority is not afforded by the CPO if an applicant has filed two applications in one or more countries for the same subject matter, and one of those filings was more than a year before the Canadian filing. Under normal circumstances no priority benefit may be based on the second application, even if it has been filed less than a year before the Canadian filing, except for new matter appearing in the second application. However, if the first filed application is considered never to have been filed in accordance with subsection 28.4(5) of the Patent Act, an inventor may be entitled to full priority rights based upon the subsequently filed application.

Priority is based on the specification in priority applications and thus not restricted to the invention claimed. A provisional patent application filed in a foreign jurisdiction such as a United States provisional application, may also serve as a basis for claiming priority for a Canadian application.

For applications filed prior to October 1, 1996 and after October 1, 1989:

A request for priority must be received by the CPO within six months of the filing date of the application (the subject application). The applicant must also provide the Commissioner with the date and country of filing and the application number of each previously regularly filed application on which the request for priority is based before the expiry of the six-month period after the filing date of the subject application (section 142 of the Patent Rules). Other than the time limits specified, all other provisions affecting priority are as given above.

No extension of time is permitted for requesting priority and providing the Commissioner with the date and country of each previously regularly filed application and for providing the application number of such applications (subsection 142(2) of the Patent Rules).

7.01.01
Internal Priority

It is permitted to request priority based on a previously regularly filed Canadian application in a subsequently filed application provided the request is made within 4 months of the filing of the subsequently filed application. The applicant must provide the date of filing of the subject application within four months of the filing of the subsequently filed application and must also provide the application number of the subject application within the later of the four-month period after the filing date of the subsequently filed application and the twelve-month period after the date of filing of the subject application.

This practice provides an applicant the opportunity to file an application for patent as early as possible after an invention has been made in order to obtain the filing date for the disclosed subject matter. If the applicant subsequently makes improvements or alterations to the original invention, the applicant may file an additional application adding the new matter and requesting priority on the first filed application. This allows the applicant to maintain the original filing date for the subject matter disclosed in the first filed application while receiving a later filing date for the new matter. The applicant has the option of proceeding with both applications or abandoning the first application and proceeding with the second application.

7.01.02
PCT Priority

The filing of an international application has the effect of filing a regular national application in each designated state. For the purposes of the Paris Convention, the effect of an international application is equivalent to that of a national filing. Priority rights, for example, may be based on an international application.

If the international application has acquired priority rights before the International Bureau based on an earlier filed national application, those rights would be extended to the applicant upon national entry in Canada.

For priority requests under the provisions of the Patent Cooperation Treaty (PCT) see Chapter 22 of this Manual.

7.02
TIME LIMITS FOR REQUESTING PRIORITY UNDER THE PARIS CONVENTION

Applications requesting priority rights must be filed in Canada on or before the first anniversary date of the first filing in a Paris Convention country, a WTO member or Canada. The "twelve months" referred to in paragraph 28.1(1)(b) of the Patent Act ends on and includes the anniversary date of the first filing. However, if the anniversary date is a day when the CPO is closed for business, the filing may be made on the next day when the Patent Office is open for business (section 78 of the Patent Act).

7.03
PRIORITY AND OPI DATE IN CANADA

The date of the earliest previously filed application on which a request for priority is based will determine the date of opening to public inspection in Canada. In accordance with subsections 10(1) and (2) of the Patent Act, the application and all documents filed in connection with the application will be opened on the expiry of an 18 month confidentiality period beginning on the earliest priority date unless the applicant requests an earlier opening.

7.03.01
Withdrawal of Priority

Under subsection 28.4(3) of the Patent Act, an applicant may withdraw a request for priority, either entirely or with respect to one or more previously regularly filed applications, by filing a request with the Commissioner. The Commissioner shall send a notice to the applicant advising that the request for priority has been withdrawn (subsection 90(1) of the Patent Rules). The effective date of the withdrawal of the request for priority will be the date the request for withdrawal is received by the Commissioner (subsection 90(2) of the Patent Rules).

7.04
PETTY PATENTS AND AUTHORS' CERTIFICATES

The CPO recognizes convention priority based on petty patent applications, applications for authors' certificates, and utility models filed in foreign countries, since these are considered forms of patent applications. On the other hand, no priority may be based on a foreign application for an industrial design registration, design patents or their equivalent.

7.05
U.S. CONTINUATION-IN-PART APPLICATIONS

Under some conditions, priority may be based on United States continuation-in-part applications. A continuation-in-part application may serve as a priority document for new matter disclosed in it and not in the original United States application if the Canadian application is filed within a year of the continuation-in-part.

Where a Canadian application is filed more than a year after the filing date of the original United States application, but less than a year after the continuation-in-part, the applicant is not entitled to priority on subject matter common to the two United States applications, even if the original has been abandoned. While under the Paris Convention an applicant may claim priority based on a second foreign application when the first has been abandoned, this is only so if there are no rights whatsoever remaining (Subsection 28.4(5) of the Patent Act). In the case of a continuation-in-part application, certain rights are carried over from the abandoned original application.

If both the original and the continuation-in-part applications are filed within the year preceding the filing of the Canadian application, priority may be based on both the original application and on the new matter in the continuation-in-part.

Where, therefore, priority is necessary to support a claim date in the prosecution of a Canadian application claiming priority from a United States continuation-in-part application only, it is necessary to identify the matter derived from the original United States application, thereby to determine the priority rights of the applicant. Because a

United States continuation-in-part application does not identify the new matter added to the original United States application, the applicant must submit certified copies of the original and continuation-in-part applications whenever required to do so by the CPO.

7.06
MULTIPLE PRIORITIES

Subsection 28.4(4) of the Patent Act provides for multiple convention priorities.

A Canadian application, the subject application, may be a composite of several earlier filings of the inventor, and entitled to priority in respect of each for the subject matter contained therein, provided, that the subject application was filed within a year of the earliest filed application on which the request for priority is based.

Claim dates under section 28.1 of the Patent Act may be based on one or more previously regularly filed applications in the same or different countries which describe the subject matter of the claim in question. See also Chapter 15 of this Manual.

CHAPTER 8

ABSTRACTS

8.01 ABSTRACTS
8.02 REFERENCE CHARACTERS IN ABSTRACTS
8.03 EXAMINATION OF ABSTRACTS
8.04 APPLICATIONS READY FOR ALLOWANCE
8.05 EXAMPLES OF ABSTRACTS

CHAPTER 8
ABSTRACTS

8.01
ABSTRACTS

Subsection 27(2) of the Patent Act provides the authority for the requirements of a patent application. An abstract is not a requirement for a filing date. An application, however, must contain an abstract in order to be complete (paragraph 94(1)(b) of the Patent Rules).

Section 79 of the Patent Rules sets forth the required form and content of the abstract as follows:

An application shall contain an abstract which shall

(a) contain a concise summary of the matter contained in the application and, where applicable, the chemical formula that, among all the formulae included in the application, best characterizes the invention;

(b) specify the technical field to which the invention relates;

(c) be drafted in a way that allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;

(d) be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art; and

(e) shall not contain more than 150 words.

Section 72 of the Patent Rules specifies that the abstract should be provided on a page separate from the description. For clarity, it should have a separate heading, such as, "Abstract of the Specification". Since the abstract will be used as a search tool in the CPO's Techsource database, the text should avoid patent jargon so that it may be readily understood by technicians and scientists and other persons who are interested in obtaining information about opened patent applications and issued patents. It should provide a means for quickly determining the nature of the description so that the reader can decide whether a complete copy of the specification would be useful.

8.02
REFERENCE CHARACTERS IN ABSTRACTS

Each main technical feature mentioned in the abstract and illustrated by a drawing in the application may be followed by a reference character referred to in a drawing, placed between parentheses (subsection 79(7) of the Patent Rules).

8.03
EXAMINATION OF ABSTRACTS

Abstracts are subject to examination in respect to their conformance with section 79 of the Patent Rules.

8.04
APPLICATIONS READY FOR ALLOWANCE

When an application is allowable, except for the abstract, the examiner requisitions an amendment. The requisition notifies the applicant that the form of the abstract is the sole impediment to the prompt allowance of the application and that amendment to comply with section 79 of the Patent Rules is requisitioned within the prescribed time limit. Failure to respond will result in abandonment of the application.

8.05
EXAMPLES OF ABSTRACTS

The following examples illustrate what are considered to be suitable abstracts.

(a) A heart valve with an annular valve body defining an orifice and having a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and moved by blood flow between open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing a convex profile on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within the heart.

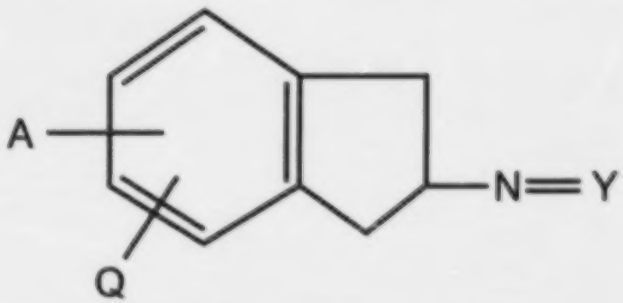
(b) A method comprising the use of heat to seal overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermo-plastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The boxes are moved so quickly through the air stream that the coating on the side of the panels not directly exposed to the hot air remains substantially non-tacky. A bond is formed almost immediately after heating. Under such conditions the heat applied to soften the thermo-plastic coating is dissipated after completion of the bond by absorption into the board itself, which acts as a heat sink, without the need for cooling devices.

(c) Amides are produced by reacting an ester of a carboxylic acid with an amine, using as catalyst an alkoxide of an alkali metal. The ester is first heated to at least 75°C. under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which prevent the reaction, and then converted to an amide without further heating.

(d) Process for the production of semiconductor devices, wherein a silicon oxide film is formed on a surface of a semiconductor substrate, followed by deposition of a layer of lead on the film. This combination is then heated at 500-700°C. for at least 10 minutes in an oxidizing atmosphere, whereby a passivating film forms, consisting essentially of silicon oxide and lead oxide. The temperatures employed are substantially lower than those conventionally used, and prevent deterioration of the device.

(e) Wool is heated at 50-65°C. for less than 15 minutes in an aqueous dispersion of 0.1-2 percent calcium hydroxide, washed, and then acidified to render it receptive to dyestuffs without adversely affecting the physical properties of the wool.

(f) Compounds of the formula:
wherein A and Q are hydrogen or alkoxy groups and Y means an alkylene group



with 4 to 7 carbon atoms, are useful as plant desiccants.

(g) Method by which a token-passing local-area network having from 2 to 2^n modules is initialized, where n is an integer greater than zero. When connected into the network and energized, each module determines if the network is initialized and, if not, which module is to do so. Each module has a unique n bit network address. The module with the smallest network address energized before the network is initialized is identified and begins the process of initialization by transmitting tokens addressed sequentially to network addresses beginning with the next higher address than its own until a token so transmitted is accepted by an addresses module or until a token has been addressed to all network addresses other than that of the initiating module. After tokens are transmitted to all possible network addresses other than that of the initiating module, the initiating module generates a fault signal to indicate its status.

CHAPTER 9

DESCRIPTION

9.01 THE DESCRIPTION
9.02 TITLE OF THE INVENTION
9.03 REFERENCE TO DRAWINGS
9.04 REFERENCE TO OTHER DOCUMENTS IN THE DESCRIPTION
9.05 INSUFFICIENT DESCRIPTION
9.06 TRADE-MARKS IN THE DESCRIPTION
9.07 AMENDMENTS TO THE DESCRIPTION
9.08 JURISPRUDENCE

CHAPTER 9
DESCRIPTION

9.01
THE DESCRIPTION

The description means the part of the specification other than the claims (see definition in section 2 of the Patent Rules).

The description must describe the invention and its operation or use as contemplated by the inventor (subsection 27(3) of the Patent Act). It must be in the same language as the claims, that is, wholly in English or wholly in French (subsection 71(3) of the Patent Rules). If an applicant wishes to change the language used in a specification, he may submit a new specification in the other official language provided that no new matter is added.

The description must be clear and accurate. It should be as simple, direct, and free from obscurity and ambiguity as possible. It is addressed to persons skilled in the art or science to which the invention pertains and must be so written that those persons would be able to put the invention to the same successful use as had the inventor.

The description must not contain erroneous or misleading statements likely to deceive or mislead persons to whom it is addressed. Nor should it be couched in such language as to render it difficult to comprehend the invention's mode of operation without trial or experimentation. Broad assumptions or unproved statements made in the description are objectionable and must be removed. If only one embodiment is operable, alternatives must not be suggested even if skilled persons would probably choose the operable embodiment (Mineral Separation v. Noranda Mines 1947 Ex. C.R.)

The actual inventive step need not appear in a single sentence or paragraph in the description. It is sufficient if it can be seen that the invention is described in the description as a whole.

For applications filed on or after October 1, 1996 the description must be presented in the manner set forth in sections 69(1),(3), (4), and (5), 70(1), 71, 72, 73, 74, 75, and 76 of the Patent Rules. These Rules require specified standards in regard to the paper size and quality, margins, page numbering, line numbering, sequence listings, language of the description, etc..

As prescribed by paragraphs (a) to (g) of subsection 80(1) of the Patent Rules the description shall:

(a) state the title of the invention, which shall be short and precise;

(b) specify the technical field to which the invention relates;

(c) describe the background art that, as far as known to the applicant, can be regarded as important for the understanding, searching and examination of the invention;

(d) describe the invention in terms that allow the understanding, of the technical problem, even if not expressly stated as such, and its solution;

(e) briefly describe the figures in the drawings, if any;

(f) set forth at least one mode contemplated by the inventor for carrying out the invention in terms of examples, where appropriate, and with reference to the drawings, if any; and

(g) contain a sequence listing where required by paragraph 111(a) of the Patent Rules.

The description must be presented in the manner and order specified in (a) to (g) above unless, because of the nature of the invention a different manner or a different order would afford a better understanding or a more economical presentation (subsection 80(2) of the Patent Rules). This would, for example, permit the applicant to refer to drawings of the background art prior to providing a brief description of the figures in all of the drawings.

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, the description must conform to sections 133, 134, 135, 136,137,138, and 140 of the Patent Rules.

For applications filed before October 1, 1989, the description must conform to sections 169, 170, 171, 172, 173, and 176 of the Patent Rules.

A new product should be described in terms of its characteristics and for a compound its derived formula should be given.

Under Section 2 of the Patent Act, the invention must have utility. The description should explain at least one use of the invention in sufficient detail to enable a skilled person to use the invention for its intended purpose. If no use can be seen on the basis of the description, the application may be rejected for lack of utility.

Not only must the applicant give all information for putting the invention to use but he must also insert necessary warnings to avert failure.

9.02
TITLE OF THE INVENTION

Each application for a patent must have a title. The title of the invention must appear on the first page of the description and should preferably also appear on the page containing the abstract. It must be short and precise (paragraph (a) of subsection 80(1) of the Patent Rules). It should be descriptive of the invention rather than broad, such as "CARBON TETRACHLORIDE" rather than "COMPOUNDS".

For applications filed in the period beginning October 1, 1989 and ending on the day before October 1, 1996, the title must conform to section 134 of the Patent Rules.

For applications filed before October 1, 1989, the title must conform to section 170 of the Patent Rules.

9.03
REFERENCE TO DRAWINGS

Drawings are not permitted in the description, abstract, claims, or the petition (subsection 74(1) of the Patent Rules). However, the description, abstract and claims may contain chemical or mathematical formulae or the like (subsection 74(2) of the Patent Rules). All drawings provided with an application for a patent must be described in the description making reference to corresponding reference numbers shown on the drawings identifying the various elements being depicted. All reference numbers in the description must appear in the drawings (subsection 82(9) of the Patent Rules). The same reference number must describe the same feature throughout the application (subsection 82(10) of the Patent Rules).

9.04
REFERENCE TO OTHER DOCUMENTS IN THE DESCRIPTION

The description may not incorporate by reference another document (section 81(1) of the Patent Rules). The description may refer to a document that does not form part of the application, only if the document was available to the public on the filing date of the application (subsection 81(2) of the Patent Rules). Any such document cannot be relied upon for the support of a claim in an application (section 84 of the Patent Rules). If a document referred to is a patent or a patent application, it must be identified by the serial number and country or organization where filed. Any other document referred to must be sufficiently identified to enable the document to be located.

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, refer to subsections 137(1), 137(2) and 137(3) of the Patent Rules.

For applications filed before October 1, 1989, refer to subsections 173(1), 173(2) and 173(3) of the Patent Rules.

9.05
INSUFFICIENT DESCRIPTION

The description of an application must describe all of the subject matter that the applicant intends to claim as his invention. For example, if the applicant intends to claim a chemical compound the description must disclose how that compound is prepared and desirably it will characterize the compound by some of its physical constants.

When it is clear that the description of an application is not sufficient to support the claims without reference to a document referred to in the application being examined, it is objected to for insufficiency of description under section 84 of the Patent Rules. If the reference is to a document that was available to the public before the Canadian application date, the applicant is requisitioned to insert the pertinent disclosure of the document into the application. If the reference is to any document that was not available to the public before the filing date of the Canadian application, the applicant may not import any of the subject matter disclosed in that reference into the application. Further, the applicant will be requisitioned to delete the reference from the description (subsection 81(2) of the Patent Rules).

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, see subsection 137(2) of the Patent Rules.

For applications filed before October 1, 1989, see subsection 173(2) of the Patent Rules.

9.06
TRADE-MARKS IN THE DESCRIPTION

A "trade-mark" is a mark that is used by a person for the purpose of distinguishing, or so as to distinguish, wares or services manufactured, sold, leased, hired or performed by that person from those sold, leased, hired or performed by others.

A "registered trade-mark" is a trade-mark that is on the register kept by the Registrar of Trade-marks.

In compliance with subsection 27(3) of the Patent Act, the applicant is required to give a full description of the invention being described. This description may include a trade-mark as long as it is identified as such in the description (see section 76 of the Patent Rules). The Commissioner may require a complete description of the wares that are the subject of the trade-mark if reference to the trade-mark per se does not satisfy subsection 27(3) of the Patent Act. The applicant is required to give as complete a description as possible. It is usually possible to describe, at least partly, a material or list some of its constituents or properties, if only in general terms. Once the material has been defined, subsequent references to it in the same description or in the claims may be made by use of the trade-mark alone.

Whenever a trade-mark is used, it must be identified at the first appearance as a trade-mark. For the purpose of identification, the CPO will accept the symbol or a statement that it is a trade-mark. Whenever the trade-mark appears subsequently in the specification, it must be identified in a similar manner or by capitalizing all letters or by use of quotation marks.

9.07
AMENDMENTS TO THE DESCRIPTION

The general rule governing the admissibility of amendments is that they must not have the effect of introducing new matter.

Under subsection 38.2(2) of the Patent Act, the description may not be amended to add subject matter not reasonably to be inferred from the drawings or the specification as originally filed. Therefore, subject matter shown in the drawings as originally filed or set forth in the original claims, may be added to the description. In addition, the applicant is permitted to add matter that describes the prior art with respect to the application (subsection 38.2 (2) of the Patent Act). The specification includes the description and claims (subsections 27(3) and (4) of the Patent Act). (Refer to Chapter 19.08.01 and 19.10.01)

Any amendment which is not acceptable under section 38 of the Patent Act because it contains new matter will be objected to in a subsequent examiner's action and cannot be used to establish a priority date or a claim date. (Refer to 19.08.01 and 19.10.01)

9.08
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

<u>disclosure/description (directed to one of skill in the art)</u>

O'Cedar v Mallory Hardware	ExCR	299	1956
Metalliflex v Rodi	35 CPR	49	1961
	SCR	117	1961
American Cyanamid v Charles	47 CPR	215	1965
Gilbert (Gillcross) v Sandoz	64 CPR	14	1970
	1 SCR	336	1974
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Burton Parsons v Hewlet	17 CPR (2d)	97	1976
	1 SCR	555	1976
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Consolboard v MacMillan	56 CPR (2d)	145	1981
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Windsurfing v Bic Sports	8 CPR (3d)	241	1985
Amfac v Irving	12 CPR (3d)	193	1986
Hy Kramer v Lindsay	9 CPR (3d)	297	1986
Reading & Bates v Baker	18 CPR (3d)	181	1987
Pioneer Hi-Bred v Com of Pat	25 CPR (3d)	257	1987
	14 CPR (3d)	491	1987
Tye-Sil v Diversified	16 CPR (3d)	207	1987

DESCRIPTION			
Eli Lilly v O'Hara	20 CPR (3d)	342	1988
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Computalog v Comtech	32 CPR (3d)	289	1990
	35 CPR (3d)	350	1991
	44 CPR (3d)	77	1992
Lubrizol v Imperial Oil	33 CPR (3d)	1	1990
	45 CPR (3d)	449	1992
Welcome v Apotex	39 CPR (3d)	289	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
Hi-Quail v Rea's Welding	55 CPR (3d)	224	1994
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995
<u>misleading statements</u>			
Lovell v Beatty	41 CPR	18	1962
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
PLG Research v Jannock	35 CPR (3d)	346	1991
Nekoosa v AMCA	Int56 CPR (3d)	470	1994
<u>ambiguity</u>			
French's Complex v Electrolytic	ExCR	94	1927
	SCR	462	1930
Mineral Separation v Noranda	12 CPR	99	1947
	15 CPR	133	1952
Omark v Gouger Saw Chain	45 CPR	169	1964
Proctor & Gamble v Bristol	39 CPR (2d)	145	1978
	42 CPR (2d)	33	1979
Standal v Swecan	28 CPR (3d)	261	1989
Gorse v Upwardor	25 CPR (3d)	166	1989
	40 CPR (3d)	479	1992
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
Risi Stone v Groupe Peracon	29 CPR (3d)	243	1990
	65 CPR (3d)	2	1995
PLG Research v Jannock	35 CPR (3d)	346	1991
Procter & Gamble v Kimberly	40 CPR (3d)	1	1991
Unilever v Procter & Gamble	47 CPR (3d)	479	1993
	61 CPR (3d)	499	1995
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
Mobil Oil v Hercules	57 CPR (3d)	488	1994

DESCRIPTION			
	63 CPR (3d)	473	1995
Almecon v Nutron	65 CPR (3d)	417	1996
<u>description of product (characterization)</u>			
Scully Signal v York Machine	20 CPR	27	1954
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Re: Farbwerke Hoechst	13 CPR (3d)	212	1980
Ciba Geigy v Comm of Pat	65 CPR (3d)	73	1982
Martinray v Fabricants	41 CPR (3d)	1	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Airseal v M&I Heat	53 CPR (3d)	259	1993
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
<u>need to avert failure</u>			
Wandscheer v Sicard	SCR	1	1948
Mineral Separation v Noranda	69 RPC	81	1952
	12 CPR	99	1950
TRW Inc v Walbar	39 CPR (3d)	176	1991
Airseal v M&I Heat	53 CPR (3d)	259	1993
Feherguard v Rocky's	53 CPR (3d)	417	1994
	60 CPR (3d)	512	1995
<u>utility</u>			
Mailman v Gillet	SCR	724	1932
Northern Electric v Browns	ExCR	36	1940
	SCR	224	1941
Wandscheer v Sicard	SCR	1	1948
Metalliflex v Wienenberger	35 CPR	49	1961
	SCR	117	1961
Boehringer v Bell-Craig	39 CPR	201	1962
Comm of Pat v Farbweke	41 CPR	9	1963
	SCR	49	1964
Rhone-Poulenc v Gilbert	55 CPR	207	1968
Burton Parsons v Hewlet	17 CPR (2d)	97	1976
	1 SCR	555	1976
Marzone v Eli Lilly	37 CPR (2d)	37	1978
Proctor & Gamble v Bristol	39 CPR (2d)	145	1978
	42 CPR (2d)	33	1979
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Consolboard v MacMillan	56 CPR (2d)	145	1981

DESCRIPTION

Radio Corp v Hazeltine	56 CPR (3d)	170	1981
Shell Oil v Comm of Pat	2 SCR	536	1982
	67 CPR (2d)	1	1982
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Hy Kramer v Lindsay	9 CPR (3d)	297	1986
Lubrizol v Imperial Oil	33 CPR (3d)	11	1990
	45 CPR (3d)	449	1992
TRW Inc v Walbar	39 CPR (3d)	176	1991
Welcome v Apotex	39 CPR (3d)	289	1991
Haul-All v Shanahan	50 CPR (3d)	368	1993
Unilever v Procter & Gamble	47 CPR (3d)	479	1993
	61 CPR (3d)	499	1995
Feherguard v Rocky's	53 CPR (3d)	417	1994
	60 CPR (3d)	512	1995

novelty in utility

Wright v Brake Service	Ex CR	127	1925
Pope Appliance v Spanish River	Ex CR	28	1926
Candian Gypsum v Gypsum Lime	Ex CR	180	1931
Mailman v Gillet	SCR	724	1932
Lanlois v Roy	Ex CR	197	1941
Northern Electric v Browns	SCR	224	1941
Shell Oil v Comm of Pat	2 SCR	536	1982
	67 CPR (2d)	1	1982

best mode (undue experimentation)

TRW Inc v Walbar	39 CPR (3d)	176	1991
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Mobil Oil v Hercules	63 CPR (3d)	473	1995
	57 CPR (3d)	488	1994

insufficiency of disclosure

French's Complex v Electrolytic	ExCR	94	1927
	SCR	462	1930
BVD Co V Canadian Celanese	ExCR	139	1936
Low v Hawley Products	1 DLR	15	1940
Mineral Separation v Noranda	12 CPR	99	1950
	69 RPC	81	1952
Di Fiore v Tardi	16 CPR	18	1952
Boehringer v Bell-Craig	39 CPR	201	1962
Rhone-Poulenc v Gilbert	55 CPR	207	1968
Gilbert (Gillcross) v Sandoz	64 CPR	14	1970
	SCR	1336	1974
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974

DESCRIPTION

Xerox v IBM	33 CPR (2d)	24	1977
Re: Farbwerke Hoechst	13 CPR (3d)	212	1980
Ductmate v Exanno	2 CPR (3d)	289	1984
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Pioneer Hi-Bred v Com of Pat	14 CPR (3d)	491	1987
	25 CPR (3d)	257	1987
Cabot Corp v 318602 Ont	20 CPR (3d)	132	1988
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Computalog v Comtech	44 CPR (3d)	77	1992
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995
<u>consistory clause</u>			
Reliance Electric v Northern	47 CPR (3d)	55	1993
Re: Appln 122,906	52 CPR (2d)	135	1978
<u>object statements</u>			
Amfac Foods v Irving Pulp	12 CPR (3d)	193	1986
	80 CPR (2d)	59	1984
Saunders v Airglide	50 CPR (2d)	6	1980
Johnston Controls v Varta	80 CPR (2d)	1	1984
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
<u>variance/omnibus clause</u>			
Mico Products v Acetol	ExCR	64	1930
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Amfac Foods v Irving Pulp	12 CPR (3d)	193	1986
	80 CPR (2d)	59	1984

CHAPTER 10

DRAWINGS

10.01 DRAWINGS
10.01.01 Restriction on Amendments to Drawings
10.02 PHOTOGRAPHS

CHAPTER 10
DRAWINGS

10.01
DRAWINGS

Inventions which can be illustrated by means of drawings must be so illustrated in an application for a patent. The role of the drawings is to clarify the principles of the construction of a device rather than to provide particular details of dimensions or relative proportions. The drawings must clearly show all parts of the invention (subsection 37(1) of the Patent Act). Known devices may be illustrated by symbols which have a universally recognized conventional meaning provided that no further detail is essential for understanding the subject matter of the invention. Where text matter in the drawings would give a better understanding of the drawings, a single word or a few words may be used. Blank "blocks" in schematic diagrams must be descriptively labelled. Figures in the drawings which illustrate the prior art should be labelled "PRIOR ART".

Each drawing provided must include reference characters corresponding with those in the description, and the Commissioner may require further drawings or dispense with any of them as the Commissioner sees fit (subsection 37(2) of the Patent Act).

Whenever drawings are provided in an application, they must conform to the provisions of sections 72, 82 and 83 and subsections 69(2), 71(3), 74(1), 75(2), 86(1) and (2) of the Patent Rules. Section 80(2) of the Patent Rules permits reference to the drawings before the "Brief Description of the Drawings" when the reference is made in respect of the prior art.

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, see section 141 of the Patent Rules.

For applications filed before October 1, 1989, see section 177 of the Patent Rules.

10.01.01
Restriction on Amendments to Drawings

Drawings may be amended at any time up to the time of payment of the final fee, unless the application is under final rejection (subsection 38.2(1) of the Patent Act and section 33 of the Patent Rules).

Drawings may not be amended to add matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application (subsection 38.2(3) of the Patent Act).

Drawings may only be amended by inserting new pages in place of the pages altered by the amendment and shall be accompanied by a statement explaining their nature and

purpose (section 34 of the Patent Rules).

10.02
PHOTOGRAPHS

In any case in which an invention does not admit of illustration by means of drawings but does admit of illustration by means of photographs, the applicant may, as part of the application, furnish photographs, or photocopies of photographs, that illustrate the invention (section 83 of the Patent Rules).

CHAPTER 11

CLAIMS

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CHAPTER 11
CLAIMS

11.01
BASIC REQUIREMENTS

The claims must define distinctly and in explicit terms the subject matter of the invention for which protection is sought (section 27(4) of the Patent Act). Patentable claims must define novel subject matter. To be considered novel the whole of subject matter defined by a claim shall not form part of the state of the art. With respect to each claim in an application for patent in Canada the state of the art may be defined generally as everything disclosed in such a manner that it became available to the public in Canada or elsewhere before the **CLAIM DATE**. The **CLAIM DATE** of a claim in a Canadian patent application is the filing date of the application in Canada, unless, priority is claimed on an earlier filed application in Canada or elsewhere. In the latter case, the claim date is the filing date of the earliest application which supports the subject matter of the claim Sections 2 and 28.1 of the Patent Act and Chapter 15 for more detail. The claims should also specify in a positive manner all the elements, features, and critical aspects of the invention which are necessary to ensure the result as set forth in the description. Each claim (read with the introduction to the claims) must be restricted to a single sentence.

Claims may be drafted to contain the three following major parts:

1) preamble or introductory phrase
2) transitional phrase
3) body (or purview)

The preamble identifies the category of the invention and may state the purpose of the invention with regard to this category.

Examples:

A machine for waxing paper ...
A composition for fertilizing the soil ...

The transitional phrase joins the preamble to a recitation of the elements of the invention to be protected. It also indicates, in an abbreviated way, whether the recitation is left open or closed to additional elements.

Examples:

which comprises, comprising, including, having ...
consisting of, consisting essentially of ...

The body of the claim lists the main elements of the invention, such as, parts of a device,

steps of a process or method, ingredients of a composition, or groups in the chemical formula of a compound.

Notwithstanding the above, the CPO will accept any form of claim that conforms to section 27(4) of the Patent Act and that sets forth an invention in distinct and explicit terms and otherwise conforms to the Patent Act and the Patent Rules.

For a consideration of claims with respect to the prior art (novelty and non-obviousness) see Chapter 15.

For consideration of claims with respect to utility, operability and non-patentable subject matter (section 2 of the Patent Act) see Chapter 16.

11.02
PRINCIPLES OF CONSTRUCTION

Claims are the starting point for construing a patent as they define the invention and exclusive right sought. The relevant date for the analysis of a claim is the claim date (see Chapter 15). When construing a claim the essential elements must be determined. However, in order to determine the nature of the invention and the essential elements of the invention, the specification must be construed as a whole. Analysis of a patent is to be determined from the point of view of one skilled in the art, with a mind willing to understand the invention.

Even though claims are construed with reference to the description, reference to the description is only permitted to assist the understanding of terms used within the claims if these terms have a unique meaning. Reference to the description is not permitted for terms that have a plain, common, and unambiguous meaning as these terms would be known to someone of skill within the art, nor is reference to stray phrases within the description considered support for terms within the claims. Furthermore, reference to the description cannot be used to vary the scope of the claims.

The application of these principles can be found in the following: Beecham v Procter Gamble 1982; AT &T v Mitel 1989; Airscal v M&I Heat 1993; Hi-Quail v Rea's Welding 1994; Mobil Oil v Hercules 1994; Cochlear v Cosem; and Almecon v Nutron 1996.

11.03
CLARITY

No speculation should be necessary to determine what is covered by each claim. It must not define some parts of the desired monopoly while only alluding to or vaguely mentioning others. If the invention is difficult to claim, due allowance is given for the limitations of language but involved language should not be used when the invention can be claimed simply. Wording should not be so flexible that several interpretations of it are possible, i.e. the claim should not have more than one meaning or be capable of both broad and narrow interpretations.

11.03.01
Antecedents

When an element is referred to in definite terms without having been introduced previously, the claim is objectionable under section 27(4) of the Patent Act. An example of this is, "A device for cracking nuts comprising a cup shaped base and a striker element, said lever tripping the hammer at timed intervals". In this claim there are no proper antecedents for "said lever" and "the hammer".

Implied antecedents may be permitted where the word or phrase, by definition, always contains the missing antecedent. For example, a claim beginning with: "A wheel, the axis being..." or "A compound having the formula I..." are acceptable.

11.03.02
Ambiguity in Claims

The claims must be framed in distinct and clear language. They should not include vague or equivocal forms of wording which will create doubt. Examples of unclear language are relative terms or expressions such as "thin", "strong", "a major part", "if desired". If such expressions appear in a claim, they must be further defined in clear and distinct terms or be removed from the claim.

The following are some of the most commonly used imprecise terms that may be encountered in claims:

a) "Such as", "Or the like", "For example".
b) "If desired", "When required".
c) "About", "Approximately", "More or less".
d) "Preferably".

Other terms which in certain circumstances may be indefinite are:

a) "Containing as an active ingredient".
b) "Therapeutically effective amount".
c) "A major part".
d) "Of the character described", "As herein described".
e) "At least", "At least one of".
f) "And/or", "Either....or".g)"An effective amount", "A sufficient amount", "A synergistic amount".
h) "Not being...", "Not having...", "Not requiring...".

Whenever any of the above terms is encountered in a claim, a possibility exists that the claim may not satisfy the requirements of the Patent Act and Rules. Specifically, subsection 27(4) of the Patent Act and Section 84 of the Patent Rules should be considered.

Some of these terms have been considered in decisions by the courts or by

Commissioner's decisions.

a) "Containing as an active ingredient"

This phrase should, in some circumstances be refused as being ambiguous and indefinite because "an" implies the presence of other unspecified active ingredients in addition to the one specified in the claim.

Note: This phrase would be acceptable in a claim if "an" is changed to "the" and the other ingredients of the composition are specified while the utility for which the composition is intended is either inherent from the wording of the claim or expressly stated therein (Rohm & Haas v. Commissioner of Patents 30 C.P.R. 113, Ex.C.).

(b) "Therapeutically effective amount"

As was stated in Gilbert v. Sandoz 64 C.P.R. 14, Ex.C., this is an ambiguous term in a claim. The claims in suit included this phrase in conjunction with a particular phenothiazine derivative when produced by specified process claims in association with a pharmaceutical carrier. While it is recognized that the essence of a great many inventions based on compounds for medicinal purposes resides more in the discovery of the unexpected medicinal utility of the compound than in its effective dose, nevertheless, when such a functional statement occurs in a claim, the medicinal utility of the composition of matter must be stated or be inherent from the preamble of the claim.

A particular amount of an active ingredient in combination with another compound (X) may have an entirely different therapeutic value than a very different amount of the same active ingredient in combination with compound X. Therefore, this functional phrase should only be permitted in a composition of matter claim when the utility of the composition of matter is indicated in the claim and provided that the actual amount taught and prescribed in the disclosure is not an important aspect of the invention. This amount may vary over a considerable range apparent to one skilled in the art because of similar known ranges for analogous compounds for the same purpose. However, if the disclosed range is an important feature of the invention or if the invention is only operable within a prescribed range so as to produce the promised results, then of course this disclosed range must be included in all of the independent claims.

(c) "A major part"

This is an acceptable phrase in a claim if it is used in relation to one part of a two- part system where it is clear that it means more than 50%. However, when it refers to one part in a system consisting of three or more parts, it is refused as indefinite because it is not clear if it means a greater percentage than any of the other components or more than 50% of the overall total.

11.03.03
Negative Limitations

Claims containing negative expressions such as "not being...", "not having...", "not requiring..." may be objectionable under section 27(4) of the Patent Act in that claims should generally set forth what the invention is or does, and not what it is not or does not do, unless there is no positive way to describe it. Sometimes a dependent claim (Chapter 11.06) contains provisions which effectively cancel or negate some of the features of a preceding claim, thus making the dependent claim broader than the preceding claim. This is objectionable under section 87 of the Patent Rules.

11.04
COMPLETENESS OF CLAIMS

To define the invention distinctly and in explicit terms, it is required that sufficient elements be recited for operability. The inventive features must appear in each claim . In the case of a composition, a claim must define a minimum of two ingredients, at least broadly. If a claim does not do this, it is objected to as indefinite and contrary to subsection 27(4) of the Patent Act.

11.05
SUPPORT

A claim must be fully supported by the description as required by section 84 of the Patent Rules. All the characteristics of the embodiment of the invention which are set forth in the claim must be fully set forth in the description (Section 84 of the Patent Rules). However, since the claims included in the application at the time of filing are part of the specification (see definition of specification in section 2 of the Patent Rules), any matter in the originally filed claims that was not included in the description as filed may be added to the description.

A claim is objected to for lack of support by the description if the terms used in the claim are not used in the description and cannot be clearly inferred from the description. Terms used in the claims and in the description must be used in the same sense.

11.05.01
Claims Referring to Description or Drawings

It is generally not acceptable for a claim to contain reference to the description or drawings (subsection 86(1) of the Patent Rules). However, in some instances, if the claim is complete in itself and can be read and understood without the reference, the claim is acceptable. The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings except where absolutely necessary. In particular, they must not rely on references such as: "as described in the description " or "as illustrated in Figure 3". The following are examples of exceptions:

(a) Claims which include reference numerals

Reference numerals used in the drawings are permissible in a claim provided they are in brackets or parenthesis (subsection 86(2) of the Patent Rules), and the claim is otherwise explicit and complete. However, if a claim is not complete without referring to the parts of the drawings identified by numerals in brackets, it must be objected to as contravening subsection 27(4) of the Patent Act.

(b) Claims which make reference to charts, tables and graphs

Tabulations in the form of charts often appear in the descriptions of applications. Such tabulations may also be included in the drawings as are graphs, phase diagrams, absorption spectrograms and the like. In circumstances where the nature of the invention is very complex and it is practically impossible or extremely cumbersome to define the scientific relationship of the different factors in a precise and distinguishing manner, without making reference to other parts of the application, then reference to charts, graphs or tables may be permitted in the claims. However, if such a chart or table, for example, is brief and concise, i.e. about 5-10 lines, the applicant may be required to enter it into the claims (subsection 86(1) of the Patent Rules).

(c) Reference to particular unconventional disclosed tests

If a test can be accurately defined in a few lines, then it must be included in the claim and a mere reference to such a test as described should not be permitted. However, when such a test is complex and lengthy to describe, for example if it requires more than one page of the description to characterize it, then the applicant may make reference to the test as therein defined rather than reproduce the test in the claim.

(d) Reference to Sequence listings and Biological Deposits

Reference may be made, within a claim, to sequence listing identifier numbers and biological deposit catalogue numbers (subsections 86(3) and (4) of the Patent Rules). These procedures are specified in detail in chapter 17 (Biotechnology).

11.05.02
Scope in Relation to Description

A claim may be as narrow as the applicant wishes within the scope of the invention disclosed. It must not, however, be broader than the invention as described or supported by the description. Furthermore, a claim will fail if, in addition to claiming what is new and useful, it also claims something that is old or useless (Mineral Separation v. Noranda Mines 12 C.P.R. 99; 12 C.P.R. 182; 15 C.P.R. 133).

Each claim must be read giving its words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning by explicit definition. If a claim covers subject matter outside the scope of the described invention, it should be objected to for failing to satisfy the provisions of section 84 of the Patent Rules.

11.05.03
Ranges Not Specifically Described

When an application includes claims containing a specific limitation with respect to operating conditions, which limitation falls within a broader range described, no objection is made to the narrow claim solely on the grounds that it is not specifically shown in the description or that the description does not indicate the significance of the described range. For example, an application may describe a process carried out within certain temperature limits, e.g. between 500°C and 800°C. No objection is made if some claims are directed to the process carried out between 500°C and 800°C and others to the process carried out at a temperature falling within a smaller range within the described range, e.g. between 650°C and 700°C. However, should the broad claim fall in view of prior art, the narrower claim would also fall unless it can be shown that by restricting the process to the narrower range, a new and unobvious result is obtained.

11.06
DEPENDENT CLAIMS

Section 87 of the Patent Rules permits a claim to refer to one or more other claims, in order to define an invention more narrowly by adding further characteristics to those already present in the claims to which reference is made. Such a claim is designated as a dependent claim.

Claims are also permitted to refer to other claims or parts of claims of the same or of another category, in order to avoid repeating lengthy definitions already given and to simplify claiming, provided they do not become ambiguous as a result of such dependency, thereby contravening section 27(4) of the Patent Act. Such claims however are not dependent claims and section 87 of the Patent Rules does not apply. The patentability of the claim referred to does not necessarily imply the patentability of the dependent claim containing the reference. The following example indicates the form of claiming that is acceptable.

Claim 1: A product comprising composition A.

Claim 2: A process for the production of the composition defined in claim 1 comprising reacting B with C.

An objection is made whenever there is uncertainty as to which part of a preceding claim reference is made or whenever a dependent claim of one category, such as a process, contains by reference so many limitations of another category, such as a product, that it becomes difficult to determine which category the claim covers.

A dependent claim usually refers to other claims in its preamble. In view of subsection 87(1) of the Patent Rules, a dependent claim must state the additional features claimed. According to subsection 87(3) of the Patent Rules, a dependent claim is understood as including all the limitations inherent in the particular claim or claims in relation to which it

is considered. When a claim refers to other claims it must only refer to preceding claims and it must do so to by number.

Examples:

Claim 1: The process of reacting A with B in the presence of a catalyst. (acceptable)

Claim 2: The process of reacting A with B in the presence of a metal containing catalyst. (acceptable)

Claim 3: The process of claim 2 in which the catalyst contains iron. (acceptable)

Claim 4: The process of claim 3 in which the catalyst also contains copper. (acceptable)

Claim 5: The process of claim 1, 2, 3, or 4 in which the catalyst also contains zinc. (acceptable)

Claim 6: The process of any one of claims 1 to 5 in which the catalyst also contains cobalt. (acceptable)

Claim 7: The process of **any of the above** claims in which the catalyst is supported on an inert carrier. (not acceptable)

Claim 8: The process of claim 5 in which the catalyst is supported on an inert carrier. (acceptable)

Claim 9: The process of claim 6 in which the catalyst is supported on an inert carrier. (acceptable)

Claim 10: The process of claim 8 or 9 in which the inert carrier is a silica. (acceptable)

Claim 11: The process of claims 3 and 4 in which the catalyst also contains manganese. (acceptable)

In the examples given above, no objection would be taken to claims 1-6 and 8-10 in view of the provisions of section 87 of the Patent Rules. In contrast, claim 7 which does not refer to the preceding claims by number, would, consequently, violate subsection 87(1) of the Patent Rules and would therefore be objected to.

The form of dependent claims accepted under section 87 of the Patent Rules will be considered acceptable in all applications presently pending in the CPO.

11.07
COMBINATIONS

A combination is a union of elements or process steps co-operating to produce a unitary and practical result that is not the sum of the known characteristics of the elements or steps.

A patentable combination is one in which the elements or steps cooperate in an unexpected manner or cooperate in a known way to give an unobvious result or effect. If all the requirements of the Act and Rules are met, a claim to such a combination can be allowed.

A subcombination is part of a combination. It may be a single element or step of the combination or may, itself, be a combination.

11.07.01
Exhaustive Combinations

Claims must not exceed the scope of the invention by going further than the protection to which the inventor is entitled. Generally, an inventor is entitled to claim the invention, be it apparatus, product or method and its immediate and cooperating environment. For example, claims to a new accelerator pump and the carburetor containing it are permitted. Also, claims to a new type of radio tube grid may be permitted with claims to the tube containing the grid. But claims to a new pump in a carburetor which is attached to an engine or claims to a radio receiver accommodating a tube having a new grid would be objected to unless the overall combination produced new and unexpected results, amounting to further invention, that may require restriction under section 36 of the Patent Act.

11.07.02
Aggregation

An aggregation is not a true combination. It consists of the juxtaposition of parts that do not cooperate to produce a result that is other than the sum of the results of the parts. The function of an aggregation is the sum of the functions of the parts and its result is the predictable sum of the separate results. A mere aggregation of old parts cannot form the basis of a patentable invention.

Claims are objected to when the inventive matter is claimed in association with other elements and it is clear that there is no invention in the aggregation so resulting apart from the inventive matter itself. An applicant who submits claims to a new radio receiver may not submit claims that further define the receiver in terms of a standard chassis or cabinet housing the receiver. However, a new combination of container and receiver that unexpectedly gives new and useful results may be made the subject of a separate application.

11.08
PRODUCT CLAIMS

In product claims, the product may be defined in three ways:

(i) By structure. In the chemical field this includes empirical formulae, structural formulae, and chemically acceptable names.
(ii) In terms of the process by which it is made. These are known as product-by-process claims.

(iii) In terms of physical or chemical properties.

A claim that defines a product by a mixture of two or three of these forms is also possible.

The most explicit and definite form of claims for a product defines the product by structure. Since, under subsection 27(4) of the Patent Act, the applicant is required to distinguish any new product from all other products by claiming it distinctly and explicitly, the structure, if known, should be given in the claim.

11.08.01
Product-by-process Claims

A product-by-process claim defines the claimed product wholly or partly in terms of the process used to produce the product. The process limitations may be included within the product claim itself or the whole claim may be made dependent upon another claim directed to the process. The following examples show the two possible forms:

(i) The product made by heating A with B.

(ii) The product when made by the process of claim 1.

The use of past participle adjectives, such as welded, bent, molded or coated, is not construed as changing a product claim into a product-by-process claim.

A product-by-process claim, where permitted, must define the product explicitly and distinguish it from all other products. Hence, products that are already known may not be claimed by making them dependent on a new process (Hoffman-La Roche v. Commissioner of Patents 23 C.P.R. 1).

A product-by-process claim must be directed to the final product of the process claim upon which the product claim is made dependent.

11.09
MEANS CLAIMS

A "means" claim is one in which at least part of an invention is defined as a means or mechanism for performing an act, instead of reciting the element that performs the action.

Invention may exist in a new combination of old means (Lightning Fastener v. Colonial Fastener 51 RPC 349; Martin and Biro Swan v. H. Millwood 1956 RPC 125). Claims composed of more than one statement of old means are allowable, without defining structure, if there is invention in the new combination.

If a claim is composed of a single statement of means, it is objected to for being indefinite and contrary to subsection 27(4) of the Patent Act. The report of the examiner should indicate in detail why the claim contravenes subsection 27(4) of the Patent Act. It may, for example, be directed to the result desired rather than to the combination developed and illustrated to achieve that result.

A claim is also objected to if it contains a broad means statement at the point of invention, i.e., a statement that distinguishes the claim from the prior art, but which is so broad that it embraces all possible means without qualification for solving the problem facing the inventor and is in effect no more than a restatement of the problem or desired result.

Examples:

An application describes a sanding device that may be used in a direct-drive mode for removing stock from a work piece at a rapid rate or in an orbital mode for removing stock at a much slower rate to provide a smooth finish. The invention lies in the combined use of a known one-way clutch and a known reversible motor in an otherwise conventional rotary sander. Under prior art conditions, either two sanders were used or an attachment was employed to convert a device from a direct-drive sander to an orbital sander.

Claim (i) Means for operating a sanding device in either a direct-drive mode or an orbital mode.

This claim would be objected to under section 27 of the Patent Act. The applicant should claim a sander having the combination of a one-way clutch with a reversible motor.

Claim (ii) A surface-finishing device comprising a drive shaft, a driven element connected to receive drive from the drive shaft, a driven shaft mounted for rotation in said driven element about an axis eccentric to the axis of the drive shaft, means connecting the driven shaft to the driven element, a surface-finishing tool connected to be driven by the driven shaft, and automatic means for selectively connecting the surface-finishing tool directly to the drive shaft, or allowing said tool to rotate freely in an orbital path about the drive shaft axis.

This claim would be objected to for merely restating the desired result.

Claim (iii) A surface-finishing device comprising a drive shaft, a driven element connected to receive drive from the drive shaft, a driven shaft mounted for rotation in said driven element about an axis eccentric to the axis of the drive shaft, one-way clutch means connecting the driven shaft to the driven element, a surface-finishing tool connected to be driven by the driven shaft, and means for selectively driving the drive shaft in one direction or in an opposite direction.

This claim would be accepted as a novel combination of known means giving a new and unexpected result.

11.10
PROCESS, METHOD, METHOD OF USE AND USE CLAIMS

The CPO accepts process, method, method of use and use claims as explained under the following subheadings.

11.10.01
Process and Method Claims

A method is the series of steps to be followed either alone or in conjunction within a process in order to achieve a desired result. A method should be distinguished from a process, which includes the method and the substances to which it is applied. The overall process may be new even though the method is old.

A claim to a process which consists of applying a known method to chemically react known substances is patentable, providing the method has never before been applied to these substances and results in new, useful and unobvious products. (Ciba Ltd. v. Commissioner of Patents 27 C.P.R. 82; 30 C.P.R. 135).

11.10.02
Method of Use and Use Claims

When a claim to a compound has been found allowable in an application, then a claim to a method of use of that compound or a claim to the use of that compound is also allowable in the same application. When a claim to a compound has been found allowable to the inventor in one application, then claims in a different application of the same inventor to a use of that compound or methods of using that compound which are obvious from the utility disclosed for the compound, and upon which utility the patentability of the compound was predicated, are not allowed.

When a compound has been patented previously or is in the public domain, claims directed to the obvious use of this compound should be objected to for lacking patentable subject matter. Claims directed to a new and unobvious use of the same compound are allowable. Likewise, claims directed to a method of using the compound for a new unobvious purpose are allowable. Furthermore, when an invention is directed to a novel and unobvious use of a known compound, claims to this known compound with the

further recitation of a novel use are allowable (re application for patent of Wayne State University 22 C.P.R. (3d) 407).

When a device or machine is only a new instrument for carrying out an old method, only the device or machine can be patented. Since the utility of a device or machine is obvious from the description of the device or machine, the patentability of a method using such device or machine is determined by the state or the art.

Guidelines for method of use claims

(i) Method of use claims directed to medicinal use are rejected under Section 2 of the Patent Act in view of Tennessee Eastman v. Commissioner of Patents (1970) 62 C.P.R. 117; (1974) S.C.R. 111.

Example: Method of treating the symptoms of cognitive decline in a patient comprising administering to a patient an effective amount of compound X wherein said compound is used as a cholinergetic agent. (rejected)

(ii) Method of use claims directed to a medicinal treatment should be interpreted to include only those methods directed to curing or preventing diseases in humans or animals. Method claims directed to an industrial use should not be rejected.

Example: Method for enhancing the dressed carcass weight of meat-producing animals by increasing lean meat deposition and improving the lean meat to fat ratio comprising administering to said animals, before slaughter, either orally or parenterally, an effective amount of a compound X. (accepted)

(iii) Other types of method of use claims directed to an industrial use are allowable but must include manipulative steps. (The reasoning for the requirement of the presence of manipulative steps is to distinguish method of use claims from use claims.)

Example: Method of using compound X as an intermediate to prepare compound Y wherein compound X is reduced by hydroboration or catalytic hydrogenation. (accepted)

(iv) Method of use claims incorporating a use are also acceptable as long as they meet the requirement of a proper method claim (i.e., include a manipulative step). (accepted)

Example: Method of controlling agricultural bacteria which comprises incorporating into the locus to be treated an effective amount of compound X wherein said compound is used as a bacterial agent. (accepted)

(v) Similarly, product claims containing either a use or method definition are acceptable, provided that the method is not a method of medical treatment).

Example: Compound X for the use as an insecticide wherein said compound is applied to the locus of a tree trunk, (accepted).

Example: Compound Y for the treatment of viruses wherein said compound is administered to a patient intravenously, (not accepted because it contains a method of medical treatment).

Guidelines for use claims

(i) Use claims are permitted. Moreover, use claims incorporating method steps are acceptable as long as the use has been clearly identified and it is not a method of medical treatment. If the claim is complete and understandable without the method steps, then the claim as a whole is acceptable. The method steps merely provide a restriction to the previously recited use.

Example: Use of compound X as a herbicide. (accepted)

Use of compound X as a herbicide wherein an effective amount of the compound X is incorporated into the locus to be treated. (accepted)

Use of compound Y as an antiarrhythmic agent. (accepted)

Use of compound Y as an antiarrhythmic agent wherein an effective amount of the compound Y is administered to a patient. (not accepted). The addition of the "wherein" clause makes the use a method of medical treatment.

Use of machine Z for cutting. (accepted)
Use of machine Z for cutting wherein ... (accepted)

11.11
MARKUSH CLAIMS

In chemical cases, a claim directed to a genus expressed as a group consisting of certain specified materials is allowable (Ex parte Markush 1925, 340 U.S.O.G. 839) provided it is clear from the known nature of the alternative materials or from the prior art that the materials in the group possess at least one property in common which is mainly responsible for their function in the claimed relationship. Therefore, a Markush claim will generally be construed with a generic expression covering a group of two or more different materials (elements, radicals, compounds) as illustrated in the following examples:

A solvent selected from the group consisting of alcohol, ether and acetone...

A strip of a conductive metal selected from the group consisting of copper, silver and aluminium...

Occasionally, the Markush format may be used in claims directed to subject matter in the mechanical or electrical fields in a manner such as that illustrated in the example below:

> A means for attaching a wall panel to a framework wherein the attaching means is **selected from group consisting of** nails, rivets **and** screws...

11.12
SELECTION PATENTS

A selection from members of a previously known class of substances may be patentable if the substance selected is unobvious and affords a new and useful result. There must be a special advantage arising from the selected substance and any advantage, novel property or use must be fully characterized in the description. The substance should be defined in an explicit manner within the claim.

11.13
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

claims

construction

Mineral Separation v Noranda	12 CPR	99	1950
	69 RPC	81	1952
O'Cedar v Mallory Hardware	ExCR	299	1956
McPhar v Sharpe	35 CPR	105	1960
Metalliflex v Wienenberger	35 CPR	49	1961
	SCR	117	1961
Lovell v Beatty	41 CPR	18	1962
Burton Parsons v Hewlet	1 SCR	555	1976
Xerox v IBM	33 CPR (2d)	24	1977
Cutter v Baxter Travenol	68 CPR (3d)	179	1983
Johnston Controls v Varta	80 CPR (2d)	1	1984
Reading & Bates v Baker	18 CPR (3d)	181	1987
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Energy v Boissonneault	30 CPR (3d)	420	1990
Lubrizol v Imperial Oil	33 CPR (3d)	11	1990
	45 CPR (3d)	449	1992
Computalog v Comtech	32 CPR (3d)	289	1990
	44 CPR (3d)	77	1992
Procter & Gamble v Kimberly	40 CPR (3d)	1	1991
Welcome v Apotex	39 CPR (3d)	289	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Martinray v Fabricants	14 CPR (3d)	1	1991

Reliance v Northern Tel		47 CPR (3d)	55	1993
Airseal v M&I Heat		53 CPR (3d)	259	1993
Dableh v Ont Hydro		50 CPR (3d)	290	1993
Unilever v Procter & Gamble		47 CPR (3d)	479	1993
		61 CPR (3d)	499	1995
Nekoosa v AMCA	Int	56 CPR (3d)	470	1994
Anderson v Machineries		58 CPR (3d)	449	1994
Pallmann v CAE		62 CPR (3d)	26	1995
Hi-Quail v Rea's Welding		55 CPR (3d)	224	1994
Feherguard v Rocky's		53 CPR (3d)	417	1994
		60 CPR (3d)	512	1995
Cochlear v Coseum		64 CPR (3d)	10	1995
Pallmann v CAE		62 CPR (3d)	26	1995
Almecon v Nutron		65 CPR (3d)	417	1996

positive recitation

Mineral Separation v Noranda		12 CPR	99	1950
		69 RPC	81	1952
Burton Parsons v Hewlet		1 SCR	555	1976
Eli Lilly v O'Hara		20 CPR (3d)	342	1988
		26 CPR (3d)	1	1989
Hi-Quail v Rea's Welding		55 CPR (3d)	224	1994
Pallmann v CAE		62 CPR (3d)	26	1995

antecedents

Mobil Oil v Hercules		57 CPR (3d)	488	1994
		63 CPR (3d)	473	1995

preamble

Re: Lelke		72 CPR (2d)	139	1981
Shell Oil v Comm of Pat		2 SCR	536	1982
Rucker V Gavels Vulcanizing		7 CPR (3d)	294	1985
Permacon v Enterprises		19 CPR (3d)	378	1987
Re: Neuro Med Inc		28 CPR (3d)	281	1988
Computalog v Comtech		44 CPR (3d)	77	1992

explicit, distinct v ambiguous/several interpretations

Rohm & Haas v Comm of Patents		30 CPR	113	1959
Xerox v IBM		33 CPR (2d)	24	1977
Monsanto v Comm of Pat		42 CPR (2d)	161	1979
		2 SCR	1108	1979
Ciba Geigy v Comm of Pat		65 CPR (3d)	73	1982
Pioneer Hi-Bred v Com of Pat		14 CPR (3d)	491	1987
		25 CPR (3d)	257	1987
Reliance v Northern Tel		28 CPR (3d)	397	1989
		44 CPR (3d)	161	1992
		47 CPR (3d)	55	1993

Risi Stone v Groupe Peracon	29 CPR (3d)	243	1990
	65 CPR (3d)	2	1995
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995

insufficient/sufficient/essential elements

BVD Co V Canadian Celanese	ExCR	139	1936
	SCR	221	1937
Mineral Separation v Noranda	12 CPR	99	1947
	15 CPR	133	1952
Curl Master v Atlas Brush	SCR	514	1967
Burton Parsons v Hewlet	1 SCR	555	1976
Re: Farbwerke Hoechst	13 CPR (3d)	212	1980
Ciba Geigy v Comm of Pat	65 CPR (3d)	73	1982
Consolboard v MacMillan	56 CPR (2d)	145	1981
	1 SCR	504	1981
Ductmate v Exanno	2 CPR (3d)	289	1984
Amfac Foods v Irving Pulp	12 CPR (3d)	193	1986
Crila Plastics v Ninety Eight	10 CPR (3d)	226	1986
	18 CPR (3d)	1	1987
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
TRW Inc v Walbar	39 CPR (3d)	176	1991
Atlas v CIL	41 CPR (3d)	348	1992
Airseal v M&I Heat	53 CPR (3d)	259	1993
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995
Feherguard v Rocky's	53 CPR (3d)	417	1994
	60 CPR (3d)	512	1995

operability

Union Carbide v Trans Canadian	ExCR	884	1965
Mineral Separation v Noranda	12 CPR	99	1950
	69 RPC	81	1952
Gilbert (Gillcross) v Sandoz	64 CPR	14	1970
	SCR	1336	1974
Burton Parsons v Hewlet	1 SCR	555	1976
Sandvick v Windsor	8 CPR (3d)	433	1986
Mahurkar v Vas-Cath	18 CPR (3d)	417	1988
Welcome v Apotex	39 CPR (3d)	289	1991
TRW Inc v Walbar	39 CPR (3d)	176	1991
Feherguard v Rocky's	53 CPR (3d)	417	1994

	60 CPR (3d)	512	1995
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995

broad

BVD Co V Canadian Celanese	ExCR	139	1936
	SCR	221	1937
Trubenizing v John Forsyth	2 CPR	1	1943
O'Cedar v Mallory Hardware	ExCR	299	1956
Lovell v Beatty	41 CPR	18	1962
Boehringer v Bell-Craig	39 CPR	201	1962
Union Carbide v Trans Canadian	ExCR	884	1965
Hoechst v Gilbert	SCR	189	1966
Gilbert v Sandoz	64 CPR	14	1970
Burton Parsons v Hewlet	1 SCR	555	1976
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Re: American Home Products	55 CPR (2d)	238	1980
Re: Farbwerke Hoechst	13 CPR (3d)	212	1980
Cutter v Baxter Travenol	50 CPR (2d)	163	1980
	68 CPR (3d)	179	1983
Johnston Controls v Varta	80 CPR (2d)	1	1984
Sandvick v Windsor	8 CPR (3d)	433	1986
Amfac Foods v Irving Pulp	12 CPR (3d)	193	1986
Cabot Corp v 318602 Ont	20 CPR (3d)	132	1988
Mahurkar v Vas-Cath	18 CPR (3d)	417	1988
Reliance v Northern Tel	28 CPR (3d)	397	1989
	44 CPR (3d)	161	1992
	47 CPR (3d)	55	1993
	55 CPR (3d)	299	1994
Risi Stone v Groupe Peracon	29 CPR (3d)	243	1990
Lubrizol v Imperial Oil	33 CPR (3d)	1	1990
	45 CPR (3d)	449	1992
Welcome v Apotex	39 CPR (3d)	289	1991
Dableh v Ont Hydro	50 CPR (3d)	290	1993
Unilever v Procter & Gamble	47 CPR (3d)	479	1993
	61 CPR (3d)	499	1995
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995
Nekoosa v AMCA	Int 56 CPR (3d)	470	1994
Pallmann v CAE	62 CPR (3d)	26	1995
Almecon v Nutron	65 CPR (3d)	417	1996

selection/improvement

Sherbrooke v Hydrolic	Ex CR	114	1927
Bergeon v De Kermor	Ex CR	181	1927
Western Electric v Bell	Ex CR	213	1929
Wandscheer v Sicard	SCR 1		1948
K v Uhleman Optical	Ex CR	142	1950
	1 SCR	143	1952
O'Cedar v Mallory Hardware	Ex CR	299	1956
Ciba Geigy v Comm of Pat	27 CPR	82	1957
	30 CPR	135	1959

aggregation/combination

Lightning Fastener v Colonial	ExCR	89	1932
	SCR	363	1933
	51 RPC	349	1934
Crosley Radio v CGE	SCR	551	1936
Lanlois v Roy	Ex CR	197	1941
Lester v Comm of Pat	Ex CR	603	1946
Wandscheer v Sicard	Ex CR	112	1946
	SCR 1		1948
R v Uhleman Optical	Ex CR	142	1950
	1 SCR	143	1952
Defrees v Dominion Auto	ExCR	331	1963
Barton v Radiator Specialty	44 CPR	1	1965
Gibney v Ford	2 Ex CR	279	1972
Rubbermaid v Tucker Plastics	8 CPR (2d)	6	1972
Agripat v Comm of Patents	52 CPR (2d)	229	1977
Domtar v MacMillan	33 CPR (2d)	182	1977
Xerox v IBM	33 CPR (2d)	24	1977
Ductmate v Exanno	2 CPR (3d)	289	1984
Windsurfing v Triatlantic	3 CPR (3d)	95	1984
Hy Kramer v Lindsay	9 CPR (3d)	297	1986
Crila Plastics v Ninety Eight	10 CPR (3d)	226	1986
	18 CPR (3d)	1	1987
Hoffman-La Roch v Apotex	15 CPR (3d)	217	1987
	24 CPR (3d)	289	1989
Standal v Swecan	28 CPR (3d)	261	1989
Imperial Tobacco v Rothmans	47 CPR (3d)	188	1993

CHAPTER 12

CLASSIFICATION

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- 12.06.01 Search Tools
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CHAPTER 12
CLASSIFICATION

12.01
INTRODUCTION

Classification is a systematic arrangement or subdivision of subject matter along the lines necessary for facilitating the investigation or search of subject matter. Such an arrangement is provided in the Canadian Patent Office (CPO) and represents a vast amount of scientific and technical information encompassed in published patent documents. The selective retrieval of such information is thus facilitated.

This chapter provides basic information regarding classification in the CPO. More detailed information can be found in the following manuals: the International Patent Classification (IPC) Guide, the Handbook on Industrial Property Information and Documentation published by the World Intellectual Property Organization (WIPO), and the Handbook of Patent Classification (HOPC) published by the CPO.

12.02
INTERNATIONAL PATENT CLASSIFICATION

The CPO classifies all Canadian patent documents filed on or after October 1, 1989 according to the edition of the International Patent Classification (IPC) in effect at the filing date of the application or the issue date of the patent. An IPC code is also applied to applications allowed after October 1, 1996 but filed before that date.

12.02.01
IPC Layout

A complete IPC symbol is composed of the designations for the section, class, subclass, main group, and subgroup. The subgroup consists of at least 2 digits; any third or subsequent digit is to be understood as a decimal subdivision of the digit preceding it.

For example: in IPC6 "A61K 31/025";

"A"	is the Section,
"61"	is the Class,
"K"	is the Subclass,
"31"	is the Main Group, and
"02.5"	is the Subgroup.

12.02.02
IPC Hierarchical Structure and Other Useful Information

The word "hierarchy" describes the indented layout of the IPC. The hierarchy within a group is determined solely by the number of dots preceding the titles of the subgroups, and not by the numbering of the subgroups. In the example shown below, notice the indentation within main group B62D 33/00.

A multipart title comprises two or more distinct parts separated by semicolons. Each part of the title is to be understood as if it stood alone. In the example shown below, notice the title of subclass B62D and the title of subgroup B62D 33/02.

A reference is a bracketed phrase that refers to another place in the classification. A reference may serve to limit scope, to indicate precedence, or to guide. In the example shown below, notice the two references in group B62D 33/00.

A note defines specific words, phrases or the scope of places and indicates how subject matter is classified. A note applies only to the places concerned and takes precedence if it disagrees with any general guidance reference. In the example shown below, notice the note under subclass B62D.

Example of IPC6:

B62D MOTOR VEHICLES; TRAILERS

Note: In this subclass, the following terms are used with the meanings indicated:
- "vehicles" includes motor vehicles and trailers;
- "trailers" includes forecars or sidecars.

33/00 Superstructures for load-carrying vehicles (in which a load-carrying element is movable B 60 P; liners B 60 R 13/00)
33/02 . Platforms; Open load compartments
33/023 . . Sideboard or tailgate structures [5]
33/027 . . . movable [5]
33/03 . . . . by swinging down [5]
33/033 . . . . removable [5]
33/037 . . . . Latching means therefor [5]

12.02.03
IPC Classification of Inventions

Typically, Canadian Patent documents are provided with several IPC symbols. The symbol which most adequately represents the invention information, should be listed first. The other IPC symbols relate either to further places in the Classification where other non-trivial aspects of invention information may need to be classified, or to additional information, i.e. non-trivial technical information given in the description which is not claimed, but might constitute useful information for the searcher. The classification of

invention information is obligatory, additional information, while desirable, is non-obligatory.

The IPC provides places for classifying inventions that are function-oriented and application-oriented. A function-oriented invention is characterized by its intrinsic nature or function, being either independent of a particular field of use or technically not affected if statements about the field of use are disregarded. For example, subclass F16K provides for valves characterized by constructional or functional aspects, i.e. the structure of the valve does not depend on the nature of the fluid passing therethrough or on any system of which the valve may form a part. Another example is class C07 which provides for organic chemical compounds characterized by their chemical structure but not their application. An application-oriented invention may be an invention specially adapted for a particular use or purpose. Special adaptations include modifications or particular constructions for the given use or purpose. For example, subclass A61F provides for a mechanical valve specially adapted for insertion into a human heart. An application-oriented invention may also be a particular use or application in itself. For example, class C05 provides for the use of an organic chemical compound as a fertilizer. Finally, an application-oriented invention may be the incorporation of an invention into a larger system. For example, subclass B60G provides for the incorporation of a leaf spring into the suspension of a vehicle (leaf springs per se are provided for in F16F).

12.02.04
IPC Considerations when Searching

When searching for a technical subject in files classified according to the IPC, due consideration to both the function and application of the subject should be considered in order to improve the likelihood of locating similar art.

If the technical subject is covered by more than one subgroup under the same main group and at the same level of indentation, but resides merely in the combination of matter covered by each of those subgroups separately without the matter itself being of interest, a search should be directed to the hierarchically higher subgroup unless a specific subgroup is provided for such combination. However, if the technical subject is covered under different main groups, and there is not provided a "general" main group, the search can be directed to each of these groups.

In certain places of the IPC some particular rules are specified for the purpose of limiting multiple classification, improving consistency and facilitating searching without harming its quality. The places where such rules apply are clearly marked by a note at the highest place covered by such classifying rules.

In the absence of clearly specified notes, an invention is classified in the subgroup best defining the invention. Since groups within a subclass are mutually exclusive, there is no hierarchical relationship between groups and as such, inventions are not classified in the first appearing group.

In certain places of the IPC where a particular subject matter is covered by two or more

places of the same hierarchical level or indentation a last place rule has been introduced. According to this rule, such a subject matter is only classified in the one of these places which appears last in the IPC. This rule is applied successively at each hierarchical level or indentation at which the subject matter in question is covered by two or more places. In each part of the IPC where this rule applies there appears a note which clearly sets out the subject matter concerned. For example, see A61K, C07, C08G, C10M, G07D 5/00. The last place rule is in effect a systematic precedence rule which obviates the need for separate precedence references in each of the places concerned.

12.03
CANADIAN PATENT CLASSIFICATION

All Canadian patent documents filed prior to October 1, 1989 are classified according to the Canadian Patent Classification (CPC). This section provides basic information on the layout and use of the CPC.

12.03.01
CPC Layout

A complete CPC symbol is composed of the designations for the class and subclass.

For example: in CPC "363/26";

"363" is the Class, and
"26" is the Subclass.

12.03.02
CPC Hierarchical Structure and Other Useful Information

The hierarchy within a Canadian class is determined by the number of dots preceding the titles of the subclasses and the order of appearance in the class of coordinate subclasses (same number of dots). In the example shown below, notice the indented structure of the subclasses.

A CPC class is generally organized with subclasses providing for more complex subject matter placed before subclasses providing for less complex subject matter. Therefore, subclasses providing for specialized subject matter precede subclasses providing for basic subject matter. Similarly, subclasses providing for combinations precede subclasses providing for subcombinations.

In a CPC class the first appearing of a series of coordinate subclasses (same number of dots) is exhaustive of the subject matter for which the subclass provides. For example, consider the following subclasses in a class of supports:

1 STANDS
2 . Adjustable Vertically
3 . . Standard Type
4 . Standard Type

In order to search for vertically adjustable standard type stands, one need only consult subclasses 2 and 3 because these subclasses exhaust all vertically adjustable stands. Thus, subclass 4, a coordinate of subclass 2, provides for all stands of standard type except those which are vertically adjustable.

In some arts which include an abundance of multifaceted subject matter, generically-claimed subject matter, or alternately-claimed subject matter (Markush type), a CPC class is subdivided in subclasses on one basis along with some generic subclasses being further subdivided on another basis. The subclasses subdivided on the second basis are called modified hierarchy and are usually indicated by the letters M.H., double indentation, a box around the subclass, or the words Markush group. In using a CPC class comprising M.H. subclasses, one bypasses the M.H. subclasses on the initial search for a proper subclass. If no specific subclass providing for the subject matter is found, then the appropriate M.H. subclass is used. If no appropriate M.H. subclass is found, then an appropriate generic subclass is used.

For example: Class 402: Synthetic Macromolecules

1 SYNTHETIC MACROMOLECULES
3 M.H. Modified or Cross-Linked
5 M.H. Treating
31 . From Oxo Compounds
246 . From Cyclic Ethers
353 . From Phosphorous-Containing Compounds
372 . From Unsaturated Compounds

The CPC schedules are supplemented with class and subclass definitions which are of primary importance in describing the subject matter that is intended to be grouped within a class or subclass. A class definition comprises a class statement which defines the nature of subject matter and its scope within the class. The class definition may be supplemented with notes such as definitions of terms used within a class, notes outlining the main groupings of subject matter of the class for the purpose of understanding the class breakdown, notes explaining the limits of the class as to what subject matter is included or excluded in relation to other classes, and notes showing where related or similar subject matter is classified in other classes. A subclass definition comprises a subclass statement which defines the nature of subject matter and its scope within the subclass. The subclass definition may be supplemented with notes such as specific examples of the type of subject matter encompassed in the subclass and notes indicating where related or similar subject matter is classified in other subclasses within the class or other classes.

12.03.03
CPC Classification of Inventions

The first appearing CPC code on a patent document is the primary CPC. Any other appearing CPC codes are cross-references.

It is of great importance that the technical subject(s) with which the invention in a patent document is concerned be identified accurately Claims must be read in the light of the disclosure in order to determine the appropriate place in the CPC.

The CPC provides places for classifying inventions that are structure-oriented and utility-oriented. A structure-oriented invention, which may include a composition, is characterized by being so simple in its nature and of such general utility as to make it difficult to ascertain a function or utility. A utility-oriented invention is characterized by being based on a function, a result, or an art field.

12.03.04
CPC Considerations when Searching

When searching for a technical subject in files classified according to the CPC, due consideration to both the structure and utility of the subject should be considered in order to improve the likelihood of locating similar art.

Many arts are classified into groups of related classes each having one class generic to the others in the group. The material handling arts, for example, have been dealt with in this manner. Class 201, Material and Article Handling is the generic class to a number of other classes such as; Class 212, Material and Article Handling: Crane Hoists and Draglines; Class 214, Material and Article Handling: Mobile Handlers; and others. When searching in a specific class it is advisable to check the class definitions for a generic class which contains relevant art.

Some subclasses in a class are superior to others. Where the claims of an application set forth a combination of features provided for individually in the subclass schedule, two situations can arise. If the subject matter is partially provided for by two or more equally indented subclass titles (under the same genus), it is classified in the first appearing subclass which provides for a part of the combination. If the subject matter is partially provided for by two subclass titles, one of which is indented under the other, it is classified in the indented subclass.

For example: Class 211: Supports, Racks

2 POWER OPERATED
18 ROTATABLE
20 . Shelf type
30 SHELF TYPE

A combination of a rotatable rack or a shelf type rack with power operating means is

classified in subclass 2, the first appearing subclass of the first line subclasses 2, 18 and 30 which provides for one of the subcombinations. A search for the subject matter should be made in subclass 2 only, as no other combinations including power operating means can appear below subclass 2 or its indented subclasses (if any).

A rotatable shelf-type rack is classified in indented subclass 20. A search for the subject matter should be made in subclass 20 where it is classified and also in subclass 2 where rotatable shelf-type racks which are power-operated are classified.

In chemical practice, the abundance of generically claimed and alternately claimed (Markush-type) subject matter has generated highly indented chemical schedules. Because generically claimed and alternately claimed inventions are classified in the more generic subclass, it is necessary to search "up-and-to-the-left". Subclasses of equal indentation may be searched on an individually selected or non-systematic basis.

12.04
STANDARD INDUSTRIAL CLASSIFICATION

The Standard Industrial Classification (SIC) was elaborated by Statistics Canada to collect statistics on economic activities of the various industries in Canada. The CPO assigns SIC codes to patent documents for the purpose of correlating patenting activity to economic activity.

The SIC codes on patent documents are used to form the PATDAT database which includes information dating back to 1978. Copies of the PATDAT database have been provided to outside organizations such as Statistics Canada. More detailed information may be obtained from the Information Branch in the Canadian Intellectual Property Office (CIPO).

12.05
UNITED STATES PATENT CLASSIFICATION

The CPO does not classify patent documents according to the United States Patent Classification (USPC). However, the CPO does provide a collection of US patents in the search room classified according to the USPC.

The layout and use of the USPC is quite similar to the Canadian Patent Classification (CPC) and therefore section 12.03 of this manual may be consulted in order to better understand this classification system. Additionally, the Development and Use of Patent Classification Systems (DUPACS) manual published by the United States Patent and Trademark Office should be consulted.

It should be noted that the filing system of paper copies of US patents is slightly different from the system used in the United States. In the CPO, an American patent is filed according to the USPC at the time of publication and will not be refiled if the USPC is subsequently changed. Therefore the CPO provides old US class schedules which are necessary for retrieval of older subject matter. For example, in order to find a US 1940

patent, the US class schedule of this period may be consulted.

Should searchers with the support of CPO Search Information Officers have difficulty in the use of the USPC, CPO classification examiners are available for consultation in order to assist retrieving American patent documents.

12.06
SEARCHING

The CPO provides search facilities for examiners, patent agents, and public searchers. The types of searches performed may include novelty, state-of-the-art, infringement or right to manufacture, validity, and title searches. A sound knowledge of the tools available and some search strategies will prove valuable towards an effective search. Guidance on these topics is provided by the search room staff and in more difficult cases by the CPO classification examiners. More detailed information can be found in the Handbook of Patent Classification (HOPC).

12.06.01
Search Tools

The primary tools available to a searcher are the IPC, CPC, and USPC class schedules. Accompanying the schedules are the subject matter indexes comprising alphabetically arranged subjects and their corresponding classification. In the case of CPC and USPC schedules, these are further supplemented with class and subclass definitions which aid in the interpretation of their scope. A detailed explanation of these tools can be found in this manual in section 12.02, 12.03, and 12.05.

The classification division of the CPO has also elaborated concordances between the IPC and CPC which aid in some cases to identify similar subject matter between the two systems.

Electronic support for Canadian patent documents is provided by the TECHSOURCE Inquire Text system. Additional electronic support is provided by the CASSIS system for American patents and by the ACCESS system for European and Patent Cooperation Treaty (PCT) patent documents.

12.06.02
Search Strategies

The first and probably most important step in searching is to precisely define the subject matter of the search. It is also important to consider the type of search that will be performed, such as novelty or validity.

Perusal of the subject matter indexes will usually point to a general class in the IPC, CPC, and USPC. Further scrutiny of the class schedules and the class definitions if applicable will then lead to the correct places in the classification under which the subject matter is to be found. Reference to the IPC and CPC concordances may also be of help when a good classification place is only found in one system.

When searching the electronic databases, classifications, keywords, and perhaps combinations thereof will usually prove successful in locating pertinent subject matter.

Should searchers with the support of CPO Search Information Officers have difficulty in locating pertinent art, CPO classification examiners are available for consultation.

CHAPTER 13

EXAMINATION OF APPLICATIONS

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CHAPTER 13
EXAMINATION OF APPLICATIONS

13.01
SCOPE OF THE CHAPTER

This chapter presents an overview of the procedures followed during the examination of a patent application. Generally, an application is examined in order depending on the date on which the request for examination is made. Special order status may be given under the circumstances described in Section 13.03.

The examiner searches the prior art, including any art supplied by the applicant under section 29 of the Patent Rules to determine that the invention is novel and unobviousness. The application is also examined for conformance with all sections of the Patent Act and the Patent Rules.

When an examiner determines that an application complies with the Act and Rules, a Notice of Allowance is issued to the applicant.

Where the examiner finds that the application does not comply with the Act and Rules, an examiner's report is issued requisitioning amendment of the application to comply. Where an impasse between the examiner and the applicant is reached a Final Action is issued by the examiner refusing the application. The prosecution before the examiner is terminated unless the applicant amends to comply with the requisition of the examiner. The Patent Appeal Board and the Commissioner of Patents then determine whether the application is allowed or refused.

An application that is refused by the Commissioner cannot issue to patent unless so dictated by an appeal to the courts.

After a Notice of Allowance is issued on an application, the applicant must pay the final fee within six months of the notice.

An application may be withdrawn from allowance by the Office, before it issues to patent, if the Commissioner has reason to believe that the application does not comply with the Act or the Rules.

Upon payment of the final fee, the application is processed through to issue.

13.02
REQUEST FOR EXAMINATION

Applications are not examined automatically (see subsection 35(1) of the Patent Act). The applicant (or any other party) must first make a written request for examination, and pay the prescribed fee. Subsections 95 and 96 of the Patent Rules sets forth the details required with such a request.

The request for examination shall contain:

a) the name and address of the person making the request;

b) if the person making the request is not the applicant, the name of the applicant; and

c) information, such as the application number, sufficient to identify the application.

A request for examination must be made within five years from the date of filing in Canada (subsection 96(1) of the Patent Rules) to avoid abandonment. In the case of a divisional application, the request must be made within five years of the filing of the original application in Canada, or within six months of the filing of the divisional in Canada, whichever occurs later (subsection 96(2) of the Patent Rules).

NOTE: For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, requests for examination must be made within 7 years from the date of filing in Canada (subsection 150(1) of the Patent Rules).

The Commissioner may by notice require an applicant to make a request for examination (subsection 35(2) of the Patent Act) within three months of the notice (sections 25, 97, and 151 of the Patent Rules). Failure to comply with the Commissioner's notice will result in abandonment of the application pursuant to paragraph 73(1)(e) of the Patent Act.

Any person other than the applicant may request examination of an application by submitting a request and paying the required fee (subsection 35(1) of the Patent Act). The CPO will inform the applicant by letter that a third party has requested examination of the application.

The fee payable on requesting examination of an application is not refundable or transferable.

Failure to request examination within the specified time period will result in abandonment of the application (paragraph 73 (1)(d) of the Patent Act). The application may be reinstated upon request and upon payment of the prescribed fee(s) within 12 months from the date of abandonment (section 98 of the Patent Rules).

13.03
REQUESTS FOR ADVANCED EXAMINATION (SPECIAL ORDER)

Applications are generally examined in order according to the date on which the request for examination is made. Under section 28 of the Patent Rules, the applicant or any other person may request advanced examination of an application. To obtain advanced examination the requester must make a written request establishing that failure to advance the application is likely to prejudice that person's rights and must pay the prescribed fee (Item 4 of Schedule II of the Patent Rules). The request must also be accompanied by, or preceded by a request for examination under subsection 35(1) of the Patent Act and by the fee as set out in Item 3 Schedule II of the Patent Rules.

An application must be open to public inspection under section 10 of the Patent Act in order for a request for advanced examination to be granted (subsection 28(2) of the Parent Rules. The applicant may request early opening of the application (subsection 10(2) of the Patent Act) simultaneously with the request for advanced examination. There is no additional fee required for early opening. A third party cannot request early opening of another party's application and must therefore, wait until the application is opened under the provisions of subsection 10(2) of the Patent Act.

Where a third party requests advanced examination of an application, the CPO will inform the applicant by letter that a third party has requested advanced examination.

Verbal requests for advanced examination are not granted.

The Commissioner does not grant advanced examination status to an incomplete application. Any person requesting advanced examination on such an application is informed, by office letter, that the request will be considered when the application is in proper order.

A divisional application, once it has been completed and an examination request and fee has been received, may be accorded advanced examination status upon request and upon payment of the advanced examination fee.

The advanced examination status remains in effect until disposal of the application or withdrawal by the requester. An application under advanced examination is given immediate action whenever it is in proper condition for examination.

13.04
PRIOR ART CITATIONS FROM FOREIGN PROSECUTION

The applicant may be asked to provide information and copies of any documents related to the prosecution of corresponding applications in other countries including details of;

(a) any prior art cited against those applications,
(b) application numbers, filing dates and patent numbers,
(c) conflict, opposition, re-examination or similar proceedings, and

(d) translations of documents not in English or French.

Generally, at the time that the office acknowledges the receipt of a request for examination on an application, the applicant is asked to consider providing particulars of the prior art cited in the prosecution of corresponding foreign applications when such information becomes available. The above information may also be requisitioned by the examiner according to section 29 of the Patent Rules during the prosecution of the application. Failure to respond to an examiner's requisition will result in abandonment of the application (paragraph 73(1)(a) of the Patent Act).

All prior art information and other information provided under section 29 of the Patent Rules will be taken into account by the examiner at the time of examination.

13.05
EXAMINATION

A careful examination of each patent application is made by competent examiners employed in the Patent Office in accordance with subsection 35(1) of the Patent Act. A patent, granting an exclusive property in the invention, is only obtained providing the applicant complies with all requirements of the Act. It is the role of the examiner to ensure that all the relevant sections of the Patent Act and the Patent Rules are met before issue of the patent.

After careful study of the specification by the examiner to ascertain the scope of the invention described and claimed in the application, the examiner performs a thorough search of the prior art related to the technical area of the invention. The examiner also examines the abstract, description, drawings, photographs, sequence listings, and claims for conformance to the relevant sections of the Patent Act and Patent Rules.

13.05.01
Search of the Prior Art

A search of the prior art of the technical area of the invention is carried out to establish that the invention claimed in the patent application is novel (section 2, and subsection 28.2 (1) of the Patent Act) and is not obvious to a person skilled in the art or science to which it pertains (section 28.3 of the Patent Act).

A classification examiner determines the main International Patent Classification (IPC) class, subclass, group and subgroup for the subject matter of the claims of the application as well as cross reference classifications and the Canadian Patent Classification (CPC) class and subclass. These classifications are used by the examiner to conduct a search of the prior art patents.

For the search, the examiner has access to patent documents from the following countries; Australia, Austria, Belgium, Bulgaria, Czechoslovakia, Canada, France, Germany, Great Britain, Hungary, Japan, Netherlands, Norway, Poland, Spain, Sweden, Switzerland, Romania and the United States as well as patent documents from the

European Patent Office and Patent Cooperation Treaty publications. The examiner also has access to on-line search services such as INPADOC, ORBIT and STN for keyword searching. Printed publications can also be obtained through the Departmental Library.

Prior art citations provided by the applicant regarding prosecution of corresponding foreign applications are also scrutinized by the examiner.

Prior art references which have a bearing on the novelty or obviousness of the invention claimed in the application are cited against the application in an examiner's report. Details of art citation for lack of novelty and obviousness are presented in Chapter 15 of this manual. The examiner requisitions the applicant to amend the application to overcome the art citations.

13.05.02
Defects in the Application

In addition to the search of the prior art, the examiner inspects various parts of the patent application for compliance with the applicable sections of the Act and the Rules. In particular, the abstract, description, claims, drawings, photographs, and sequence listings are each reviewed.

The purpose of the abstract is to provide a brief description of and utility for the invention disclosed in the patent specification so as to enable the reader to determine quickly if the entire patent specification would be of interest to him. A full discussion of the requirements of the Act and Rules regarding abstracts is presented in Chapter 8 of this manual.

The description must correctly and fully describe the invention and its operation or use as contemplated by the inventor. It must clearly set out the invention in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected to put the invention into practice. The invention should be described in such a manner as to distinguish it from other inventions. The office practice and the relevant sections of the Patent Act and Patent Rules which apply to the description are given in Chapter 9 of this manual.

Drawings or photographs are necessary in an application for a machine or an invention which admits of illustration by means of drawings or photographs. The drawings must clearly show all the parts of the invention and must include references corresponding with the description. Chapter 10 of this manual deals with the requirements of the Act and Rules for drawings and photographs.

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed. The criteria that must be met for acceptable claims in a patent application are discussed in detail in Chapter 11 of this manual.

Any defects found in the application are reported to the applicant in an examiner's report.

An application which is found to fully comply with all of the relevant sections of the Patent Act and the Patent Rules is allowed by the examiner and a Notice of Allowance is issued to the applicant.

13.06
EXAMINER'S REPORT

Where an examiner finds that an application does not comply with the Act or the Rules, an examiner's report is issued to the applicant, in accordance with subsection 30(2) of the Patent Rules, objecting to the defects found.

In the report the examiner also requisitions the applicant to amend the application in order to comply with those sections of the Act or Rules identified in the report, or to provide arguments as to why the application does comply.

The time limit for responding to an examiner's requisition is the six-month period after the requisition is made or within any shorter period established by the Commissioner, in accordance with paragraph 73(1)(a) of the Act.

The examiner's report generally includes the following;

a statement of the authority for issuing the report (section 30(2) of the Patent Rules),

the time limit for response to the examiner's requisition (paragraph 73(1)(a) of the Patent Act),

a statement of the status of the application at the time of examination (as filed, as amended on specified date, subject to the Commissioner's Decision, correspondence received and reviewed),

an indication of the number of claims on file,

the results of the prior art search, or limitations made to the prior art search and reasons for the limitations,

objections to the defects found in the application, including a reference to the applicable sections of the Act or Rules with which the application fails to comply, and

a requisition for amendment of the application to comply with the cited sections of the Act and Rules.

Failure to respond to an examiner's requisition within the time limit specified in the report will result in abandonment of the application as per paragraph 73(1)(a) of the Patent Act. An abandoned application can be reinstated upon applying for reinstatement, paying the reinstatement fee, and taking the action which was necessary to avoid the abandonment

originally (in this case respond to the examiner's requisition).

13.06.01
Withdrawal of Examiner's Report

If an outstanding examiner's report is no longer applicable in view of correspondence which renders the action unapplicable or unnecessary the examiner directs the examination assistant to cancel the report and notify the applicant of the cancellation by Office letter, and, as a courtesy, also by telephone, if practical. The application file will indicate that the report has been withdrawn and the time limit that was set for response does not apply.

13.07
AMENDMENT OF THE APPLICATION

Amendments to applications are permitted under section 38.2 of the Patent Act. Applicants may amend their applications either on their own initiative or in response to an examiner's requisition. The amendment must comprise new pages for any changes to the application made by the amendment, and a supporting explanation. Under section 34 of the Patent Rules every amendment must be accompanied by a written statement explaining the nature of the amendment and its purpose. If the amendment is in response to an examiner's requisition, the written statement must explain the manner in which the amendment overcomes each of the objections made by the examiner.

Section 38.2 of the Patent Act restricts the contents of amendments. The restriction is that no new subject matter may be introduced. Only matter reasonably to be inferred from the specification and drawings as originally filed may be added to either the specification or drawings.

All applications that have been amended are subject to further examination. Any defects introduced by an amendment, will be addressed in a subsequent examiner's report. Amended applications, except those amended after allowance, are also subject to a further search of the prior art.

A detailed discussion of the restrictions and office procedures regarding amendments to patent applications is given in Chapter 19 of this manual.

13.08
FINAL ACTION

Occasionally, during the prosecution of an application, an impasse is reached between the examiner and the applicant on a particular defect of the application. Where the applicant does not comply with a requisition of the examiner to amend the application, and the examiner still believes that the application is defective for not conforming to the applicable section of the Act or Rules, the examiner may reject the application in a Final Action (subsection 30(3) and (4) of the Patent Rules). The Final Action terminates the prosecution of the application before the examiner unless the applicant submits an

amendment that satisfies the requisition of the examiner (subsection 30(5) of the Patent Rules).

Chapter 21 of this manual provides a detailed discussion of the office procedures for Final Action.

13.09
REFUSAL TO GRANT A PATENT

Whenever the Commissioner is satisfied that the applicant is not by law entitled to be granted a patent, the Commissioner refuses the application in accordance with section 40 of the Patent Act.

The refusal is generally preceded by a Final Action issued by the examiner responsible for the substantive examination of the application. The reason for the Commissioner's refusal must be based on non-compliance with one or more sections of the Patent Act or the Patent Rules.

The Commissioner must notify the applicant by registered letter of the refusal and the ground or reason therefor. The notification generally bears the notation "Decision of the Commissioner of Patents" and provides a justification for the refusal based on the Patent Act, Patent Rules and pertinent jurisprudence.

An applicant whose application for patent has been refused by the Commissioner pursuant to section 40 of the Patent Act may appeal the decision of the Commissioner to the Federal Court. The time limit for taking the appeal is the six-month period after the notice of the Commissioner's Decision is mailed.

13.10
ALLOWANCE AND NOTICE OF ALLOWANCE

Where the examiner, after substantive examination of the application, finds that it is in compliance with all requirements of the Patent Act and the Patent Rules, the examiner issues a Notice of Allowance in accordance with subsection 30(1) of the Patent Rules.

The Notice of Allowance advises that the patent application has been found allowable by the examiner and may issue to Letters Patent upon payment of the final fee. The notice also requisitions the payment of the final fee (item 6 of Schedule II of the Patent Rules) within six months of the date the notice was mailed (paragraph 73(1)(f) of the Patent Act).

Where the final fee is not paid within six months from the date of the notice, the application for patent is abandoned in accordance with paragraph 73(1)(f) of the Patent Act. An abandoned application may be reinstated upon applying for reinstatement, paying the reinstatement fee and taking the action which was necessary to avoid the abandonment (in this case paying the final fee). A reinstated application is subject to amendment and further examination and search of the prior art before a new Notice of Allowance is issued.

After a Notice of Allowance has been issued, the applicant has no right to amend the application, but the Commissioner may at his discretion permit the entry of an amendment presented before payment of the final fee, if the entry does not necessitate a further search by the examiner in respect of the application.

13.11
WITHDRAWAL FROM ALLOWANCE

If, after an application is found by the examiner to be allowable and the applicant has received a Notice of Allowance, the Commissioner subsequently finds that the application is not allowable, the Commissioner, either before or after payment of the final fee, notifies the applicant that the Notice of Allowance is withdrawn (subsection 30(7) of the Patent Rules).

If the final fee has been paid at the time that the Commissioner withdraws the Notice of Allowance, the fee is refunded to the applicant (subsections 4(10) and 30(7) of the Patent Rules).

A withdrawal from allowance may be precipitated by the filing of a protest or prior art under section 34.1 of the Patent Act.

An application which has been withdrawn from allowance is returned to the examiner for further examination. The normal restrictions regarding amendments after allowance (section 32 of the Patent Rules) and amendments after payment of the final fee (section 33 of the Patent Rules) do not apply to applications where the Notice of Allowance has been withdrawn by the Commissioner (subsection 30(8) of the Patent Rules). When the application is found by the examiner to be in compliance with all requirements of the Act and Rules, a new Notice of Allowance is issued to the applicant.

13.12
ISSUE OF THE PATENT

Upon payment of the final fee, the application is generally automatically processed through to issue. No amendments may be entered in the application, except in the circumstance where the Notice of Allowance is withdrawn by the Commissioner.

The application will issue in the name of the inventor or the legal representative as their interest appear from assignments previously recorded. Assignments which are received in the Patent Office no later than the day on which the final fee is paid, may be relied upon to provide the appropriate names in which the patent will issue (section 41 of the Patent Rules).

The patent generally will issue on a Tuesday, approximately nine weeks after the office receives the payment of the final fee. The payment of the final fee may be withdrawn if a request for its return is made by the applicant before the start of technical preparations for issue of the patent.

A list of the patents issued by the Patent Office each week is published in the Patent Office Record. Information listed in the POR for each patent includes the number, the title in French and English, inventor name(s), patentee, number of claims and the classification of the patent. Patents issued on applications filed before October 1, 1989 bear a unique patent number less than two million. Applications filed on or after October 1, 1989 issue to patent with the same number as the application (greater than 2,000,000).

CHAPTER 14

UNITY OF INVENTION

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CHAPTER 14
UNITY OF INVENTION

14.01
UNITY OF INVENTION

Section 36 of the Patent Act states that a patent shall be granted for one invention only. The Commissioner shall not consider a patent application to claim more than one invention if the subject matters defined by the claims are so linked as to form a single general inventive concept (section 36 of the Patent Rules). Thus, there must be unity of invention within the claims of a patent application. Restriction is required whenever different subject matters unconnected in design or operation are claimed in one application. Further, where a group of inventions is claimed in the same application, the requirement of unity of invention referred to in section 36 of the Patent Rules is considered to be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" refers to those technical features that define the contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

14.02
UNITY OF INVENTION; DIVISION OF APPLICATIONS

The requirement of unity of invention shall be considered to be complied with where the following combinations of claims of different categories are included in the same application:

(a) a product and a process for making the product;

(b) a product and a use of the product;

(c) a product, a process for making the product and a use of the product;

(d) a process and an apparatus specially adapted to carry out the process;

(e) a product, a process for making the product and an apparatus specially adapted to carry out the process; or

(f) a product, a process for making the product, an apparatus specially adapted to carry out the process and a use of the product.

14.02.01
Order of Claims

The order in which the claims appear in any of combinations (a) to (f) above may be different from the order set forth therein. What is decisive is that the combinations are the same.

14.02.02
Examples

(A) Product and process

Claims to a product and claims to a process for making that product are allowable in the same application. Generally, there is no need for the process claims and the product claims to be of the same scope. Consequently, the process claims may be directed to a method of preparing a family of compounds while the product claims may be restricted to only one member, or a small number of members, of that family. Conversely, the product claims may be directed to a family of compounds and the process claims may prepare only a few members of the family.

The process and the product must be so related that the process produces the product. If, however, there is a generic product claim and a generic process claim which are merely linked together through a common species, Section 36 is applied.

The following example illustrates Section 36 practice:

Claim 1 - A process to prepare sulphate compounds.
Claim 2 - A process to prepare sulphate of A.
Claim 3 - A process to prepare sulphate of B.
Claim 4 - A process to prepare sulphate of C.
Claim 5 - Sulphate of C.
Claim 6 - Salts of C.
Claim 7 - Nitrate of C.
Claim 8 - Chloride of C.

In this example the CPO would not permit claims 1 and 6 in one application, even though they are linked with respect to sulphate C. There is no unity of invention between, the claim to the process to sulphate A and the claim to the nitrate of C. Furthermore, there is no unity between claims 7 and 8 and any of the process claims defined in claims 1 to 4.

(B) Product and a use of the product

Claims to the use of a product may be included in the same application with claims to the product itself. The use must be fully described in the disclosure and must be based on the utility upon which the patentability of the product is predicated. The use may be embodied in different types of claims. A use could be claimed in the form of,

a) a composition in which the product is an ingredient (e.g. A herbicidal composition comprising the product X and an inert carrier),

b) a method of use claim (e.g. The method of killing weeds comprising applying product X to the weeds),

c) a use "per se" (e.g. The use of product X to kill weeds).

Claims in these formats may be claimed in the same application as claims to the product. There is no need for the product claim and the use claim to be of the same scope.

(C) Product, process and use

Under the provisions of paragraph 14.02 (c) above, an application may include claims to a product, claims to a process for preparing that product and claims to a use of the product.

(D) Process and apparatus

An application may contain claims to a process along with a claim to an apparatus or means specially adapted to carry out the process. The apparatus claims may be more extensive in scope than the process claims, or the process claims may be more extensive in scope than the apparatus claims, e.g. the process could be carried out in an apparatus different from the apparatus claimed. However the two sets of claims must be directed to the same inventive concept.

In the following example, the execution of functions A to D inclusive is the inventive concept and is claimed in both apparatus and process forms. The additional means and apparatus of claim 1 would normally constitute the known immediate and cooperating environment of the invention.

Claim 1

An apparatus to manufacture lamps automatically, including lamp envelope selecting and positioning means, means for conveying lamp components to an assembling means, wherein said assembling means comprises means for executing function A, means for executing function B, means for executing function C and means for executing function D; and means for conveying assembled lamps from said assembling means.

Claim 2

A process of assembling lamps comprising the steps of executing function A, executing function B, executing function C and executing function D.

(E) Product, process and apparatus

An applicant is permitted to include independent claims to a product, independent claims to a process for preparing that product and independent claims to an apparatus specially adapted to carry out the process in an application (Refer to 14.02 (e) above).

(F) Product, process, apparatus and use

An applicant is permitted to include independent claims to a product, independent claims to a process for preparing that product and independent claims to an apparatus specially adapted to carry out the process and independent claims to the use of the product (Refer to 14.02 (f) above).

14.03
ACCEPTABLE CLAIM GROUPINGS

Applications may contain certain groups of subject matter including combinations and subcombinations, intermediates and final products and Markush claims. Each of these groups may contain claims or elements of claims which could be claimed in separate applications but because they incorporate a single general inventive concept they may be permitted in a single application. The following examples illustrate acceptable claim groupings.

14.03.01
Combination and Subcombination Claims

To be allowable in one application, a claim to a combination and one to a subcombination must be directed to the same inventive concept. It must be seen that the subcombination is truly the same invention as the combination.

Where the function or utility of the subcombination is essentially that of the combination, claims to the two may be allowed together. A viscosity-reducing oil additive and oil containing the additive would normally be allowed in one application. The purpose of the inventive additive is to improve the properties of the substance with which it is mixed.

On the other hand an anticorrosion agent per se and a composition containing the agent cannot be claimed in the same application if in the claimed composition, the agent has lost its original anticorrosion effect and, instead, acts as an insecticide.

A second invention may also be present when a subcombination is claimed together with one or more combinations containing it, and it is clear that the purpose, use or function of a combination differs from that of the subcombination. For example, in a process having a principal step A of heating composition X to produce composition Y, a claim to step A may not be allowable with a claim to step A followed by step B. For example, these two claims could not be allowed in the same application if step B comprised an ingenious transformation of Y to produce a newly invented composition Z that differed in function from its intermediate Y.

14.03.02
Markush Claims

A Markush claim is a claim which covers selected members of a genus as contrasted to all the members of the genus, so as to exclude inoperative members of the group.

Markush groupings will be considered to be directed to one invention when all of the members of the group have a common basic structure and/or a common property or activity is present. In those cases where a common property or activity is present, all of the members are expected to behave in the same way in the context of the claimed invention.

14.03.03
Intermediates and Final Products

A final product and an intermediate product used in the preparation of the final product may be claimed independently in the same application only when there is sufficient structural similarity between the two such that it can reasonably be assumed that the intermediate was designed to prepare the final product. The intermediate may also have the same use as the final product, but it must not have any other use. Any other use of this intermediate may be considered a further invention. Furthermore, the final product should be manufactured directly from the intermediate or from the intermediate via a small number of other intermediates having similar structure.

14.04
UNACCEPTABLE CLAIM GROUPING

There may be a variety of claims drafted which share one or more common features but which do not ensure that there is a single general inventive concept defined by each of the claims. The examples characterized in 14.04.01 show such unacceptable claims.

14.04.01
Linking Claims

Applications may not contain separate claims linked together by the subject matter of a third claim.

For example:

(a) Claim 1 to the substance A.
Claim 2 to the substance B.
Claim 3 to the combination of A and B.

(b) Claim 1 to the combination of A, B and C.
Claim 2 to the combination of E, F and G.
Claim 3 to the combination of C, D and E.

In Example (a) Claims 1 and 2 are directed to different substances and in Example (b) Claims 1 and 2 are directed to different combinations.

The presence of linking Claims 3 in both examples does not justify the inclusion of unrelated subcombinations in one application and restriction is required under Section 36(1) of the Patent Act and Section 36 of the Patent Rules.

It should be noted that in the first example Claim 3 could be maintained in an application with either Claim 1 or Claim 2, but not both.

In example (b) none of claims 1, 2, or 3 could be allowed in the same application with any other of claims 1, 2, or 3 because they each define a distinct combination. Claims 1 and 3 could be allowed together if the application contained an allowable claim to subcombination C. Claims 2 and 3 could be allowed together if the application contained an allowable claim to subcombination E.

14.05
DIVISIONAL APPLICATIONS

When unity of invention does not exist, the applicant may voluntarily limit the claims to one invention only, and any other invention described may be made the subject of a divisional application (section 36(2) of the Patent Act). Such a divisional application must be filed before the issue of a patent on the original application.

Further, where an original application describes and claims more than one invention, the applicant must, on the direction of the Commissioner, limit the claims to one invention only and any other invention described may be made the subject of a divisional application, if the divisional application is filed before the issue of a patent on the original application (section 36(2.1) of the Patent Act).

Under section 36 of the Patent Act, it is not required that an applicant claim the various inventions that may be described in the specification in order to file a divisional application; it is only required that the applicant describe the various inventions.

Divisional applications will retain the filing date of the original applications. Further, any priorities requested respecting the original applications will be automatically carried forward to divisional applications subsequently filed. If the applicant wishes to withdraw one or more priority requests he/she may so indicate in the petition of the divisional application.

It should be noted that when filing divisionals under subsection 36(2), of the Patent Act, the applicant may contravene subsection 36(2.1) of the Patent Act by inserting claims to more than one invention in a divisional application. This case could arise when an applicant describes three or more inventions in an original application.

When the examiner is reasonably certain that more than one invention is being claimed, the claims are grouped by invention and the applicant is requisitioned to limit the claims

to one invention (subsection 36(2.1) of the Patent Act).

When two or more groups of claims are present in an application, only one of the groups of claims is examined. A requisition for restriction of the claims to one invention will usually be made in the examiner's first report along with any other objections to the group of claims under examination.

It is also possible that, during the examination process, the claims of an application may be amended in such a manner that two or more inventions are being claimed. The examiner will make a requisition for restriction to one invention at that time.

14.05.01
Time Limits for Divisional Applications

Examination of divisional applications filed on the basis of an original application that was filed on or after October 1, 1996 must be requested before the expiry of the later of the five year period after the filing date of the original application and the six month period after the date on which the divisional application is actually filed (subsection 96(2) of the Patent Rules).

For divisional applications filed on the basis of an application that was filed between October 1, 1989 and October 1, 1996, the examination request must be made before the expiry of the later of the seven year period after the filing date of the original application and the six month period after the date on which the divisional application is actually filed (subsection 150(2) of the Patent Rules). Under subsections 36(2) and 36(2.1) of the Patent Act, a divisional must be filed "before the issue of a patent on the original application". Sections 2 and 6 of the Interpretations Act establish that a patent is granted and issued at the end of the day preceding the date of issue, since instruments issued on a particular day come into force upon the expiration of the previous day. Consequently a divisional application may not be filed on the day of issue of the patent on the original application.

The time for filing a divisional of an abandoned application terminates with the expiration of the time for reinstating the original application.

14.06
EXAMINATION FOR DIVISIONAL STATUS

An application for which the applicant has requested divisional status will be accorded the filing date of the parent application. The applicant may be required to withdraw his request for divisional status if it is subsequently determined that the application contains new matter not described in the parent application.

Any application that satisfies the requirements of subsections 36(2) and 36(2.1) of the Patent Act may be given the status of a divisional application at any time during its prosecution.

For divisional applications with an examination request, the question of divisional status will be settled as soon as possible after receipt of the request for examination and before any action on the merits of the application is issued. If divisional status is refused, the applicant will be informed.

14.06.01
Divisional Applications Open to Inspection

A divisional application will be open to public inspection in accordance with Section 10 of the Patent Act if the parent application is already open to inspection. If the parent application is not open to public inspection, the divisional application and parent application will be opened to public inspection at the same time.

Any application filed as a divisional will be opened to public inspection 18 months from the filing date of the original application or the date of the earliest previously filed application on the basis of which a request for priority has been made (subsections 10(2) and 36(4) of the Patent Act). Should the application be refused divisional status because it contains new subject matter, the new subject matter may also be opened to public inspection and may constitute a bar to the issuance of a patent to the applicant for that subject matter.

Divisional applications based on original applications filed prior to October 1, 1989 will not be opened to public inspection.

14.06.02
No New Matter in Specification

A determination of the presence of new matter in the specification and drawings of a divisional application as outlined in the following paragraphs will be made only after a request for examination of the divisional is received.

The specification and drawings of a divisional application must be restricted to what has been described in the specification and drawings of the parent application. If new matter which was not part of the parent application as originally filed is included in the specification or drawings of a divisional application when it is filed, the applicant is advised by examiner's report that the new application is not entitled to divisional status.

Where both the petition and specification refer to divisional status, the examiner's report requisitions that the new matter be removed within a specified time or all references to divisional status be deleted. In those cases where only the petition refers to divisional status, the examiner's report requisitions the applicant to delete the new matter or to delete reference to divisional status from the petition within a specified time. Failure to comply with the examiner's report may result in the rejection of the application in a final action. If the applicant retains new matter in the specification and drawings but removes all reference to divisional status, the application will be given the date it was received in the CPO as its filing date.

If during the prosecution of a divisional application an applicant amends to add new matter, an examiner's action is issued requisitioning deletion of the new matter. Any further examiner's action on the same ground may be made final.

14.06.03
Further Divisionals

A divisional application may itself be divided. The further divisionals may be filed after the original parent application has issued, as long as they are filed before the issue of their particular parent application. For example, an application describing three inventions A,B and C may be divided as follows: divisional 1 describing and claiming inventions B and C and divisional 2 describing and claiming invention C. If the original application has issued, divisional 1 must describe inventions B and C in order for divisional 2 to have a proper parent.

The effective filing date of each divisional application is the filing date of the original application.

If a divisional application is derived from a parent application which is itself a division of an earlier application, the front cover of the last divisional must clearly indicate the relationship between the various applications in the following form: Div. of 735xxx filed Sept.9, 1987 (Division of 619xxx filed Aug. 6, 1984).

14.06.04
The Petition of a Divisional

The petition of a divisional application must refer to its divisional status (section 77 of the Patent Rules and Item 2 of Form 3, Schedule I of the Patent Rules). If such a reference is missing from the petition at the time of filing, an Office letter is sent under paragraph 94(1)(a) of the Patent Rules requisitioning a new petition before the expiration of the time period specified in subsection 94(2) of the Patent Rules. If the applicant fails to comply, a Commissioner's notice is sent requisitioning the applicant to provide a petition in conformance with Form 3 of Schedule 1 of the Patent Rules. The notice will carry the time limit specified in subsection (94)(1) of the Patent Rules and require payment of the fee specified in Item 2 of Schedule II of the Patent Rules.

If an application at filing is not entitled to divisional status, for example, if the examiner refuses divisional status upon receipt of the request for examination there should be no reference to division either in the petition or in the specification. It should be noted that an application not entitled to divisional status will be given as its filing date the actual day that it was received in the CPO. The applicant would be entitled to request priority based on any earlier regularly filed application which had been filed within the preceding 12 months.

In the above situations, an examiner's report is sent detailing the reasons for not recording the divisional status and giving the applicant the option of rectifying the cause for not recording divisional status or amending the application to remove any reference to

divisional status from the petition and the specification (if present). The amendment must take the form of a replacement petition and any page of the specification affected. If the applicant argues that divisional status should be retained the application may be rejected in a final action.

14.07
DIVISIONAL APPLICATIONS AND FEES

Divisional applications are considered to be separate and distinct applications. Therefore, any fee which is applicable to an ordinary application will be applicable to a divisional application. Since a properly filed divisional application will bear the filing date of the parent application, a divisional application is, at the time of filing, subject to fees to maintain the application in effect. Such fees will be calculated from the filing date of the parent application and are payable upon the filing of the divisional application (subsection 99(3) of the patent Rules). Moreover, such a divisional application will be subject to the prescribed fee upon a request for examination pursuant to subsection 35(1) of the Patent Act. Finally, any patent resulting from the a divisional application is subject to the appropriate fees to maintain the patent. (section 46 of the Patent Act and subsection 100(1) of the Patent Rules.

14.08
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

Short Milling v George Weston	ExCR	69	1941
Rohm & Haas v Comm of Patents	30 CPR	113	1959
Lovell v Beatty	41 CPR	18	1962
Boehringer v Bell-Craig	39 CPR	201	1962
Comm of Pat v Farbwerke	41 CPR	9	1963
	SCR	49	1964
Xerox v IBM	33 CPR (2d)	24	1977
Consolboard v MacMillan	56 CPR (2d)	145	1981
	1 SCR	504	1981
Radio Corp v Hazeltine	56 CPR (3d)	170	1981
Re: Hedstrom	31 CPR (3d)	324	1989

APPENDIX OF EXAMPLES

RELATING TO

CHAPTER 14

UNITY OF INVENTION

I. CLAIMS IN DIFFERENT CATEGORIES

Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

Example 2

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out Step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

Example 3

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

Example 4

Claim 1: Use of a family of compounds X as insecticides.

Claim 2: Compound X_1 belonging to family X.

Provided X_1 has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

Example 5

Claim 1: A process for treating textiles comprising spraying the material with a particular coating composition under special conditions (e.g. as to temperature, irradiation).

Claim 2: A textile material coated according to the process of claim 1.

Claim 3: A spraying machine for use in the process of claim 1 and characterized by a new nozzle arrangement providing a better distribution of the composition being sprayed.

The process according to claim 1 imparts unexpected properties to the product of claim 2.

The special technical feature in claim 1 is the use of special process conditions corresponding to what is made necessary by the choice of the particular coating. Unity exists between claims 1 and 2.

The spraying machine in claim 3 does not correspond to the above identified special technical feature. Unity does not exist between claim 3 and claims 1 and 2.

Example 6

Claim 1: A fuel burner with tangential fuel inlets into a mixing chamber.

Claim 2: A process for making a fuel burner including the step of forming tangential fuel inlets into a mixing chamber.

Claim 3: A process for making a fuel burner including casting step A.

Claim 4: An apparatus for carrying out a process for making a fuel burner including feature X resulting in the formation of tangential fuel inlets.

Claim 5: An apparatus for carrying out a process for making a fuel burner including a protective housing B.

Claim 6: A process of manufacturing carbon black including the step of tangentially introducing fuel into a mixing chamber of a fuel burner.

Unity exists between claims 1, 2, 4 and 6. The special technical feature common to all the claims is the tangential fuel inlets. Claims 3 and 5 lack unity with claims 1, 2, 4 and 6 since claims 3 and 5 do not include the same or corresponding special technical feature as set forth in claims 1, 2, 4 and 6. Claims 3 and 5 would also lack unity with one another.

Example 7

Claim 1: A high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0-5.0; Cr=15-19; Mo=1-2; and the balance Fe having thickness of between 0.5 and 2.0 mm and a 0.2% yield strength in excess of 50 kg/mm squared.

Claim 2: A method of producing a high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0-5.0; Cr=15-19; Mo=1-2; and the balance Fe comprising the steps of:

hot rolling to a thickness between 2.0 and 5.0 mm;

annealing the hot rolled strip at 800-1000 degrees C under substantially non-oxidizing conditions;

cold rolling the strip to a thickness of between 0.5 to 2.0 mm; and final annealing the cold rolled strip at between 1120 and 1200 degrees C for a period of 2-5 minutes.

Unity exists between product claim 1 and process claim 2. The special technical feature in the product claim is the 0.2% yield strength in excess of 50 kg/mm squared. The process steps in claim 2 inherently produce a ferritic stainless steel strip with a 0.2% yield strength in excess of 50 kg/mm squared. Even if this is not apparent from the wording of claim 2, it is clear from the description. These process steps are the special technical feature which correspond to the limitation in the product claim directed to the same ferritic stainless steel with the claimed strength characteristics.

II. CLAIMS IN THE SAME CATEGORY

Example 8

Claim 1: Plug characterized by feature A.

Claim 2: Socket characterized by corresponding feature A.

Feature A is a special technical feature which is included in both claims 1 and 2 and therefore unity is present.

Example 9

Claim 1: Transmitter provided with time axis expander for video signals.

Claim 2: Receiver provided with time axis compressor for video signals received.

Claim 3: Transmission equipment for video signals comprising a transmitter provided with time axis expander for video signals and a receiver provided with time axis compressor for video signals received.

The special technical features are in claim 1 the time axis expander, and in claim 2 the time axis compressor, which are corresponding technical features. Unity exists between claims 1 and 2. Claim 3 includes both special technical features and has unity with claims 1 and 2. The requirement for unity would still be met in the absence of the combination claim (claim 3).

Example 10

Claim 1: Conveyor belt with feature A.

Claim 2: Conveyor belt with feature B.

Claim 3: Conveyor belt with features A + B.

Feature A is a special technical and feature B is another unrelated special technical feature. Unity exists between claims 1 and 3 or between claims 2 and 3, but not between claims 1 and 2.

Example 11

Claim 1: Control circuit A for a d.c. motor.

Claim 2: Control circuit B for a d.c. motor.

Claim 3: An apparatus including a d.c. motor with control circuit A.

Claim 4: An apparatus including a d.c. motor with control circuit B.

Control circuit A is a special technical feature and control circuit B is another unrelated special technical feature. Unity exists between claims 1 and 3 or between claims 2 and 4, but not between claims 1 and 2 or 3 and 4.

Example 12

Claim 1: A display with features A + B.

Claim 2: A display according to claim 1 with additional feature C.

Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is features A + B.

Example 13

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is the filament A.

Example 14

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Example 16

Claim 1: An insecticide composition comprising compound A (consisting of a_1, a_2 ...) and a carrier.

Claim 2: Compound a_1.

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided a_1 has the insecticidal activity which is also the special technical feature for compound A in claim 1.

Example 17

Claim 1: Protein X.

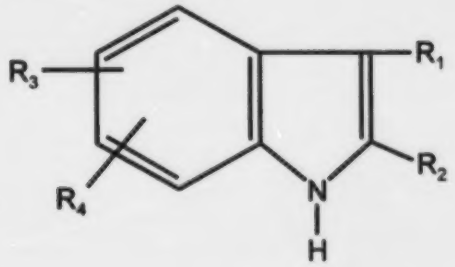
Claim 2: DNA sequence encoding protein X.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

III. MARKUSH PRACTICE

Example 18 - common structure:

Claim 1: A Compound of the formula:

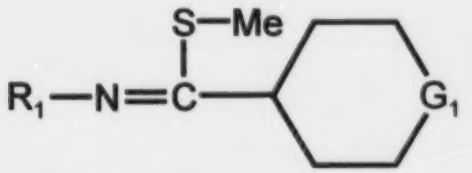


Wherein R_1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy and methyl; R_2 - R_4 are methyl, benzyl or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

Example 19 - common structure:

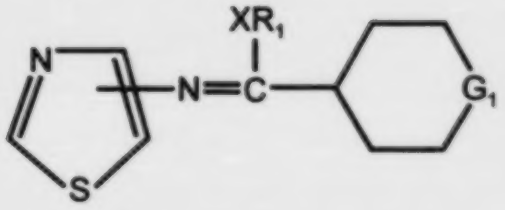
Claim 1: A compound of the formula:



Wherein R_1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy and methyl; G_1 is selected from the group consisting of oxygen (O), sulfur (S), imino (NH) and methylene ($-CH_2-$). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain. In this particular case the iminothioether group -N=C-Me linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 20 - common structure:

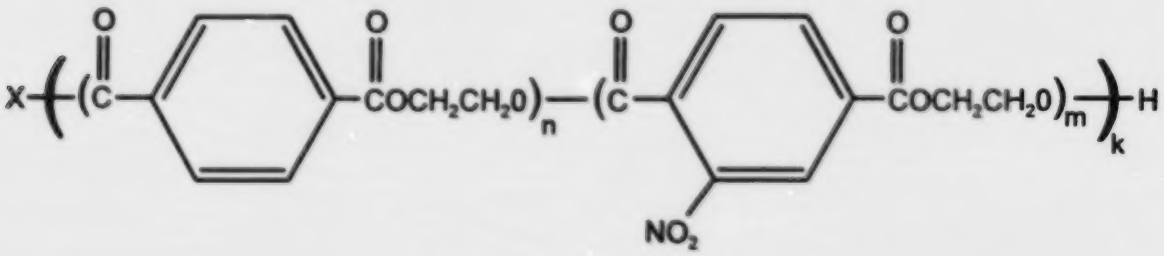
Claim 1: A compound of the formula:



Wherein R_1 is methyl or phenyl, X and G_1 are selected from oxygen (O) and sulfur (S). The compounds are useful as pharmaceuticals and contain the 1,3-thiazolyl substituent which provides greater penetrability of mammalian tissue which fact makes the compounds useful as relievers for headaches and as topical anti-inflammatory agents.

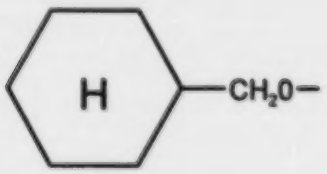
All compounds share a common chemical structure, the thiazole ring and the six atom heterocyclic compound bound to an imino group, which occupy a large portion of their structure. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 21 - common structure:

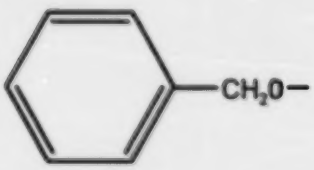


$1 \leq k \leq 10$

$200 \geq n+m \geq 100$



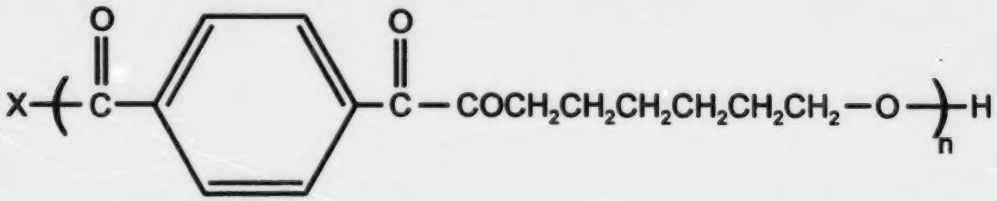
or



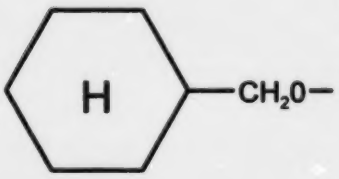
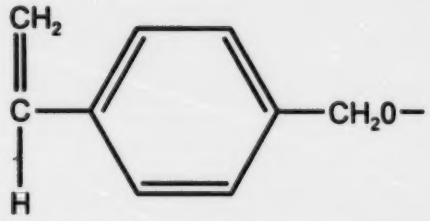
All of the above copolymers have in common a thermal degradation resistance property, due to the reduced number of free COOH radicals by esterification with X of the end COOH radicals which cause thermal degradation. The chemical

structures of the alternatives are considered to be technically closely interrelated to one another. A grouping in one claim is therefore allowed.

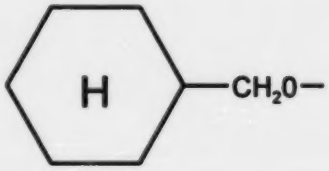
Example 22 - common structure:



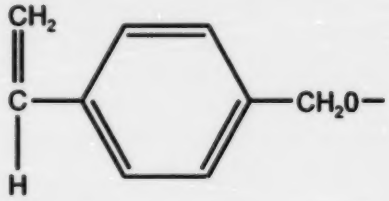
(Polyhexamethyleneterephtalate)
$100 \geq n \geq 50$

X:  or 

The compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephtalate with



has a thermal degradationresistant property, due to the reduced number of free COOH radicals which cause thermal degradation. In contrast, the compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephtalate with



serves as raw material for a setting resin when mixed with unsaturated monomer and cured (addition reaction).

All compounds covered by the claim do not have a property or activity in common.

For example, the product obtained through esterification with the "CH_2=CH" compound does not have a thermal degradation resistant property. The grouping in a single application is not allowed.

Example 23 - No common structure:

Claim 1: A herbicidal composition consisting essentially of an effective amount of the mixture of A 2,4-D (2,4-dichlorophenoxy acetic acid) and B a second herbicide selected from the group consisting of copper sulfate, sodium chlorate, ammonium sulfamate, sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamid (an amide), ioxynil (nitrile), dinoseb (phenol), trifluralin (dinitroaniline), EPTC (thiocarbamate) and simazine (triazine) along with an inert carrier or diluent.

The different compounds under B must be members of a recognized class of compounds. Consequently in the present case a unity objection would be raised because the members of B are not recognized as a class of compounds, but, in fact, represent a plurality of classes which may be identified as follows:

a) <u>inorganic salts:</u>

copper sulfate
sodium chlorate
ammonium sulfamate

b) <u>organic salts and carboxylic acids:</u>

sodium trichloroacetate
dichloropropionic acid
3-amino-2,5-dichlorobenzoic acid

c) <u>amides:</u>

diphenamid

d) <u>nitriles:</u>

ioxynil

e) <u>phenols:</u>

dinoseb

f) <u>amines:</u>

trifluralin

g) heterocyclic:

simazine

Example 24

Claim 1: Catalysts for vapor phase oxidation of hydrocarbons, which consists of (X) or (X+a)

In this example (X) oxidizes RCH_3 into RCH_2OH and (X+a) oxidizes RCH_3 further into RCOOH.

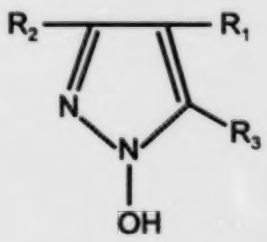
Both catalysts share a common component and a common activity as oxidation catalyst for RCH_3. With (X+a) the oxidation is more complete and goes until the carboxylic acid is formed but the activity still remains the same.

A Markush grouping is acceptable.

IV. INTERMEDIATE/FINAL PRODUCTS

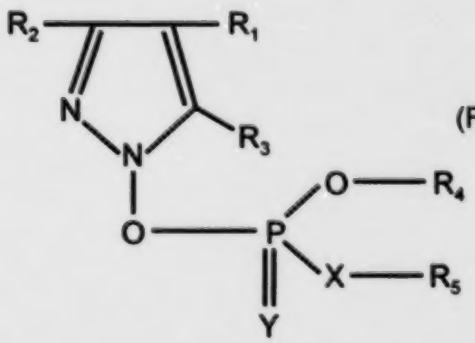
Example 25

Claim 1:



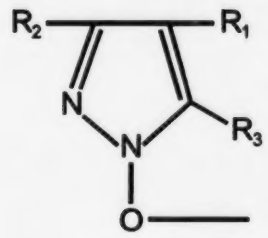
(Intermediate)

Claim 2:



(Final product)

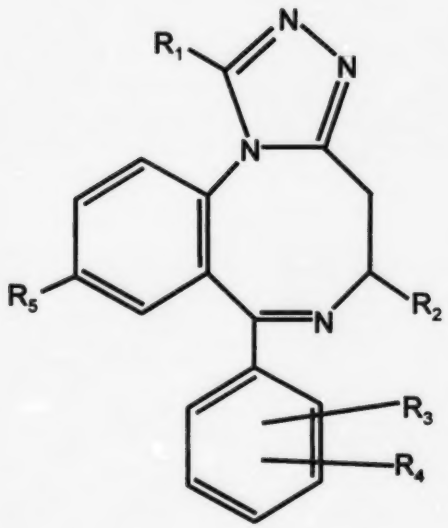
The chemical structures of the intermediate and final product are technically closely interrelated. The essential structural element incorporated into the final product is:



Therefore, unity exists between claims 1 and 2.

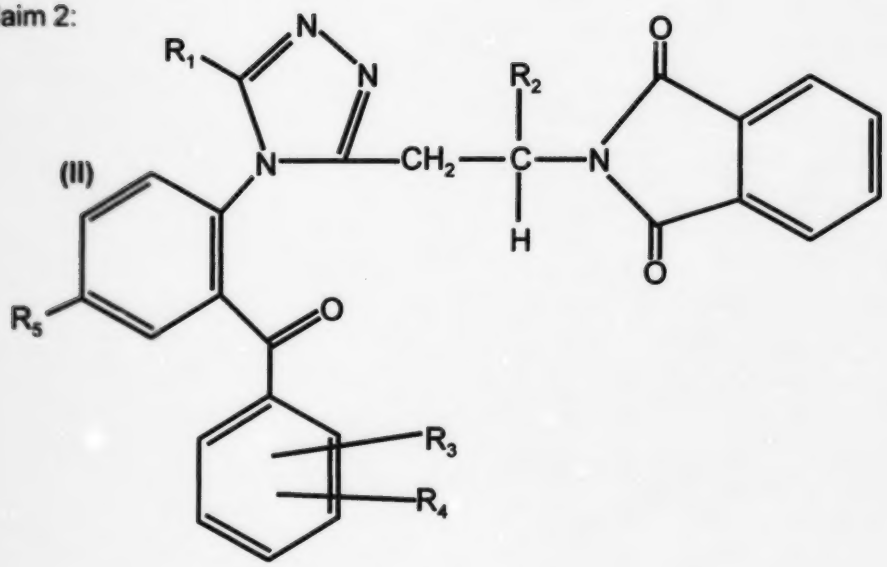
Example 26

Claim 1:



(I)

Claim 2:



(II) is described as an intermediate to make (I). The closure mechanism is one well known in the art. Though the basic structures of compound (I) (final product) and compound (II) (intermediate) differ considerably, compound (II) is an open ring precursor to compound (I). Both compounds share a common essential structural element which is the linkage comprising the two phenyl rings and the triazole ring. The chemical structures of the two compounds are therefore considered to be technically closely interrelated.

The example therefore satisfies the requirement for unity of invention.

Example 27

Claim 1: Amorphous polymer A (intermediate).

Claim 2: Crystalline polymer A (final product).

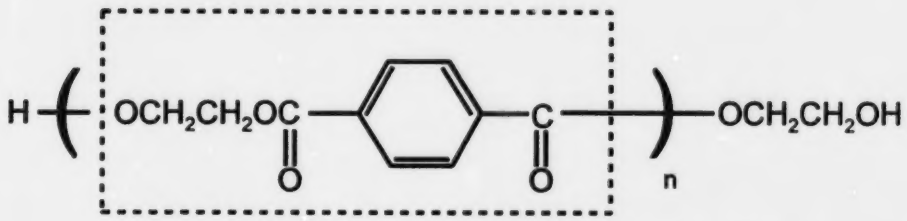
In this example a film of the amorphous polymer A is stretched to make it crystalline. Here unity exists because there is an intermediate final product relation in that amorphous polymer A is used as a starting product to prepare crystalline polymer A.

For purposes of further illustration, assume that the polymer A in this example is polyisoprene. Here the chemical structures of the intermediate, amorphous polyisoprene and the final product, crystalline polyisoprene have the same chemical structure.

Example 28

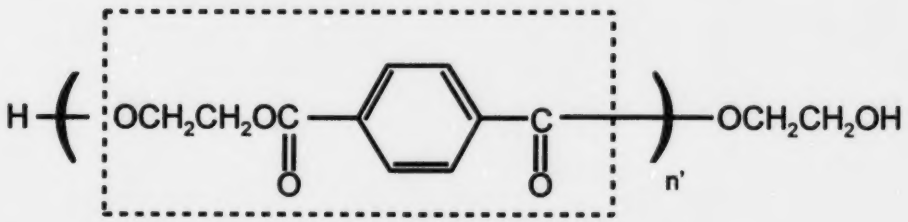
Claim 1: Polymeric compound useful as fiber material identified by the following general formula:

[repeating unit (X)]



(I)

Claim 2: Compound identified by the following general formula: (useful as intermediate for polymeric compound I)



(II)

(primary condensation product)

The two inventions are in an intermediate and final product relationship.

Substance (II) is a raw material for substance (I).

Meanwhile, both compounds share an essential structural element (repeating unit (X)) and are technically closely interrelated. The intermediate and final products therefore satisfy the requirements for unity.

Example 29

Claim 1: Novel compound having structure A. (Intermediate).

Claim 2: Product prepared by reacting A with a substance X. (Final Product).

Example 30

Claim 1: Reaction product of A and B. (Intermediate).

Claim 2: Product prepared by reacting the reaction product of A and B with substances X and Y. (Final Product).

In examples 29 and 30 the chemical structure(s) of the intermediate and/or the final product is not known. In (29) the structure of the product of claim 2 (the final product) is not known. In (30) the structures of the products of claim 1 (the intermediate) and claim 2 (the final product) are unknown. Unity exists if there is evidence which would lead one to conclude that the characteristic of the final product which is the inventive feature in the case are due to the intermediate. For example, the purpose for using the intermediates in (29) or (30) is to modify certain properties of the final product. The evidence may be in the form of test data in the specification showing the effect of the intermediate on the final product. If no such evidence exists then there is no unity on the basis of an intermediate-final product relationship.

CHAPTER 15

REQUIREMENTS FOR PATENTABILITY

15.01 INTRODUCTION
- 15.01.01 Novelty and Anticipation
- 15.01.02 Obviousness

15.02 INTERNAL PRIORITY

15.03 CLAIM DATE

15.04 GRACE PERIOD

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- 15.05.01 References Applied
- 15.05.02 References of Interest
- 15.05.03 Identification of Art Cited
- 15.05.04 Incorrect Citation of References

15.06 MANNER OF CITING REFERENCES
- 15.06.01 Citations of Copending Canadian Applications
- 15.06.02 Copending PCT Applications

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CHAPTER 15
REQUIREMENTS FOR PATENTABILITY

15.01
INTRODUCTION

The subject matter protected by a patent is defined by the claims. This chapter deals with the various requirements imposed by law and jurisprudence on claims before they can be said to be directed to novel and unobvious subject matter in accordance with sections 28.2 and 28.3 of the Patent Act.

15.01.01
Novelty and Anticipation

To be considered novel the whole of subject matter defined by a claim shall not form part of the state of the art. With respect to each claim in an application for patent in Canada the state of the art may be defined generally as everything disclosed in such a manner that it became available to the public in Canada or elsewhere before the **CLAIM DATE**. The **CLAIM DATE** of a claim in a Canadian patent application is the filing date of the application in Canada, unless, priority is claimed on an earlier filed application in Canada or elsewhere. In the latter case, the claim date is the filing date of the earliest application which supports the subject matter of the claim (Sections 2 and 28.1 of the Patent Act).

If the subject matter defined by a claim in an application is disclosed completely in a single prior art reference, it is considered to be anticipated by the reference (meaning lacking in novelty). In this situation the examiner will inform the applicant of the defect and requisition the applicant to amend the application to comply with the Act and Rules or to provide arguments as to why the application does comply. The defect in this case is that the claim lacks novelty in view of the prior art (i.e. is anticipated by the reference). Although novelty is assessed on the basis of a single item of prior art, it is permitted to read into prior art things that can be considered to be implicit therein, but references may not be combined to find a lack of novelty. Combining references to show lack of novelty has been referred to as an improper "mosaic" of references (Pope v. Spanish River 46 RPC 1929).

15.01.02
Obviousness

A claim will be objected to under section 28.3 of the Patent Act if it is considered to be obvious to one of skill in the art or science, on the claim date. The test for obviousness is essentially whether or not an unimaginative skilled technician would, in the light of the state of the art and common general knowledge at the claim date, be led directly and without difficulty to the invention covered by the claim i.e. subject matter defined by the claim.

While some references do not show every detail of an invention claimed in an

application, the differences between the two may be so slight that the invention claimed is obvious in view of the reference. Where the differences could have been made using the ordinary skill of one versed in the art, the claims are rejected for obviousness in view of the state of the prior art revealed in the reference or references.

Care must be exercised in assessing whether the differences between the claimed invention and the disclosure of the prior art, even if minor, produce unexpected results, in which event the element of unobviousness could be present.

It may be necessary to cite two or more references, or one reference and evidence of common knowledge to show all the features of an applicant's invention. Several references may be cited to show that the state of the art is such that the applicant failed to make any inventive improvement when the rejection is for obviousness rather than for anticipation. The references cannot be from such diverse arts that one skilled in the art of the invention claimed would not normally be expected to be aware of it. There may be invention in applying known principles of one art to another art if the different arts are sufficiently remote from each other, even though one skilled in the art would be expected to look beyond the immediate environment of the invention

It has been held by the courts to be obvious to do any of the following:

(a) To merely substitute superior for inferior materials, in the manufacture of one or more or all of the parts of a machine or manufacture.

(b) To merely change the size or dimensions of an object.

(c) To omit one or more of the parts of a machine or manufacture with a corresponding omission of function, unless that omission causes a new mode of operation of the parts retained.

(d) To change a process, machine, manufacture or composition of matter, by substituting an equivalent for any of its parts, unless the new part not only performs the function of the part for which it was substituted, but also performs another function, by another mode of operation, or develops new uses and properties of the article formed.

(e) To merely use an old process, machine or manufacture for a new but analogous purpose.

(f) To change the form or proportions of a machine or manufacture, unless a new mode of operation or function results.

(g) To produce an article which differs from an older article only in excellence of workmanship.

(h) To duplicate one or more of the parts of a machine or manufacture unless the duplication causes a new mode of operation, or produces a new unitary result.

(i) To combine old devices into a new machine or manufacture, without producing any new mode of operation.

15.02
INTERNAL PRIORITY

A Canadian application may be used as a basis for priority for claims in subsequently filed applications within Canada (subparagraph 28.1(1)(a)(i) and subsection 28.1(2) of the Patent Act). In order to establish a priority claim, the filing date of the subject application must be within twelve months of the filing date of the preceding Canadian application (subsection 28.1(1)(b) of the Patent Act), and the request for priority must be made within a four month period after the filing of the subject application (paragraph 88(1)(b) of the Patent Rules). Where the subject matter of a claim is disclosed in more than one preceding Canadian or foreign application a priority claim may only be made if the subject application is filed within 12 months of the earliest filed application (paragraph 28.4(4)(a) of the Patent Act).

15.03
CLAIM DATE

The claim date of a claim in an application or patent is the filing date of the application in Canada, unless there is a priority claimed. In the latter case the claim date is the filing date of the earliest priority application which supports the subject matter of the claim.

In order to have a valid priority claim date the following conditions must be satisfied:

a) the previously filed Canadian or foreign application must disclose the subject matter defined in the claim of the subject application (subparagraph 28.1(1)(a)(i) and (ii) of the Patent Act and chapter 7 of this Manual);

b) the subject matter of the claim must be reasonably inferred from supported by the specification or drawings as they were originally filed in the preceding Canadian or foreign application (section 38.2(2) and (3) of the Patent Act);

c) the filing date of the subject application must be within twelve months of the filing date of the preceding Canadian or foreign application (section 28.1(b) of the Patent Act);

d) a request for priority must be made within a four month period after filing the subject application (section 28.4 of the Patent Act, paragraph 88(1)(b) of the Patent Rules), the applicant must provide the Commissioner with the date and country of filing of each previously regularly filed application on which the request for priority is based before the expiry the four-month period after the filing date of the subject application. The applicant must also provide the Commissioner with the application number of any such application before the expiry of the later of the four-month period after the filing date of the subject application and the twelve-month period after the filing date of the previously filed application; and

e) upon requisition by the examiner, the applicant must provide a certified copy of any foreign application that forms a basis for the priority request (section 89 of the Patent Rules).

A situation may arise where an application may contain claims having different claim dates. This may occur when an applicant requests priority from two or more preceding applications, or when only part of the application has priority from a preceding application (section 28.4(4) of the Patent Act). A claim that defines subject matter in the alternative may be derived from several priority documents. In such a circumstance each alternative in the claim will be considered as a separate claim and will possess its own claim date (section 27(5) of the Patent Act).

15.04
GRACE PERIOD

The public disclosure of claimed subject matter by the applicant, or by a person who obtained knowledge of this subject matter directly or indirectly from the applicant, will not be used to object to claims for lack of novelty or obviousness unless such disclosure was made more than one year (grace period) before the Canadian filing date (section 28.2(1)(a) of the Patent Act). For applications filed on or after October 1, 1996, any publication arising from an applicant's corresponding application in a foreign jurisdiction will not constitute a bar if the Canadian application is filed within 12 months of the publication (subsection 28.2(1)(a) of the Patent Act). For applications filed prior to October 1, 1996, any patent arising from an applicant's corresponding application in a foreign jurisdiction constitutes a bar unless (1) the Canadian application was filed before the foreign patent issued or (2) the foreign patent issued within 12 months after the filing of the first corresponding application by that inventor (subsection 27(2) of the Patent Act as it read prior to October 1, 1996).

15.05
CITATION OF ART

Art cited in examiners' reports falls into two categories, that applied against the application as a basis for objection or amendment, and that cited as of interest only. Art that is applied is usually placed near the start of the examiner's report under the heading "References Applied". An examiner may also place on record related art of interest that shows the state of the art.

15.05.01
References Applied

References may be applied because they disclose the invention claimed in the application (section 28.2 of the Patent Act), or because they show that the claims define something that is obvious and therefore unpatentable (section 28.3 of the Patent Act).

15.05.02
References of Interest

All references placed on record that are not relied upon as grounds for objection, or to requisition amendments, are cited to show the state of the art. They may be useful in identifying subject matter disclosed but not claimed by an applicant and which cannot be claimed through subsequent amendment of the application. On some occasions, the abstract of a document which appears pertinent will be cited as a reference of interest when the full document is not available to the examiner.

15.05.03
Identification of Art Cited

When a reference is first cited against an application, it is identified sufficiently so that the applicant will be able to locate it. For a publication, the author, title, publisher, date of publication and page number are normally given. In the case of a patent, the number, country, date on which it became available to the public and name of inventor or patentee (if known) are given. Sometimes, as in the case of United States patents, the patent classification at the time of issue is also listed. If specific pages of the disclosure or certain views in the drawings are relied upon, they are identified.

15.05.04
Incorrect Citation of References

When the CPO discovers that a reference has been incorrectly cited in an examiner's action which has already been sent to the applicant, a letter of correction is sent to him. Such a letter does not extend the time set for replying to an outstanding action, but if the applicant finds that as a result of the original error he is left with insufficient time to deal with the citation properly he may so indicate in his response. Under these circumstances, the objection made in view of the citation will be repeated in a subsequent action, thus giving the applicant a further opportunity to consider it.

15.06
MANNER OF CITING REFERENCES

Any patent, opened patent application, printed publication or public knowledge anywhere, disclosing the subject matter of the claim, and which disclosure was available to the public prior to the claim date of the subject application filed in Canada, constitutes a bar to the grant of a patent on that application, unless such disclosures originate from the applicant and comes within the grace period (section 28.2(1)(a) of the Patent Act). Therefore, public disclosures of the invention by the applicant or by a person who obtained knowledge of the invention, directly or indirectly from the applicant and which disclosures occurred more than one year before the Canadian filing date (grace period) of the application are also a bar. These disclosures are considered eligible citations both for lack of novelty and obviousness. The applicant is given the opportunity to overcome the citation by amendment to clear the reference or by presenting convincing arguments showing that the invention claimed differs patentably from that described in the cited reference.

For example, under section 28.2 of the Patent Act claims are objected to if the subject matter was:

(i) disclosed by the applicant, or by a person who gained knowledge of the invention from the applicant, so as to be available to the public more than one year prior to the Canadian filing date (section 28.2(1)(a) of the Patent Act), or

(ii) disclosed by another person so as to be available to the public before the claim date.

However, a foreign application of the same inventor disclosing the same invention as the corresponding Canadian application, and which was published, laid open, or granted prior to the Canadian filing date, is a bar to the grant of the Canadian Patent, unless the Canadian application was filed within twelve months of such foreign publication or granting (grace period).

15.06.01
Citations of Copending Canadian Applications

A laid open copending application by a different applicant describing the same invention and having at least one claim with an earlier claim date then a subject application will be cited as a document that negates the novelty of the claims of the subject application (paragraph 28.2(1)(d)). However, a copending application cannot be cited against a subject application on the grounds of obviousness, unless the subject matter of the copending application was made available to the public prior to the claim date of the subject application. In this section, the subject application is the application under examination.

In the event that two or more copending applications describe the same invention the following situations may arise:

(A) No examination request on any application:

No consideration will be given to the copending applications until examination has been requested for at least one of the applications.

(B) Subject application is the earlier filed application:

(i) where the subject application has a Canadian filing date that predates the claim date of any other copending applications, no consideration will be given to the other copending applications and examination of the subject application will proceed as though they did not exist;

(ii) where any copending application has at least one claim date earlier than the Canadian filing date of the subject application then the relevant claim dates of the subject application and copending application need to be verified (section 89 of the Patent Rules);

(C) Subject application is the later filed application:

where the subject application has a Canadian filing date that is preceded by the claim date of any other copending application describing the same invention, then;

(i) where the copending application having the earlier claim date has been laid open to the public in Canada or in any other country before the claim date of the subject application, then the copending application or its foreign counterpart having the earlier claim date is cited against the subject application as a publication;

(ii) where the copending application having the earlier claim date was not available to the public in Canada or in any other country before the filing date of the subject application, the copending application is cited under paragraph 28.2(1)(c) or (d) of the Patent Act after the copending application is laid open. Verification of the claim dates of the copending and the subject application is necessary. The copending application cannot be cited against the subject application as a reference for obviousness since the disclosure of the subject matter was not available to the public at the claim date of subject application (subsection 28.3(b) of the Patent Act).

(D) Overlap between copending applications of the same applicant:

Where an examination request is received for an application and there is an application by the same applicant describing and claiming the same invention having an earlier claim date then:

(i) Where the application having the earlier claim date has been made available to the public in Canada or in any other country more than one year (grace period) before the application under examination was filed in Canada, then the application having the earlier claim date would be applied against the subject application in the same manner as any other citable published material;

(ii) Where the application having the earlier claim date has not been made available to the public for more than one year before the application under Examination was filed in Canada, the application having the earlier claim date would be cited requisitioning the applicant to remove the overlapping claimed subject matter. The citation for overlapping subject matter is applied irrespective of whether or not internal priority has been established on the previously filed application. Since the term of protection initiates from the filing date and not the claim date, the applicant must choose in which application to prosecute the overlapping subject matter in order to prevent extension of the exclusive right (sections 44 and 45 of the Patent Act). This precludes using the applicants' earlier filed application against his/her own later filed application(s) ("self collision").

15.06.02
Copending PCT Applications

Applications filed under the provisions of the Patent Cooperation Treaty are a special case in regard to their copendency with other Canadian applications. Section 63 of the Patent Rules particularly indicates that such applications will be deemed to be applications filed in Canada at the time they become national phase applications.

For the purpose of a citation under section 28.2(1)(c) and (d) of the Patent Act in the prosecution of another application, a PCT application will benefit from its filing date or priority date only after it has entered the national phase. This could be 20 months after the filing date of the international application but may be delayed up to 42 months in certain circumstances. Should an examiner wish to cite a PCT application the status with respect to national entry in Canada must first be verified. If such application has not entered the national phase, it may be cited only as a publication using the international publication date.

15.07
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

Obviousness/Anticipation

Fada Radio v CGE	SCR	520	1927
Christiani v Rice	Ex CR	111	1929
	SCR	443	1930
	RPC	511	1931
Mico Products v Acetol	Ex CR	64	1930
Crosley Radio v CGE	SCR	551	1936
K v Uhleman Optical	Ex CR	142	1950
	1 SCR	143	1952
Comm of Pat v Ciba	SCR	378	1959
Lovell v Beatty	41 CPR	18	1962
Defrees v Dominion Auto	Ex CR	331	1963
Lamb Sets v Carlton	Ex CR	377	1964
Comm of Pat v Farbweke	SCR	49	1964
Gibney v Ford	2 Ex CR	279	1972
Xerox v IBM	33 CPR (2d)	24	1977
Marzon v Eli Lilly	37 CPR (2d)	37	1978
Globe Union v Varta	57 CPR (2d)	132	1978
Reeves Bros v Toronto	43 CPR (2d)	145	1978
Farbwerke v Halocarbon	2 SCR	929	1979
	74 CPR (2d)	95	1983
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Cutter v Baxter Travenol	68 CPR (3d)	179	1983
	74 CPR (2d)	95	1983

Johnston Controls v Varta	80 CPR (2d)	1	1984
Windsurfing v Bic Sports	8 CPR (3d)	241	1985
Beloit v Valmet	8 CPR (3d)	289	1986
Sandvick v Windsor	8 CPR (3d)	433	1986
Tye-Sil v Diversified	16 CPR (3d)	207	1987
	35 CPR (3d)	350	1991
Reading & Bates v Baker	18 CPR (3d)	181	1987
	35 CPR (3d)	350	1991
Apotex v Hoffman-La Roche	15 CPR (3d)	217	1987
	24 CPR (3d)	289	1989
Brushtech v Liberty	23 CPR (3d)	370	1988
Gorse v Upwardor	25 CPR (3d)	166	1989
	40 CPR (3d)	479	1992
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Control Data v Senstar	23 CPR (3d)	449	1989
Lubrizol v Imperial Oil	33 CPR (3d)	1	1990
	45 CPR (3d)	449	1992
Procter & Gamble v Kimberly	40 CPR (3d)	1	1991
Martinray v Fabricants	14 CPR (3d)	1	1991
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
Procter Gamble v Kimberly	40 CPR (3d)	1	1991
Re: Hering's Application	53 CPR (3d)	390	1992
	47 CPR (3d)	188	1993
Atlas v CIL	41 CPR (3d)	348	1992
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
CFM v Wolf Steel	50 CPR (3d)	215	1993
	64 CPR (3d)	75	1995
Hi-Quail v Rea's Welding	55 CPR (3d)	224	1994
Anderson v Machineries	58 CPR (3d)	449	1994
Almecon v Nutron	65 CPR (3d)	417	1996

<u>"What would infringe later, anticipates earlier"</u>

Lightning Fastener v Colonial	ExCR	89	1932
	SCR	363	1933
	51 RPC	349	1934
EMI v Lisen	56 RPC	23	1939
Atlas Copco v CIL	41 CPR (3d)	348	1992
CFM v Wolf Steel	50 CPR (3d)	215	1993
	64 CPR (3d)	75	1995

<u>subject matter reasonable inferred</u>

Re Application No. 139,256	51 CPR (2d)	95	1977

overlapping subject matter/double patenting

Short Milling v George Weston	ExCR	69	1941
Rohm & Haas v Comm of Patents	30 CPR	113	1959
Lovell v Beatty	41 CPR	18	1962
Boehringer v Bell-Craig	39 CPR	201	1962
Comm of Pat v Farbweke	41 CPR	9	1963
	SCR	49	1964
Xerox v IBM	33 CPR (2d)	24	1977
Consolboard v MacMillan	56 CPR (2d)	145	1981
	1 SCR	504	1981
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Re: Hedstrom	31 CPR (3d)	324	1989

types of prior art (printed documents, experimental use etc.)

Gibney v Ford	2 Ex CR	279	1972
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Xerox v IBM	33 CPR (2d)	24	1977
Koehering v Owens-Illinois	40 CPR (2d)	72	1978
	52 CPR (2d)	1	1980
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Johnston Controls v Varta	80 CPR (2d)	1	1984
J M Voith v Beloit	27 CPR (3d)	289	1989
Beloit v Valmet	36 CPR (3d)	322	1991
Hi-Quail v Rea's Welding	55 CPR (3d)	224	1994

CHAPTER 16

UTILITY AND NON-STATUTORY SUBJECT MATTER

16.01 SCOPE OF THIS CHAPTER
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16.02.01 An Invention Must Be Useful
16.03 PREREQUISITES OF A PATENTABLE INVENTION
16.04 EXAMPLES OF NON-STATUTORY SUBJECT MATTER
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CHAPTER 16
UTILITY AND NON-STATUTORY SUBJECT MATTER

16.01
SCOPE OF THIS CHAPTER

This chapter indicates practice on the kinds of subject matter considered to be an invention under Section 2 of the Patent Act, divorced from considerations of novelty and unobviousness. Direction is given, in particular, as to the patentability of subject matter comprising: living matter, medical treatment, diagnostic methods, and intellectual matter, including computer related matter.

16.02
DEFINITION OF A STATUTORY INVENTION

Section 2 of the Patent Act defines the essential features of an invention. It reads in part:

"invention" means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

Art means a mode, or method, or manner of accomplishing a certain result as distinct from the result. An art must accomplish some change in the character or condition of material objects. Any art which belongs to the professional fields and which is a manual art or skill is not an art within the meaning of Section 2 of the Patent Act.

A process may be defined as a mode or method of operation by which a result or effect is produced by chemical action, by the operation or application of some element or power of nature or of one substance to another.

A machine is the embodiment in mechanism of any function or mode of operation designed to accomplish a particular effect.

Manufacture is defined as anything made by the art or industry of man and connotes the making of something which must be a vendible product of a process.

Composition of matter means chemical compounds, compositions and substances.

16.02.01
An Invention Must Be Useful

Section 2 of the Patent Act requires utility as an essential feature of invention. Utility, as related to inventions, means industrial value. If an invention lacks utility for its described purpose it will result in an invalid patent should it be granted. The use of the invention must be apparent from the description to one of skill in the art

16.03
PREREQUISITES OF A PATENTABLE INVENTION

In assessing whether subject matter falls within the meaning of the definition of a patentable invention under Section 2 of the Patent Act, the prerequisites established by Canadian jurisprudence and legislation that must be satisfied are, inter alia:

(a) whether the subject matter relates to a useful art (as distinct from a fine art where the result produced is solely the exercise of personal skills, mental reasoning or judgment, or has only intellectual meaning or aesthetic appeal);

(b) whether the subject matter is operable, controllable and reproducible by the means described by the inventor so that the desired result inevitably follows whenever it is worked;

(c) whether the subject matter has practical application in industry, trade or commerce and

(d) whether it is more than a mere scientific principle or abstract theorem (Section 27(8) of the Patent Act).

16.04
EXAMPLES OF NON-STATUTORY SUBJECT MATTER

(a) Plants and animals are not patentable subject matter. Seeds are also non-patentable, however a coated seed may be patentable if the invention resides in the coating given to the seed provided that the life process of the seed has not been altered and there is no new living matter.

Plant varieties that are distinct, uniform and stable may be protected under the Plant Breeders' Rights Act, administered by Agriculture Canada.

(b) Subject matter related to a process of surgery or therapy on living humans or animals is not considered to be within the scope of "invention" as defined by section 2 of the Patent Act. The exclusion does not cover methods of treating animals to derive economic benefit. Claims which could encompass both medical and non-medical methods are not patentable. Methods of testing which do not relate to any step of surgery or therapy or vital function of the body may be patentable. Articles or apparatus designed for use in the treatment of humans or animals are patentable, provided they conform to all other conditions of the Patent

Act.

(c) Subject matter that accomplishes a result by means of a person's interpretive or judgmental reasoning cannot form the basis of a patent.

(d) Subject matter that is a process or the product of a process, that depends entirely on artistic or personal skills, such as: procedures for exercising, teaching, cosmetological procedures, hair dressing, pedicure, flower arranging, painting pictures or playing musical instruments. However, materials and instruments used in these arts may be patentable.

(e) Subject matter that is only a scheme or plan, system of doing business, method of accounting or providing statistics, personality or I.Q. test and the like is not considered to be within the scope of "invention" as defined by section 2 of the Patent Act.

(f) Subject matter comprising new rules for playing games or the like; or printed or design matter having intellectual connotations only is also unpatentable. However, structural features of printed matter and arrangements specially adapted to produce a new mechanical function or purpose may be patentable.

16.05
LIVING MATTER

Living matter is defined in terms of lower life forms which are essentially unicellular in composition (e.g. bacteria, many fungi (including yeasts), cells in culture, transformed cell lines and hybridomas), and higher life forms which are multi-cellular differentiated organisms (plants, seeds and animals).

Lower life forms which are new, useful and inventive are patentable. A process to produce or which utilizes these organisms may also be patentable.

Higher life forms are not patentable subject matter. However, a process for producing a higher life form may be patentable provided the process requires significant technical intervention by man and is not essentially a natural biological process which occurs according to the laws of nature (e.g. traditional plant cross-breeding).

16.06
SOFTWARE AND STATUTORY SUBJECT MATTER

Software implemented inventions include inventions employing a computer. The only computer-related court decision Schlumberger Canada Ltd. v. Commissioner of Patents resulted in a refusal of the application by the courts for lack of patentable subject matter.

The following principles were set out by the Court:

> In order to determine whether the application discloses a patentable invention, it is first necessary to determine what, according to the application, has been

discovered;

The fact that a computer is or should be used to implement discovery does not change the nature of that discovery;

The mere discovery that by making certain calculations according to certain formulae, useful information could be extracted from certain measurements, is not an invention within the meaning of Section 2;

A mathematical formula must be assimilated to a "mere scientific principle or abstract theorem for which Section 27(8) of the Patent Act prescribes that no patent shall issue.

16.07
SOFTWARE AND NON-STATUTORY SUBJECT MATTER

Subject matter which is outside the statutory category of subject matter in the computer implemented arts fall into the same category as non-statutory subject matter in other arts. Thus a method implementing a computer program for doing business is directed to non-statutory subject matter since methods or schemes of doing business do not meet the above test.

The scope of a patentable claim must not go beyond the limitations imposed by the mathematical operations used in the discovery. A discovery in which calculations are made in accordance with a mathematical algorithm is not patentable subject matter if the result is a mere number or an intangible entity.

Subject matter accomplishing a result by means of a person's interpretive or judgemental reasoning represents non-patentable subject matter.

Example: An icon displayed on a computer monitor having an additional pictorial image beside the icon to indicate supplemental information associated with the icon is not patentable since the image results in an intangible result requiring a mental step of associating supplemental information with the icon.

16.08
PATENTABILITY GUIDELINES

Guidelines have been established reflecting the view of the Federal Court and consistent with the trend established by the Commissioner's Decisions. A joint CPO/Patent Profession Committee agreed on the following set of guidelines replacing all previous guidelines.

1. Unapplied mathematical formulae are considered equivalent to mere scientific principles or abstract theorems which are not patentable under Section 27(8) of the Patent Act.

2. The presence of a programmed general purpose computer or a program for

such computer does not lend patentability to, nor subtract patentability from, an apparatus or process.

3. It follows from 2, that new and useful processes incorporating a computer program, and apparatus incorporating a programmed computer, are directed to patentable subject matter if the computer-related matter has been integrated with another practical system that falls within an area which is traditionally patentable. This principle is illustrative of what types of computer-related applications may be patentable, and is not intended to exclude other computer-related applications from patentability.

Claims beginning with the phrase "A program" or "A program for" are unpatentable for failure to adhere to Section 2 of the Patent Act as not falling into a useful art, process, machine, manufacture or composition of matter. A patentable computer-implemented process must be defined in a common language. Computer code falls under copyright protection.

16.09
REFERENCES

Schlumberger Canada Ltd. v. Commissioner of Patents (1981) 56 C.P.R. (2d), 204 FCA, 63 CPR (2d) 261. Leave to Appeal to the Supreme Court was refused on October 20, 1981.

"Appeal Board Decisions with Respect to Computer Software",
T. McDonough, Canadian Intellectual Property Review,
August 1985, vol. 2, no. 1, 10-16.

Commissioner's Decisions resulting in the following patents:

1,254,297, 24 C.P.R., (3d) 571
1,216,072, 13 C.P.R., (3d) 462
1,023,624, 9 C.P.R., (3d) 524
1,200,911, 9 C.P.R., (3d) 479
1,199,134, 8 C.P.R., (3d) 85
1,199,133, 9 C.P.R. (3D) 202
1,197,919, P.O.R., December 31, 1985
1,196,082, 7 C.P.R., (3d) 506
1,190,311, 6 C.P.R., (3d) 9
1,188,811, 6 C.P.R., (3d) 420
1,187,157, 6 C.P.R., (3d) 213
1,187,197, 6 C.P.R., (3d) 99
1,185,714, 6 C.P.R., (3d) 58
1,180,813, 5 C.P.R., (3d) 423
1,179,780, P.O.R., December 3, 1985
1,179,422, P.O.R., February 19, 1985
1,176,734, 5 C.P.R., (3d) 198
1,174,362, P.O.R., October 9, 1984

1,170,750, P.O.R., August 7, 1984
1,167,549, 3 C.P.R., (3d) 396
1,163,353, P.O.R., May 15, 1984
1,160,334, P.O.R., October 23, 1984
1,160,345, P.O.R., May 15, 1984
re application 178,570, (1983) 2 C.P.R. (3d) 48

16.10
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

use/utility

Mailman v Gillet	SCR	724	1932
Northern Electric v Photo	Ex CR	36	1940
	SCR	224	1941
Wandscheer v Sicard	SCR	1	1948
Metalliflex v Wienenberger	35 CPR	49	1961
	SCR	117	1961
Boehringer v Bell-Craig	39 CPR	201	1962
Rhone-Poulenc v Gilbert	55 CPR	207	1968
Burton Parsons v Hewlet	17 CPR (2d)	97	1976
	1 SCR	555	1976
Marzone v Eli Lilly	37 CPR (2d)	37	1978
Proctor & Gamble v Bristol	39 CPR (2d)	145	1978
	42 CPR (2d)	33	1979
Monsanto v Comm of Pat	42 CPR (2d)	161	1979
	2 SCR	1108	1979
Consolboard v MacMillan	56 CPR (2d)	145	1981
Radio Corp v Hazeltine	56 CPR (3d)	170	1981
Shell Oil v Comm of Pat	2 SCR	536	1982
	67 CPR (2d)	1	1982
Corning v Canada Wire & Cable	81 CPR (2d)	39	1984
Lubrizol v Imperial Oil	33 CPR (3d)	11	1990
	45 CPR (3d)	449	1992
TRW Inc v Walbar	39 CPR (3d)	176	1991
Welcome v Apotex	39 CPR (3d)	289	1991
Haul-All v Shanahan	50 CPR (3d)	368	1993
Unilever v Procter & Gamble	47 CPR (3d)	479	1993
	61 CPR (3d)	499	1995
Feherguard v Rocky's	53 CPR (3d)	417	1994
	60 CPR (3d)	512	1995

novelty in utility

Wright v Brake Service	Ex CR	127	1925
Pope Appliance v Spanish River	Ex CR	28	1926
Canadian Gypsum v Gypsum Lime	Ex CR	180	1931
Mailman v Gillet	SCR	724	1932
Lanlois v Roy	Ex CR	197	1941
Northern Electric v Browns	SCR	224	1941
Shell Oil v Comm of Pat	2 SCR	536	1982
	67 CPR (2d)	1	1982
Apotex v Hoffman-La Roche	15 CPR (3d)	217	1987
	24 CPR (3d)	289	1989
Re: Wayne State	22 CPR (3d)	407	1988

nonstatutory subject matter

Lawson v. Comm of Patents	62 CPR	101	1970
Tennessee v Comm of Patents	62 CPR	117	1970
	SCR	111	1974

Re: Application for Patent Containing Claims that Read on Mental Steps Performed by a Human	23 CPR (2d)	93	1972
Re: Polnauer	104 CPOR 40-xii		1976
Re: Dixon	60 CPR (2d)	105	1978
Re: Pallos	1 CPR (3d)	334	1978
Re: 079,973	54 CPR (2d)	124	1979
Schlumberger v Comm of Patent	56 CPR (2d)	204	1981
	63 CPR (2d)	261	
Re: Abitibi Co.	62 CPR (2d)	81	1982
ICI v Comm of Patents	9 CPR (3d)	289	1986
	3 FC	40	1986
Pioneer Hi-Bred v Com of Pat	14 CPR (3d)	491	1987
	25 CPR (3d)	257	1987
Re: Goldenberg	22 CPR (3d)	159	1988
Re: Clorox Co.	33 CPR (3d)	160	1990

CHAPTER 17

BIOTECHNOLOGY

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17.03 DEPOSIT OF BIOLOGICAL MATERIAL
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- 17.09.01 Access to a Deposit Referred to in an Issued Patent
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17.10 NEW AND TRANSFERRED DEPOSITS
17.11 SUMMARY OF DEPOSIT REQUIREMENTS
17.12 NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS
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17.15 SEQUENCES PRESENTING NUCLEOTIDES AND AMINO ACIDS
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17.17 RELATED SEQUENCES
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17.19 COMPUTER-READABLE FORM OF THE SEQUENCE LISTING
17.20 UTILITY PROGRAM
17.21 CPOR PUBLICATIONS

CHAPTER 17
BIOTECHNOLOGY

17.01
SCOPE OF THIS CHAPTER

This chapter outlines practice respecting section 38.1 of the Patent Act and sections 103-110, 159-166 and 183-187 of the Patent Rules regarding deposits of biological material, as well as practices and procedures as they relate to sections 111 to 131 of the Patent Rules regarding sequence listings.

17.02
BIOLOGICAL MATERIAL

For the purposes of section 38.1 of the Patent Act, the term "biological material" includes material which is capable of self-replication, either directly or indirectly. Direct self-replicating biological material is material which replicates by itself. Indirect self-replicating biological material is material which is capable of replication only when it is associated with self-replicating biological material. Bacteria, fungi (including yeast), cells in culture and hybridomas are representative examples of direct self-replicating material; indirect self-replicating material includes nucleotide sequences, plasmids, vectors, viruses, phages and replication-defective cells.

17.03
DEPOSIT OF BIOLOGICAL MATERIAL

A specification must contain a full description of an invention, to enable a person skilled in the art or science to which the invention pertains, to make and use the invention. When an invention is a biological material or when a biological material is needed to practice an invention, words alone may not be sufficient to fulfill the statutory requirements of subsection 27(3) of the Patent Act. Access to the biological material may also be necessary.

Section 38.1 of the Patent Act applies to an application filed in Canada (regardless of its filing date), and to any patent issued on the basis of such an application, and provides for a deposit of biological material to be taken into consideration when a determination is made as to whether or not subsection 27(3) of the Patent Act has been complied with. The deposit must be in accordance with the Patent Rules and must have been referred to in the specification at the time of filing.

Reference to a deposit is not intended to replace a written description of an invention but rather to supplement it.

17.04
THE BUDAPEST TREATY

The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (The Budapest Treaty) was established in 1977. The Treaty is administered by WIPO and obliges contracting states to recognize the fact and date of a deposit of biological material for patent purposes, when it is made in a depositary which has acquired official status under the Treaty. Such a depositary is known as an International Depositary Authority (IDA). An applicant who is making multiple patent filings need only make one IDA deposit to satisfy the deposit practice in all contracting states.

The Budapest Treaty came into force, with respect to Canada, on September 21, 1996.

17.05
WHEN A DEPOSIT MAY BE NECESSARY

If an invention relies on biological material, an examiner must determine if the written description alone is sufficient to satisfy the requirements of subsection 27(3) of the Patent Act or if access to the material is also necessary. If access is necessary in order to practice the invention, a deposit will be required unless the biological material is publicly known and readily available.

Biological material is considered to be publicly accessible if it can be obtained commercially or if it can be repeatably prepared or isolated from available materials using established procedures and without any further experimentation.

An applicant who relies on public accessibility rather than a deposit takes the risk however, that a patent may some day be held to be invalid if the biological material necessary to practice the invention ceases to be accessible to the public.

17.06
WHEN AND WHERE TO MAKE A DEPOSIT

For an application filed on or after October 1, 1996, an original deposit of biological material must be made by the applicant, in an IDA, on or before the filing date (subsection 104(1) of the Patent Rules).

For an application filed before October 1, 1996 (and for a patent which may have issued on the basis of such an application), an original deposit of biological material must have been made by the applicant, on or before the filing date, either in an IDA or in some other depositary from which samples are made available to the public, either after the application is open to public inspection under section 10 of the Patent Act (for applications filed on or after October 1, 1989 but before October 1, 1996) or after the issuance of a patent (for applications filed before October 1, 1989). If the deposit was not made in an IDA, a deposit of the same biological material must be made in an IDA on or before October 1, 1997 (subsections 160(1), 160(2), 184(1) and 184(2) of the Patent Rules).

17.07
DEPOSIT INFORMATION

For IDA deposits as well as non-IDA deposits, made for the purposes of section 38.1 of the Patent Act, the Commissioner of Patents must be informed of the name of the depositary and the date of the deposit, if this information is not already included in the specification. In the case of an IDA deposit, the accession number given to the deposit is also required. Thus, if a non-IDA deposit was made before October 1, 1996 and then an original IDA deposit of the same biological material was made (on or before October 1, 1997), the names of both depositaries, as well as the dates of deposit in each, and the IDA accession number, must be provided.

For an application filed on or after October 1, 1996, the deposit information must be provided before the application is open to public inspection under section 10 of the Patent Act (subsection 104(2) of the Patent Rules) and must be included in the description (subsection 104(3) of the Patent Rules).

For an application filed on or after October 1, 1989 but before October 1, 1996 (as well as for a patent which may have issued on the basis of such an application), IDA deposit information, as well as that for any prior non-IDA deposit of the same biological material, must be provided on or before January 1, 1998 or before the application is open to public inspection under section 10 of the Patent Act, whichever comes later (subsections 160(2) and 160(3) of the Patent Rules).

For an application filed before October 1, 1989 (as well as for a patent which may have issued on the basis of such an application), IDA deposit information, as well as that for any prior non-IDA deposit of the same biological material, must be provided on or before January 1, 1998 (subsections 184(2) and 184(3) of the Patent Rules).

The time for providing deposit information cannot be extended. If the information is not provided within the prescribed time, the deposit is not a deposit for the purposes of section 38.1 of the Patent Act.

17.08
TERM OF DEPOSIT

When a sample of biological material is deposited in an IDA under the Budapest Treaty for the purposes of patent protection, the depositor undertakes not to withdraw the sample for a period of at least 30 years from the date of deposit and for at least five years from the date of the most recent request made to the depositary for the furnishing of a sample of the deposited material (Rules 6 and 9 of the Regulations under the Budapest Treaty).

17.09
ACCESS TO DEPOSITED BIOLOGICAL MATERIAL

References to deposited biological material become public once a patent application is open to inspection under section 10 of the Patent Act or once a patent issues (for applications filed before October 1, 1989). A request form for the furnishing of a sample of deposited material will be published from time to time in the Canadian Patent Office

Record (CPOR).

17.09.01
Access to a Deposit Referred to in an Issued Patent

A request for the furnishing of a sample of a deposit can be made by anyone and is filed with the Commissioner of Patents.

17.09.02
Access to a Deposit Referred to in a Laid-open Application

A request for the furnishing of a sample of a deposit can be made by anyone if a) the application has been withdrawn, abandoned and no longer subject to reinstatement, or finally refused, or b) the application is still pending and access has not been restricted to an independent expert (see below). The request is filed with the Commissioner of Patents.

An applicant may file notice with the Commissioner of Patents that samples of deposited biological material be furnished only to an independent expert nominated by the Commissioner (subsections 104(4) and 160(4) of the Patent Rules). The restriction applies until either a patent has issued on the basis of the application or until the application is finally refused, abandoned and not subject to reinstatement, or withdrawn. The notice must be filed within the following prescribed time periods which cannot be extended: (a) before an application is open to public inspection under Section 10 of the Patent Act, for applications filed on or after October 1, 1996 (subsection 104(4) of the Patent Rules); (b) on or before January 1, 1998 or before an application is open to public inspection under Section 10 of the Patent Act, whichever comes later, for applications filed on or after October 1, 1989 but before October 1, 1996 (subsection 160(4) of the Patent Act).

While the access restriction is in effect, only a nominated expert can file a request with the Commissioner of Patents for the furnishing of a sample of a deposit (subsections 110(1) and 166(1) of the Patent Rules).

17.09.03
Nomination of an Independent Expert

The Commissioner of Patents will nominate an independent expert with the agreement of the applicant (subsections 109(1) and 165(1) of the Patent Rules). Both the applicant and the person requesting that an expert be nominated may make suggestions as to who would be a suitable expert. In the event that the Commissioner of Patents and the applicant cannot agree on an acceptable expert, within a reasonable time after a request has been made that such an expert be nominated, the notice, that access to a deposit be restricted to an expert, is deemed never to have been filed (subsections 109(2) and 165(2) of the Patent Rules).

17.09.04
Undertaking

If a request is filed for the furnishing of a sample of deposited biological material referred

to in a pending application, the request must include an undertaking that either until a patent has issued on the basis of the application or until the application has been withdrawn, abandoned and no longer subject to reinstatement, or finally refused, the requester will not make a sample of the furnished material available to any other person and will use the sample only for experiments that relate to the subject matter of the application (sections 108 and 164 of the Patent Rules).

17.09.05
Certification

After a request has been filed with the Commissioner of Patents for the furnishing of a sample of deposited biological material, the Commissioner will certify that the deposit is referred to in an application for patent in Canada or in a Canadian patent, that the requester has fulfilled all conditions for the furnishing of a sample, and that the requester has a right to a sample of the deposited material (subsections 107(2), 163(2) and 187(2) of the Patent Rules and Rule 11.3(a) of the Regulations under the Budapest Treaty).

A copy of the request along with the certification is then sent to the requester (subsections 107(3), 163(3) and 187(3) of the Patent Rules) or in the case where the requester is an independent expert, to the applicant and to the person who requested the nomination of the expert (subsections 110(2) and 166(2) of the Patent Rules).

17.10
NEW AND TRANSFERRED DEPOSITS

After an original sample of biological material has been deposited in an IDA (an original IDA deposit), circumstances may necessitate that either a new sample of the same material be deposited in the same or a different IDA (Article 4 of the Budapest Treaty) or that the sample be transferred to a substitute IDA (Rule 5 of the Regulations under the Budapest Treaty).

If an IDA cannot furnish a sample of deposited material because it is no longer viable, a depositor must make a new deposit in the same IDA.

If an IDA cannot furnish a sample of deposited material because a) the sample must be sent abroad and this is prevented by export or import restrictions, or b) the IDA ceases to have the status of an IDA, either entirely or in respect of the kind of material deposited, a depositor must make a new deposit in another IDA.
To maintain an original IDA deposit date, a new deposit must be made within three months of the depositor receiving notice from an IDA that a sample is no longer viable or cannot be sent abroad, or that the IDA's status has changed. The deposit must be accompanied by a statement that the newly deposited material is the same as that originally deposited. If a new deposit is not made, the original deposit is treated as if had never been made (subsection 106(2) of the Patent Rules).

If an IDA temporarily or permanently discontinues any of the tasks required of it as an IDA such that samples of deposited biological material can no longer be provided, the defaulting IDA is required to transfer samples of deposited materials to another IDA. The new IDA is referred to as a substitute IDA and the deposit is known as a substitute deposit.

Where an applicant or patentee makes a new deposit of originally deposited biological material, or where an original deposit is transferred to a substitute IDA, the applicant or patentee must inform the Commissioner of Patents of the name of the new or substitute IDA and the accession number given to the deposit by that IDA.

For applications filed on or after October 1, 1996, the new or substitute deposit information must be provided within three months of receiving a deposit receipt from the IDA (section 105 and subsection 106(1) of the Patent Rules).

For applications filed before October 1, 1996, the new or substitute deposit information must be provided on or before the later of January 1, 1998 and three months from the date the IDA issues a deposit receipt (sections 161 and 185 and subsections 162(1) and 186(1) of the Patent Rules).

17.11
SUMMARY OF DEPOSIT REQUIREMENTS

The deposit referred to in section 38.1 of the Patent Act is considered as part of the specification of a patent application or of an issued patent if:

1) the deposit was made on or before the filing date of the application;

2) the deposit was made in an IDA or in a non-IDA depositary from which samples of deposited material can be obtained on reasonable terms by the public;

3) an original IDA deposit is made within a prescribed period of time where the deposit referred to in the specification was made in a non-IDA depositary;

4) a required new deposit of an original IDA deposit is made within a prescribed period of time;

5) deposit information in respect of any IDA deposit (original, new or substitute) or of a non-IDA deposit is provided to the Commissioner within a prescribed period of time.

If any one of these conditions is not met, a deposit is not a deposit for the purposes of section 38.1 of the Patent Act. A specification is then viewed as if the deposit was never made.

17.12
NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS

Applications filed on or after October 1, 1996, which disclose nucleotide or amino acid sequences (see definitions in sections 17.13 and 17.14 of this chapter), that do not form part of the prior art, must contain a sequence listing containing the actual sequence(s) and associated information. An applicant must also file a copy of the sequence listing in computer-readable form and a statement that the content of the paper and electronic forms of the listing are the same (section 111 of the Patent Rules).

If a sequence listing is amended, an amended copy of the computer-readable form of the listing must also be filed along with a statement that the content of both forms of the amended listing is the same (section 112 of the Patent Rules).

The sequence listing is part of the description and must begin on a separate page entitled "Sequence Listing". Each sequence set forth in the listing is recited using a standard set of symbols and in a defined format, and is assigned a separate identifier such as "SEQ ID NO:1", "SEQ ID NO:2", SEQ ID NO:3", etc. (subsection 113(2) of the Patent Rules). The identifier may be used in the abstract, description, claims or drawings to refer to the sequence.

If an application requires a sequence listing, and the paper version or computer-readable version is not submitted at the time of filing, the application is incomplete and an applicant must submit the missing document(s) within the time limits set out in section 62 or section 94 of the Patent Rules in order to avoid abandonment. However, if a sequence listing is submitted after the filing date of an application, the actual nucleotide or amino acid sequence(s) recited in the listing must have been disclosed somewhere in the application (description, claims or figures) at the time of filing to avoid a "new matter" rejection under section 38.2 of the Patent Act.

17.13
NUCLEOTIDE SEQUENCES

"Nucleotide sequence" means an unbranched sequence of ten or more contiguous nucleotides (section 2 of the Patent Rules). "Nucleotides" means those nucleotides which can be represented using the symbols in TABLE 1 as well as nucleotides derived from these by way of modification (sections 2 and 115 of the Patent Rules).

TABLE 1

Symbol	Meaning	
	Origin of Designation	
A	A	Adenine
G	G	Guanine
C	C	Cytosine
T	T	Thymine
U	U	Uracil
R	G or A	puRine
Y	T/U or C	pYrimidine
M	A or C	aMino
K	G or T/U	Keto
S	G or C	Strong interactions (3 H bonds)
W	A or T/U	Weak interactions (2 H bonds)
B	G or C or T/U	not A
D	A or G or T/U	not C
H	A or C or T/U	not G
V	A or G or C	not T, not U
N	A or G or C or T/U or unknown or other	aNy

Modified nucleotides are identified within a sequence by the symbol "N" with the nature of the modification described elsewhere in the sequence listing (normally in the "Feature" section). The symbols set out in TABLE 2 may be used anywhere in the sequence listing, except in the actual sequence, to describe modified nucleotides (section 116 of

the Patent Rules).

TABLE 2

Symbol	Meaning
ac4c	4-acetylcytidine
chm5u	5-(carboxyhydroxylmethyl)uridine
cm	2'-O-methylcytidine
cmnm5s2u	5-carboxymethylaminomethyl-2-thiouridine
cmnm5u	5-carboxymethylaminomethyluridine
d	dihydrouridine
fm	2'-O-methylpseudouridine
gal q	β,D-galactosylqueuosine
gm	2'-O-methylguanosine
i	inosine
i6a	N6-isopentenyladenosine
m1a	1-methyladenosine
m1f	1-methylpseudouridine
m1g	1-methylguanosine
m1i	1-methylinosine
m22g	2,2-dimethylguanosine
m2a	2-methyladenosine
m2g	2-methylguanosine
m3c	3-methylcytidine
m5c	5-methylcytidine
m6a	N6-methyladenosine
m7g	7-methylguanosine
mam5u	5-methylaminomethyluridine
mam5s2u	5-methoxyaminomethyl-2-thiouridine
man q	β,D-mannosylqueosine
mcm5s2u	5-methoxycarbonylmethyl-2-thiouridine
mcm5u	5-methoxycarbonylmethyluridine
mo5u	5-methoxyuridine
ms2i6a	2-methylthio-N6-isopentenyladenosine
ms2t6a	N-((9-β-D-ribofuranosyl-2-methylthiopurine-6-yl)carbamoyl)threonine
mt6a	N-((9-β-D-ribofuranosylpurine-6-yl)N-methylcarbamoyl)threonine
mv	uridine-5-oxyacetic acid-methylester
o5u	uridine-5-oxyacetic acid (v)
osyw	wybutoxosine
p	pseudouridine
q	queuosine
s2c	2-thiocytidine
s2t	5-methyl-2-thiouridine
s2u	2-thiouridine
s4u	4-thiouridine
t	5-methyluridine
t6a	N-((9-β-D-ribofuranosylpurine-6-yl)carbamoyl) threonine
tm	2'-O-methyl-5-methyluridine
um	2'-O-methyluridine
yw	wybutosine
x	3-(3-amino-3-carboxy-propyl)uridine, (acp3)u

A nucleotide sequence recited in a sequence listing is presented only by a single nucleotide strand, in the 5' to 3' direction from left to right (section 114 of the Patent Rules).

Nucleotides in the non-coding portion of the sequence (including introns) are listed in groups of 10 with a space between each group with up to 60 nucleotides per line. When there are fewer than 10 "leftover" nucleotides at the ends of non-coding sequences, they are grouped together and separated from adjacent groups by a space (sections 120 and 122 of the Patent Rules).

Nucleotides in the coding regions of a nucleotide sequence are grouped together as codons which are separated from each other by a space with a maximum of 16 codons per line.

A nucleotide sequence is numbered continuously from the first nucleotide in the sequence, identified as number 1, in the 5' to 3' direction. In the right margin of the sequence listing, next to each line of one-letter nucleotide codes, is inserted the number of the last nucleotide in that line (section 125 of the Patent Rules).
For circular nucleotide sequences, an applicant can designate any nucleotide to be nucleotide number 1 (section 128 of the Patent Rules).

17.14
AMINO ACID SEQUENCES

"Amino acid sequence" means an unbranched sequence of four or more contiguous amino acids. "Amino acid" means those L-amino acids commonly found in naturally occurring proteins as well as amino acids derived from these by way of modification (section 2 of the Patent Rules). A D-amino acid is considered to be a modified L-amino acid.

Only the symbols in TABLE 3 may be used within a sequence to identify an amino acid (section 118 of the Patent Rules). The symbol "Xaa" is used to denote D-amino acids, or unknown or modified amino acids. Any amino acids designated as "Xaa" are further described elsewhere in the listing (normally under the heading "Feature") with respect to the nature of the modification. The symbols in TABLE 4 may be used anywhere in the sequence listing, except in the actual sequence, to describe modified amino acids (section 119 of the Patent Rules).

TABLE 3

Symbol	Meaning
Ala	Alanine
Arg	Arginine
Asn	Asparagine
Asp	Aspartic acid
Asx	Aspartic acid or asparagine
Cys	Cysteine
Glu	Glutamic acid
Gln	Glutamine
Glx	Glutamic acid or glutamine
Gly	Glycine
His	Histidine
Ile	Isoleucine
Leu	Leucine
Lys	Lysine

Met	Methionine
Phe	Phenylalanine
Pro	Proline
Ser	Serine
Thr	Threonine
Trp	Tryptophan
Tyr	Tyrosine
Val	Valine
Xaa	D-amino acid, unknown or other

TABLE 4

Symbol	Meaning
Aad	2-Aminoadipic acid
bAad	3-Aminoadipic acid
bAla	β-Alanine, β-Aminopropionic acid
Abu	2-Aminobutyric acid
4Abu	4-Aminobutyric acid, piperidinic acid
Acp	6-Aminocaproic acid
Ahe	2-Aminoheptanoic acid
Aib	2-Aminoisobutyric acid
bAib	3-Aminoisobutyric acid
Apm	2-Aminopimelic acid
Dbu	2,4-Diaminobutyric acid
Des	Desmosine
Dpm	2,2'-Diaminopimelic acid
Dpr	2,3-Diaminopropionic acid
EtGly	N-Ethylglycine
EtAsn	N-Ethylasparagine
Hyl	Hydroxylysine
aHyl	allo-Hydroxylysine
3Hyp	3-Hydroxyproline
4Hyp	4-Hydroxyproline
Ide	Isodesmosine
alle	allo-Isoleucine
MeGly	N-Methylglycine, sarcosine
Melle	N-Methylisoleucine
MeLys	6-N-Methyllysine
MeVal	N-Methylvaline
Nva	Norvaline
Nle	Norleucine
Orn	Ornithine

Hydroxylations, glycosylations and other post-translational modifications are not to be shown explicitly within the amino acid sequence itself but noted under the heading "Feature" within the sequence listing.

An amino acid sequence is listed in the amino to carboxyl direction, from left to right, without the presentation of the terminal 5'-amino or 3'-carboxyl groups (section 117 of the Patent Rules). Up to 16 amino acids may be listed per line with a space between each three letter amino acid symbol (section 123 of the Patent Rules).

If the amino acid sequence does not include a mature protein, the sequence is numbered beginning at the amino terminus with the number 1 placed under the first amino acid.

The sequence is then marked every five amino acids with the numbers 5, 10, 15, etc. placed under the sequence.

If the amino acid sequence comprises a mature protein, the amino acid at the amino terminus of this protein is designated as amino acid number 1. Any pre-sequences, pro-sequences, pre-pro-sequences or signal sequences which precede the mature protein are negatively numbered counting backwards with the amino acid next to the first amino acid of the mature protein designated as number -1 (section 126 of the Patent Rules).

In a circular amino acid sequence, which does not include a mature protein, any amino acid can be designated as amino acid number 1 (section 128 of the Patent Rules).

17.15
SEQUENCES PRESENTING NUCLEOTIDES AND AMINO ACIDS

When a nucleotide sequence containing one or more coding regions is listed with the encoded amino acids, the amino acid sequence is typed immediately below the corresponding nucleotide codons. Where a codon spans an intron, the amino acid symbol is typed below that portion of the codon containing two nucleotides (section 124 of the Patent Rules).

17.16
HYBRID AND GAPPED SEQUENCES

A sequence which is made up of one or more non-contiguous segments of a larger sequence, or consists of segments from different sequences, must be listed as a separate sequence in a sequence listing and assigned its own identifier number. A sequence which contains "gaps", representing undisclosed regions between disclosed regions in a sequence, must be presented as a plurality of separate sequences, each corresponding to a disclosed region and each with its own identifier number in the sequence listing (section 127 of the Patent Rules).

17.17
RELATED SEQUENCES

Multiple sequences may be presented on a single page in a sequence listing if a) the sequences are related in some manner, b) the data element information applies to all of the sequences, and c) each sequence is assigned its own identifier number.

A single, general sequence may be presented, and variants of this sequence referred to, without presenting each variant as a separate sequence in a sequence listing. For example, if a sequence is deleted at the C-terminus by 1, 2, 3, 4 or 5 residues, all of the variations do not need to be included in the sequence listing. Only the undeleted sequence needs to be included and the related sequences may be described as SEQUENCE ID NO: X from which deletions have been made at the C terminus by 1, 2, 3, 4 or 5 residues.

Sequence identifiers can be used to refer to parts or fragments of sequences, for example, "residues 14 to 243 of SEQUENCE ID NO: 23". The fragment need not be separately presented in the sequence listing.

17.18
SEQUENCE LISTING HEADINGS

A sequence listing must include at least one nucleotide or amino acid sequence and immediately preceding the sequence(s), the following data element headings (capitalized items) which are followed by text. When more than one line of text is necessary, additional lines are indented from the heading or subheading at the left margin (section 129 of the Patent Rules). The information associated with each heading or subheading must be provided, if applicable and when available to the applicant (section 130 of the Patent Rules) and the listing must follow the order in which the data element headings are presented in the Patent Rules. Data is entered for headings or subheadings which are followed by a colon (:).

(1) GENERAL INFORMATION
(under the following headings or subheadings, provide information about the applicant, the application, the applicant's agent, the number of sequences in the listing and how the computer-readable form of the listing was prepared)

(i) APPLICANT:
(name and address of each applicant - for a person, the family name first followed by a comma and then the first name and/or initials; for a legal entity, its full official name)

(ii) TITLE OF INVENTION:
(as in the petition)

(iii) NUMBER OF SEQUENCES:
(number of sequences in the "Sequence Listing")

(iv) CORRESPONDENCE ADDRESS:
(address in Canada of applicant, agent or representative (as the case may be) where correspondence can be sent)

(v) COMPUTER-READABLE FORM
(provide information under the following subheadings)

a) COMPUTER:
(type of computer used with diskette submitted)

b) OPERATING SYSTEM:
(type of operating system used)

c) SOFTWARE:
(type of software used)

(vi) CURRENT APPLICATION DATA
(provide data about the current Canadian application under the following subheadings)

a) APPLICATION NUMBER:

b) FILING DATE:

c) CLASSIFICATION:

(vii) PRIOR APPLICATION DATA

(provide data about any Canadian or foreign priority applications or an international application under the following subheadings)

a) APPLICATION NUMBER:
(specify two letter country code and application number; if a PCT application, identify by the letters "PCT", followed by a slash, followed by the two digit country code of the receiving office, followed by the two digit year of filing, followed by a slash, followed by the application number)

b) FILING DATE:

c) CLASSIFICATION:

(viii) PATENT AGENT INFORMATION
(provide data under the following subheadings)

a) NAME:

b) REFERENCE NUMBER:
(agent's file number)

(2) INFORMATION FOR SEQ ID NO:
(assign an identifier number to the sequence; under the following headings provide information descriptive of the nucleotide or amino acid sequence; repeat (2) for each sequence in the listing)

(i) SEQUENCE CHARACTERISTICS
(provide data under the following subheadings)

a) LENGTH:
(sequence length, expressed as number of nucleotides or amino acids)

b) TYPE:
(sequence type, i.e. whether nucleotide or amino acid)

c) STRANDEDNESS:
(if nucleic acid, number of strands of source organism molecule, i.e., whether single stranded, double stranded, both, or unknown to applicant)

d) TOPOLOGY:
(whether source organism molecule is circular, linear, both, or unknown to applicant)

(ii) MOLECULE TYPE:
(type of molecule sequenced, i.e., genomic RNA, genomic DNA, mRNA, tRNA, rRNA, snRNA, scRNA, preRNA, cDNA to genomic RNA, cDNA to mRNA, cDNA to tRNA, cDNA to rRNA, cDNA to snRNA, cDNA to scRNA, other nucleic acid (specify), protein, peptide)

(iii) HYPOTHETICAL (yes/no):
(is SEQ ID NO: X a hypothetical sequence?)

(iv) ANTI-SENSE (yes/no):

(v) FRAGMENT TYPE:
(for proteins and peptides only; select from: N-terminal fragment, C-terminal fragment, internal fragment)

(vi) ORIGINAL SOURCE:
(original source of SEQ ID NO: X)

(vii) IMMEDIATE SOURCE:
(immediate experimental source of SEQ ID NO: X)

(viii) POSITION IN GENOME
(provide data under the following subheadings about the position in the genome of SEQ ID NO: X)

a) CHROMOSOME/SEGMENT:
(chromosome/segment - name/number)

b) MAP POSITION:

c) UNITS:
(units for map position, i.e. whether units are genome percent, nucleotide number or other (specify))

(ix) FEATURE

(provide information under the following subheadings about points of biological significance as well as "N" designated nucleotides and "Xaa" designated amino acids in SEQ ID NO: X; repeat for each feature)

(significant features might include: active-site, allele, attenuator, binding-site, CAAT signal, cellular, cleavage-site, coding sequence, cross-link, D-loop, disulfide bond, domain, enhancer, exon, GC signal, inhibitory-site, insertion sequence, intron, LTR (long terminal repeat), mature peptide, modified nucleotide or amino acid, mRNA, mutation, peptide, polyA signal, polyA site, precursor RNA, primary transcript, primer binding, promoter, provirus, RBS (ribosome binding site), repeating unit, repeat region, replication origin, rRNA, satellite, stem loop, TATA signal, terminator, thiolester-bond, transit peptide, transposon, tRNA, variation, virion, 3' clip, 3'UTR, 5' clip, 5'UTR, -10 signal, or -35 signal)

a) NAME/KEY:
(provide appropriate identifier for feature)

b) LOCATION:
(specify location of feature within SEQ ID NO: X with reference to nucleotide or amino acid position numbers; indicate if feature is on the complementary strand to that listed)

c) IDENTIFICATION METHOD:
(method by which the feature was identified, i.e., by experiment, by similarity with known sequence or to an established consensus sequence, or by similarity to some other pattern)

d) OTHER INFORMATION:
(include information on phenotype conferred, biological activity of

sequence or its product, macromolecules which bind to sequence or its product, or other relevant information)

X) PUBLICATION INFORMATION
(publications in which SEQ ID NO: X is disclosed; provide data under the following subheadings; repeat for each relevant publication)

a) AUTHOR(S):

b) TITLE:
(title of publication)

c) JOURNAL:
(journal name)

d) VOLUME:
(journal volume)

e) ISSUE:
(journal issue number)

f) PAGE(S):
(journal page number(s))

g) DATE:
(date of journal publication)

h) DOCUMENT NUMBER:
(patent document number; specify two letter country code and publication number; if a PCT publication, identify by the letters "WO", followed by a slash, followed by the publication number)

i) FILING DATE:
(patent document filing date)

j) PUBLICATION DATE:
(patent document publication date)

k) RELEVANT RESIDUES IN SEQUENCE ID NO:
(insert the identifier number and indicate relevant residues with reference to nucleotide or amino acid position numbers)

(xi) SEQUENCE DESCRIPTION: SEQUENCE ID NO:
(insert the identifier number)

17.19
COMPUTER-READABLE FORM OF THE SEQUENCE LISTING

The electronic version of the listing must be submitted on diskette which is write-protected and permanently affixed with a label containing the following information: the format of the diskette, the type of computer and operating system that generated the file on the diskette, the date on which the data file was generated, the name of the applicant, the title of the invention and a reference number related to the application. If the diskette is submitted after the filing date of an application, the label must also include the filing date of the application, the application number and any other information necessary to identify the application. If all of the foregoing information cannot be included on a

permanently affixed label, the label must include at least the name of the applicant, the title of the invention and a reference number. The remainder of the information must be provided on the container that the diskette was provided in (section 131 of the Patent Rules).

The computer-readable version of the sequence listing is encoded in a subset of the American Standard Code for Information Interchange (ASCII). This subset consists of all the printable ASCII characters including the space, line-termination, pagination and end-of-file characters associated with the computer/operating system configurations specified below. The diskette must be readable on one of these configurations and formatted such that a printed copy of the sequence listing can be recreated. Any changes in acceptable computer/operating systems for sequence submissions will be published in the Canadian Patent Office Record (subsection 131(1) of the Patent Rules).

(1)	Computer:	IBM* PC/XT/AT, IBM PS/2 or compatibles
	Operating system:	PC-DOS or MS-DOS** (Versions 2.1 or above)
	Line Terminator:	ASCII Carriage Return plus ASCII Line Feed
	Pagination:	ASCII Form Feed or Series of Line Terminators
	End-of-File:	ASCII SUB (Ctrl-Z)
	Print Command:	PRINT filename.extension
(2)	Computer:	Apple Macintosh***
	Operating System:	Macintosh
	Macintosh File Type:	Text with line termination
	Line Terminator:	Pre-defined by text type file
	Pagination:	Pre-defined by text type file
	End-of-file:	Pre-defined by text type file
	Print Command:	Use PRINT command from any Macintosh application that processes text files, such as MacWrite**** or TeachText

* IBM is a registered trade-mark of International Business Machine Corporation
** MS-DOS is a registered trade-mark of Microsoft Corporation
*** Apple and Macintosh are registered trade-marks of Apple Computer, Inc.
**** MacWrite is a registered trade-mark of Claris Corporation

17.20
UTILITY PROGRAM

To facilitate compliance with the Patent Rules, an input program is available for preparing sequence listings. This program is called PatentIn and is available from the United States Patent and Trademark Office or from the European Patent Office.

PatentIn is designed for IBM PC XT, AT, PS/2 and compatible computers and runs only on a system with a hard disk drive. MS-DOS or PC-DOS Version 3.0 or higher is recommended. A Macintosh version of PatentIn is not available.

PatentIn is not required for creating a sequence listing. However, its use is highly recommended.

17.21
CPOR PUBLICATIONS

From time to time, the Commissioner of Patents will publish the following in the Canadian Patent Office Record (CPOR): a) a request form for the furnishing of a sample of a deposit, b) a list of IDAs, and c) acceptable computer/operating systems for preparing diskettes containing computer-readable copies of sequence listings.

CHAPTER 18

PROTESTS AND FILING OF PRIOR ART

18.01 FILING PRIOR ART
18.02 PROTESTS
18.03 AFFIDAVITS
18.04 APPLYING PROTESTS OR FILING OF PRIOR ART
18.05 PROTESTS OR FILING OF PRIOR ART AND CONFIDENTIALITY

CHAPTER 18
PROTESTS AND FILING OF PRIOR ART

18.01
FILING PRIOR ART

Under section 34.1 of the *Patent Act*, any person may file prior art with the Commissioner. This prior art can consist of patents, applications for patents open to public inspection, or publications that the person believes have a bearing on the patentability of any claim in a patent application. Prior art filed with the Commissioner under section 34.1 of the *Patent Act* must be accompanied by an explanation of why the art is pertinent. If the application referred to by the person submitting the prior art is a PCT application which has not yet entered the national phase in Canada, the Canadian Patent Office (CPO) will retain the submission until the last date for late national entry in Canada has expired.

When prior art is received under the provisions of section 34.1 of the *Patent Act*, the provider is notified that the filing of prior art has been received, but the provider will not be informed regarding the action taken thereon[1]. The prior art material is made part of the file of the application and the applicant of that application is notified that a submission of prior art has been made. The prior art is only considered by the examiner after a request for examination has been received. The normal prosecution, including allowance of applications, continues despite the submission of a filing of prior art[2], unless sufficient grounds are presented to warrant action based on this filing of prior art.

When there is no prior art listed or when there is no explanation of why the art is pertinent, in a "filing of prior art" letter, this letter is then treated and considered as a protest.

18.02
PROTESTS

In accordance with section 10 of the *Patent Rules*, any written communication made to the Commissioner with the stated or apparent intention of protesting against the granting of a patent is acknowledged by the Commissioner. The protestor will not be informed regarding the action taken thereon[1]. However a protestor may have access to

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1 Section 10 of the *Patent Rules*: "... no information shall be given as to the action taken".

2 Monsanto Company *et al.* v. Commissioner of Patents *et al.* (1999), 1 C.P.R. (4th) 500 at 511 *"...Notice of Allowance is not a decision subject to judicial review either by the applicant or a third party."*

the prosecution file of the application at the time of opening to public inspection. When the information is available during the pendency of an application, a protest provides an adequate alternative remedy that should be exhausted by a competitor before seeking judicial review[3].

Protests may develop as a result of public inspection of opened applications. A protest may also develop as a result of a search request under section 11 of the *Patent Act* by means of which the protestor has discovered that there is a pending application that corresponds to a foreign patent. In these cases the protestor should identify the Canadian patent publication number (if following a public inspection of opened applications), or the foreign patent publication (if following a request under section 11 of the *Patent Act*). Any protest that fails to identify an application by number, inventor or applicant reduces the likelihood of the Commissioner locating the application and therefore reduces the effectiveness of the protest.

Each time a protest is received, the CPO carries out a search to identify or to confirm (when the application(s) is/are identified by the protestor) the application(s) to which the protest applies. If the application(s) is/are found, the protest is made part of the file of the application and therefore when the file is opened any action taken on the protest is also available. A notification that a protest has been received in the CPO will be sent to the applicant of any application against which a protest is made. The protestor will also be advised of the receipt of the protest in the CPO (the application number will not be Disclosed if this application is not already opened for public inspection). When the specific application cannot be located (e.g. when the application has not already been filed at the CPO or when there is not enough information in the protest to identify the application), the protest is classified in its most relevant class(es), unless the application is located before being brought to the examiner. The examiner keeps the protest for two years.

If the protestor wishes to submit further details or another protest, he/she is welcome to do so, but each time the protestor will only receive a notice of acknowledgment. The examiner will not discuss the prosecution of the application(s) with the protestor. The normal prosecution, including allowance of applications, continues despite the submission of a protest[1] unless sufficient grounds are presented to warrant action based on the protest.

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3 Pharmascience Inc. v. Commissioner of Patents *et al.* (1998), 85 C.P.R.. (3d) 59 (FCTD) at 66, aff'd 5 C.P.R. (4th) 428 (FCA)

18.03
AFFIDAVITS

Affidavits containing allegations not backed by dated documentation will usually not be sufficient reason for the Commissioner not to grant the patent. The affidavits may however contain information that could raise serious reasons as to why a patent should not be granted or lead to documentation that could be very pertinent. Someone who submits affidavits should support his/her allegations with dated material or give details to locate such material.

18.04
APPLYING PROTESTS OR FILING OF PRIOR ART

A protest or a filing of prior art is only considered by the patent examiner after the request for examination is received. Information in a protest or a filing of prior art is taken into account by the examiner, and if it provides sufficient grounds for objection, it will be cited. In the event that the application has previously been allowed by the examiner but has not yet been issued, the pertinence of the protest or of the filing of prior art will determine whether the notice of allowance will be withdrawn. If further action is required in view of the protest or of the filing of prior art, the application will be returned to the examiner. See chapter 13 for more information on notice of allowance and withdrawal thereof.

18.05
PROTESTS OR FILING OF PRIOR ART AND CONFIDENTIALITY

Any protest or filing of prior art will become part of the opened application file (available to the public), therefore, any protest or filing of prior art requesting confidentiality will be returned to the sender. Information supplied in such a confidential document will not be considered by the patent examiner.

CHAPTER 19

AMENDMENTS TO PATENT APPLICATIONS

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19.11 JURISPRUDENCE

CHAPTER 19
AMENDMENTS TO PATENT APPLICATIONS

19.01
SUBMISSION OF AMENDMENTS BY THE APPLICANT

Applicants may amend their applications either on their own initiative or in response to an examiner's requisition. The amendment must comprise new pages for any changes made in the amendment, and a supporting explanation as described in Sections 19.02 and 19.03, below.

19.02
FORM OF AMENDMENTS

Amendments to the application are made by inserting new pages in place of the pages altered by the amendments (section 34 of the Patent Rules). New pages must be supplied for all affected pages whether the changes are for adding or deleting matter. All pages altered by the amendment must meet the criteria of sections 68 to 70 of the Patent Rules, as well as section 73 with respect to the numbering of pages and section 85 with respect to the numbering of claims. It should be noted that while claims must be numbered consecutively in Arabic numerals, page numbers may take any form provided they are consecutive. Thus for example, the sequence 1, 2, 3, 3A, 4 would be acceptable for page numbers. For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, rules 133 and 135 apply to document quality.

Delayed amendments, meaning amendments requested to take effect at some time in the future, are not permitted by the Office.

19.03
SUPPORTING EXPLANATION

Under section 34 of the Patent Rules every amendment made to an application must be accompanied by a written statement explaining the nature of the amendment and its purpose.

If the amendment is in response to an examiner's requisition identifying defects in the application, the written statement must explain the manner in which the amendment overcomes the defect. If this statement is not provided, the CPO enters the amendment (except as indicated in 19.10 below) and the applicant is requisitioned by the examiner to provide the necessary information within a specified time limit. Where possible, the CPO indicates the type of information which, if it were supplied, would satisfy the requirements of section 34 of the Patent Rules.

The supporting explanation must also provide complete instructions for entering the amendment into the application (i.e., with respect to the cancellation, addition or replacement of pages). The amendment cannot be entered into the application file if the covering letter is vague or incomplete in its instructions. If the instructions for the amendment are confusing or incomplete the examination assistant will send an office letter to the applicant requesting clearer instructions within a specified time limit.

19.04
ENTRY OF NEW PAGES INTO THE APPLICATION FOLDER

Generally, when an amendment is received in the CPO, it is entered into the application file before its acceptability is determined by the examiner. New pages submitted by the applicant are substituted in place of the pages altered by the amendment. The covering letter with the supporting explanation for the amendment is attached to the file.

It should be noted that the entry of new pages into the application file does not denote acceptance of the amendment by the examiner.

19.05
CONSIDERATIONS FOR ACCEPTANCE BY THE OFFICE

To be accepted by the examiner, an amendment must meet certain criteria with respect to subject matter, completeness and intent (good faith response) as detailed in sections 19.06, 19.06.01 and 19.07 below. Depending on the type of amendment submitted, consideration by the Office may be immediate or deferred.

19.06
ACCEPTABLE SUBJECT MATTER

Section 38.2 of the Patent Act places on amendments to the specification or drawings the restriction that no new subject matter may be introduced. Only matter reasonably to be inferred from the specification and drawings as originally filed may be added to either the specification or drawings.

New matter pertaining to prior art with respect to the invention of the application may be added to the specification and the drawings. It must be acknowledged in the specification that the new matter is prior art.

19.06.01
Petitions

Concerning restrictions on amendments to petitions, reference should be made to chapter 4, section 4.01.01 of this Manual.

19.07
INCOMPLETE AND UNSATISFACTORY RESPONSES

Paragraph 73(1)(a) of the Patent Act provides for the abandonment of an application if the applicant does not reply in good faith to any requisition made by an examiner. An amendment that fails to address the defects in the application identified by the examiner will cause the application to be deemed abandoned (see chapter 20 on abandonment).

The CPO may consider that an applicant has failed to reply in good faith to an examiner's requisition if the applicant purposely attempts to mislead or to delay prosecution by:

(a) failing to deal with all the objections made by the examiner or failing to make satisfactory amendments to avoid those objections;

(b) reintroducing claims to subject matter previously removed to overcome objections made by the examiner;

(c) adding informal or other obviously objectionable claims; or

(d) failing to provide a response to a requisition for information under section 29 of the Patent Rules.

Under (a) above, a response does not have to present an amendment to overcome each identified defect but, if it does not, the response should specifically address each identified defect for which an amendment is not presented.

The procedures for the rejection of an amendment by the examiner are detailed in Section 19.10 below.

19.08
TYPES OF AMENDMENTS

Amendments may be submitted by the applicant either voluntarily or in response to an examiner's requisition. The procedures followed by the CPO also depend on the status of the application file, that is whether;

(i) an examination request has been made
(ii) the application has been filed through the PCT route
(iii) a notice of allowance has been issued
(iv) the final fee has been paid, or
(iv) a final action has been sent.

Subsections 19.08.01 through 19.08.08 describe the procedures and acceptance criteria for the different types of amendments that may be made to a patent application.

19.08.01
Voluntary Amendments Before Examination Request

Voluntary amendments may be made to a patent application before a request for examination has been submitted. Applicants should note that voluntary amendments made before an examination request has been submitted will not be considered with respect to acceptability by the examiner at that time. Consideration for acceptance is an examination procedure which will only be carried out after an examination request has been made. Such amendments will be opened to public inspection when the application is opened. Public disclosure of any new subject matter in a voluntary amendment will occur at the date of opening to public inspection of the application. This could preclude the applicant from filing a new application for that new subject matter at a later date.

The amendment must meet the criteria for subject matter and completeness as set forth in sections 19.02, 19.03 and 19.06, above, to be acceptable to the examiner.

19.08.02
Voluntary Amendments After Examination Request

Voluntary amendments that are filed after a request for examination has been submitted will be considered with respect to acceptability upon receipt. The amendment must meet the criteria for subject matter and completeness as set forth in sections 19.02, 19.03 and 19.06, above, to be acceptable to the examiner.

19.08.03
Amendments on PCT Applications

Amendments made to PCT applications during the international phase under Articles 19 and 34 of the Patent Cooperation Treaty form an integral part of the application at the time of entry into the national phase in Canada. The Canadian national phase application is then subject to the same amendment restrictions as all other Canadian patent applications. Further details on amending PCT applications are given in Chapter 22.

19.08.04
Amendments in Response to an Examiner's Requisition

All amendments received in response to an examiner's requisition will be considered with respect to admissibility upon receipt. The acceptance criteria of Sections 19.06 for subject matter and 19.07 for completeness and good faith response must be met for the amendment to be acceptable to the examiner.

19.08.05
Amendments in Response to a Final Action

Amendments received in response to a Final Action issued by an examiner are only accepted by the examiner if the rejection of the examiner is overcome either by amending to comply with the requirements as set forth by the examiner or by persuasive argument. For amendments in response to final actions which are not acceptable to the examiner, see section 21.08.

19.08.06
Amendments After Notice of Allowance

Subsection 30(1) of the Patent Rules specifies that: where an examiner, after examining an application, has reasonable grounds to believe that the application complies with the Act and the Rules, the Commissioner shall notify the applicant that the application has been found allowable and shall requisition the payment of the applicable final fee set out in paragraph 6(a) or (b) of Schedule II within the six-month period after the date of the notice.

Further, subsection 32(1) and (2) of the Patent Rules specify that: (1) except as otherwise provided by the Act or the Rules, after the applicant is sent a notice pursuant to subsection 30(1), no amendment, other than an amendment to correct a clerical error that is obvious on the face of the application, may be made to the application unless the fee set out in item 5 of Schedule II is paid and (2) except as otherwise provided by the Act or the Rules, after the applicant is sent a notice pursuant to subsection 30(1), no amendment may be made to the application that would necessitate a further search by the examiner in respect of the application or that would make the application not comply with the Act or the Rules.

An amendment after allowance that broadens the scope of the claims or changes the point of invention so that something additional or different is claimed, is refused where the change would necessitate further consideration of the art on record or a new search. This applies not only to changes to the claims, but also to additions to or deletions from

the description or drawings which have the effect of broadening the scope of the claims or shifting the point of invention (subsection 32(2) of the Patent Rules).

In addition, subsections 38.2(2) and (3) of the Patent Act must be satisfied. Only matter that is reasonably to be inferred from the specification as originally filed or shown in the drawings as originally filed may be entered into the description and drawings.

The examiner rules on the acceptability of each amendment after allowance and, subject to the approval of the Section Head, the amendment is either refused, or accepted and entered into the application file. Procedures for refusal of an amendment after allowance are discussed in Section 19.10.03 below.

A fee for considering an amendment after allowance is required (see subsection 32(1) of the Patent Rules and paragraph 5 of Schedule II of the Patent Rules). However, no fee is required for mere correction of obvious clerical errors and changes in titles.

Provided an amendment after allowance fee was paid with an original amendment after allowance which was refused, no further fee is required upon resubmission of the same amendment with further argument as to why the amendment should be accepted. If, however, in resubmitting the amendment, significant alterations are made, the new submission is treated as a separate amendment after allowance requiring its own fee.

19.08.07
Commissioner's Notice of Non-allowability

In the case where, after a notice of allowance has been sent to the applicant but prior to the patent being issued, the Commissioner has reasonable grounds to believe that the application does not comply with the Act or the Rules, the Commissioner notifies the applicant and returns the application to the examiner for further examination. The notice will indicate why the application was found to be not allowable. If the final fee has been paid, the Commissioner refunds it (subsection 30(7) of the Patent Rules). At this time, prosecution of the application continues and the application may be amended by the applicant.

19.08.08
Amendments After Failure to Pay Final Fee

If an applicant fails to pay the final fee within the six month period after the date of the notice of allowance, the application will be deemed abandoned (see paragraph 73(1)(f) of the Patent Act).

Subsequent to abandonment the applicant has 12 months during which the application may be reinstated by requesting reinstatement, paying the reinstatement fee and paying the final fee. Should the applicant wish to amend the application at this stage, the amendment request must be made at the time of reinstatement. The amendment will be considered with respect to acceptability upon receipt and the application is subject to examination. If the application is found to be allowable, it will go directly to issue as the final fee is already paid.

19.08.09
Amendment After Payment of Final Fees

Generally, applications may not be amended by the applicant after the final fee has been paid, although clerical errors may be corrected as provided by section 8 of the Patent Act.

19.08.10
Correction of Minor Errors

The CPO does not generally require correction of minor errors in the specification, such as obvious spelling errors, mispunctuation and letter inversions. If not corrected they will appear in the printed copy of the patent. However, if the examiner is identifying other defects, minor errors may be pointed out in a requisition. Errors that are in any way critical are objectionable, and must be corrected.

19.09
FURTHER EXAMINATION OF AMENDED APPLICATIONS

All applications that have been amended are subject to further examination. Any matter introduced by an amendment that is objectionable under the Patent Act or the Patent Rules will be objected to in an examiner's requisition. Amended applications are also subject to a further search of the prior art.

The above does not apply to amendments after the notice of allowance has been sent since amendments after allowance are refused on receipt if they are found to be unacceptable.

19.10
UNACCEPTABLE AMENDMENTS

Amendments to applications under examination will not be accepted in the following circumstances:

(A) The amendment introduces new subject matter into the specification or drawings which is not reasonably to be inferred from the specification and drawings as originally filed (subsections 38.2(2) and (3) of the Patent Act).

(B) The response to an examiner's requisition is not an attempt in good faith to advance the application to allowance and is therefore contrary to paragraph 73(1)(a) of the Patent Act.

(C) After the notice of allowance, if an amendment after allowance fee is required and has not been paid (subsection 32(1) of the Patent Rules), or if the amendment adds new matter (subsections 38.2(2) and (3) of the Patent Rules), requires a further search, or causes the application in any way to become unallowable (subsection 32(2) of the Patent Rules).

(D) After the final fee has been paid (section 33 of the Patent Rules), unless the application has been withdrawn from issue or has been reinstated after abandonment due to nonpayment of the final fee (subsection 73(4) of the Patent Act).

(E) After the expiry of the time for responding to a final action except where:

1. the rejection is withdrawn in accordance with subsection 30(5);

2. the Commissioner is satisfied after review that the rejection is not justified and the applicant has been so informed;

3. the Commissioner has informed the applicant that the amendment is necessary for compliance with the Act and Rules; or

4. by order of the Federal Court or the Supreme Court of Canada.

19.10.01
Procedure for Rejecting New Subject Matter

An amendment that introduces new subject matter that is contrary to subsections 38.2(2) and (3) of the Patent Act is not accepted. The examiner requisitions the applicant to remove the new subject matter from the application. The applicant is informed that the amendment is part of the application file and therefore has or will be open to public inspection with the application.

19.10.02
Procedure for Replies Not in Good Faith

When an examiner considers that a response to an action is not made in good faith, the amendment is not accepted. The examiner, at the expiry of the time limit for the response, refers the file and the applicant's response through the Patent Appeal Board for consideration by the Commissioner. The Board will contact the applicant forthwith to give the applicant the opportunity to present a written argument or to appear before the Board to explain why the response should be considered a good faith attempt to respond to the examiner's requisition. If the Commissioner agrees with the examiner, the application is deemed abandoned under paragraph 73(1)(a) of the Patent Act because of the applicant's failure to reply in good faith to the requisition within the required time. If the Commissioner comes to a decision contrary to the examiner's position, normal prosecution is resumed. The amendment may still not be accepted in that the Commissioner only resolves whether a good faith attempt was made by the applicant.

If a response is incomplete because information requisitioned under subsections 29(1) and (2) of the Patent Rules dealing with the provision of prior art or the first publication of a foreign patent is not supplied, and reasons for its absence are not given as required by subsection 29(3) of the Patent Rules, the examiner will normally issue another report requisitioning full compliance with the Rules. The applicant must then provide the information or state why it is not available.

19.10.03
Procedures for Unacceptable Amendments After Notice of Allowance

If the amendment after allowance fee is required but is not submitted with the amendment, the CPO will notify the applicant that the required fee must be submitted before the amendment can be considered.

When the examiner decides that an amendment after allowance is improper, the

applicant is so advised by the examiner by letter. The letter indicates to the applicant those parts of the amendment that are objectionable and those that are acceptable and requisitions the removal of the objectionable parts.

19.10.04
Procedure for Refusal of Amendment After the Final Fee is Paid

The CPO will notify the applicant that the application is scheduled to issue and cannot be amended.

19.11
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

Re: Application No. 100,575	36 CPR (2d)	283	1975
Re: Application No. 139,256	51 CPR (2d)	95	1977

CHAPTER 20

TIME LIMITS, WITHDRAWAL, ABANDONMENT AND LAPSE

20.01 SCOPE OF THIS CHAPTER
20.02 TIME LIMITS
- 20.02.01 Withdrawal of an Application
- 20.02.02 Request for Priority
- 20.02.03 Filing a Divisional Application
- 20.02.04 Completing the Application
- 20.02.05 Appointment of a Patent Agent
- 20.02.06 Deposits of Biological Materials
- 20.02.07 Request for Examination
- 20.02.08 Response to a Requisition of the Commissioner or an Examiner
- 20.02.09 Appeals to the Federal Court
- 20.02.10 Reinstatement of Abandoned Applications
- 20.02.11 Final Fee
- 20.02.12 Reissue
- 20.02.13 Maintenance Fees

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20.05 EXTENSIONS OF TIME
20.06 WITHDRAWAL OF AN APPLICATION BY APPLICANT
20.07 ABANDONMENT
20.08 REINSTATEMENT
20.09 LAPSED PATENT
20.10 JURISPRUDENCE

CHAPTER 20
TIME LIMITS, WITHDRAWAL, ABANDONMENT AND LAPSE

20.01
SCOPE OF THIS CHAPTER

This chapter outlines CPO policy respecting time limits, extensions of time, withdrawal of applications, abandonment of applications and the lapse of patents. The remedial procedures available to reinstate abandoned applications are also detailed.

20.02
TIME LIMITS

The following paragraphs give the time limits prescribed by the Patent Act or the Patent Rules regarding patent applications and patents.

20.02.01
Withdrawal of an Application

A patent application may be withdrawn at any time by written notice from the applicant or the authorized correspondent. An application which is withdrawn more than two months before the expiry of the confidentiality period will not be open to public inspection (subsection 10(5) of the Patent Act and section 92 of the Patent Rules). Applications withdrawn during the last two months of the confidentiality period will be laid open to public inspection unless there is time to stop the technical preparations to open the application to public inspection (Sections 92 and 146 of the Patent Rules).

Applications filed prior to October 1, 1989 may be withdrawn at any time by the applicant or the authorized correspondent and will never be opened to public inspection.

20.02.02
Request for Priority

For applications filed after October 1, 1996 a request for priority must be received by the office within four months of the filing date of the application (the subject application). The applicant must provide the Commissioner with the date and country of filing of each previously regularly filed application on which the request for priority is based, before the expiry of the four- month period after the filing date of the subject application and must also provide the Commissioner with the application number of each previously regularly filed application on which the request for priority is based, before the expiry of the later of the four-month period after the filing date of the subject application and the twelve-month period after the date of filing of the previously regularly filed application (section 88 of the Patent Rules).

For applications filed in the period beginning on October 1, 1989 and ending the day before October 1, 1996 a request for priority must be received by the office within six months of the filing date of the application(the subject application). The applicant must also provide the Commissioner with the date and country of filing and the application number of each previously regularly filed application on which the request for priority is based before the expiry of the six-month period after the filing date of the subject

application (section 142 of the Patent Rules).

The time limit for making a request for priority is not extendable in either of the two situations set forth above.

A request for priority may be withdrawn at any time before a patent is issued. If the applicant withdraws a request for priority before the expiry of the confidentiality period it may be possible to delay the laying open of the application to public inspection (subsection 10(4) of the Patent Act). The withdrawal must be made within sixteen months of the filing date of the priority application, or a later date if the technical preparations to open the application to public inspection can be stopped (sections 91 and 145 of the Patent Rules). The application will be laid open to public inspection at the end of the new confidentiality period (eighteen months from the Canadian filing or eighteen months from the earliest date of the next earliest previously regularly filed application on which a request for priority is based). See chapter 7 on priority for more information.

Applicants of applications filed prior to October 1, 1989 may request priority at any time.

20.02.03
Filing a Divisional Application

A divisional application must be filed before issue of the original application (parent application) according to Subsection 36(2) of the Patent Act. If the parent application becomes abandoned, the divisional application must be filed before the expiration of the time limit for reinstatement of the parent (Subsection 36(3) of the Patent Act).

Time limits for filing a divisional application are not extendable.

20.02.04
Completing the Application

Non-PCT applications filed on or after October 1, 1996, which do not meet the requirements of subsection 27(2) of the Patent Act at the date of filing, are deemed to be incomplete and the office will make every effort to inform the applicant of the reasons for noncompliance by means of a courtesy letter. The letter will specify a time limit prior to which the application can be completed free. The time limit will be a date fifteen months from the filing date, or from the date of the earliest previously regularly filed application on which a request for priority is based, if any. The purpose of not requiring a fee for completing an application during the above period is to encourage applicants to provide the CPO with electronically scannable pages for TECHSOURCE and to ensure that all documents listed in (a) to (i) in the previous paragraph arrive at the CPO in a timely manner for laying open to public inspection under section 10 of the Patent Act.

If at the expiration of a time period of fifteen months from the filing date, or the priority date, if any, the application is still not complete, a Commissioner's Notice will be sent under subsection 94(1) of the Patent Rules. The Notice will requisition the applicant to complete the application within a period ending the later of three months after the date of the notice and twelve months after the filing date of the application. Completing the application after the notice has been received will require the payment of the completion fee specified in Item 2 of Schedule II of the Patent Rules. Failure to complete the application or to pay the fee within the time period specified in the notice will result in

abandonment of the application.

Non-PCT applications filed before October 1, 1996, that are not complete at filing must meet the completion requirements of subsection 148(1) of the Patent Rules and pay the completion fee within twelve months of filing in order to avoid abandonment(see chapter 5 for more information on completion requirements).

Completion requirements and time limits for PCT applications depend on whether Canada was designated or designated and elected on the international application (sections 58 and 62 of the Patent Rules and Section 16 of the Canadian Patent Cooperation Treaty Regulations as they read immediately before October 1, 1996). Chapter 22 of this manual details all the requirements and time limits for PCT applications including national phase entry.

The time limits for completing an application are not extendable (subsections 62(3), 94(3),and 148(2) of the Patent Rules).

20.02.05
Appointment of a Patent Agent

Whenever a patent agent must be appointed pursuant to Section 23 of the Patent Rules, the CPO sends a notice to the applicant. A patent agent must be appointed within three months from the date of the notice. The three-month time limit may be extended under Section 26 of the Patent Rules.

20.02.06
Deposits of Biological Materials

Where the applicant wishes to supplement the description of the invention with a deposit of biological material under Section 38.1 of the Patent Act, the deposit must be made with an International Depositary Authority (IDA). For applications filed on or after October 1, 1996, the deposit with an IDA must be made on or before the Canadian filing date. The name of the IDA, the date of the deposit, and the accession number given by the IDA, if not already part of the description at the time of filing, must be provided before the application is open to public inspection under Section 10 of the Patent Act (Subsections 104(1) and (2) of the Patent Rules). For applications filed before October 1, 1996, the deposit must have been made on or before the filing date of the application either in an IDA or in some other depositary from which samples of the deposit can be obtained by the public. If the deposit was not made with an IDA, the applicant must deposit a sample with an IDA on or before October 1, 1997. Where an application filed before October 1, 1996 (or a patent which may have issued on the basis of such an application) does not already contain the following information, it must be provided on or before January 1, 1998, or before the expiry of the 18 months confidentiality period for the application, whichever is the later: the name of the IDA, the date of the original IDA deposit, the accession number given by the IDA, the name of any non-IDA depositary (if a deposit made before the filing date was not in an IDA) and the date of the deposit in the non-IDA depositary (Section 160 of the Patent Rules).

An applicant may file a notice with the Commissioner that a sample of a deposit referred to in an application be furnished only to an independent expert nominated by the Commissioner. This "expert solution" applies until either a patent has issued on the basis

of the application or until the application is withdrawn, refused or abandoned and no longer subject to reinstatement. For an application filed on or after October 1, 1996, a notice requesting that access be restricted must be filed before the application is open to public inspection. For an application filed before October 1, 1996, the notice must be filed on or before January 1, 1998, or before the expiry of the confidentiality period for the application, whichever is the later (subsections 104(4) and 160(4) of the Patent Rules).

The time limits for deposits are not extendable (subsections 104(5) and 160(5) of the Patent Rules).

For full details on deposits of biological materials, see Chapter 17 of this manual.

20.02.07
Request for Examination

For applications filed on or after October 1, 1996 an applicant must request examination and pay the prescribed fee pursuant to subsection 35(1) and paragraph 73(1)(d) of the Patent Act within five years of filing the application (subsection 96(1) of the Patent Rules). The time limit for requesting examination on a divisional application with a filing date (parent's filing date) on or after October 1, 1996 is either five years from the filing date of the parent or six months after the date on which the divisional application was actually filed, whichever date is later (subsection 96(2) of the Patent Rules).

For applications filed before October 1, 1996, an applicant must request examination and pay the fee within seven years of filing (subsection 150(1) of the Patent Rules). The time limit for requesting examination on a divisional application with a filing date (parent's filing date) before October 1, 1996 is seven years from the filing date of the parent or six months after the date on which the divisional application was actually filed, whichever date is later (subsection 150(2) of the Patent Rules).

The time limits for requesting examination set out above are not extendable (subsections 96(3) and 150(3) of the Patent Rules).

Where the Commissioner requires the applicant to make a request for examination under subsection 35(2) of the Patent Act, a notice will be sent specifying a three month time limit (sections 25, 97 or 151 of the Patent Rules). The time limit of that notice may be extended according to section 26 of the Patent Rules, but cannot extend beyond the five-year or seven-year time limit for requesting examination under section 96 or 150 of the Patent Rules.

20.02.08
Response to a Requisition of the Commissioner or an Examiner

Where the Commissioner makes a requisition of an applicant pursuant to section 25, section 97 or section 151 of the Patent Rules the time limit for a response is three months from the date of the notice. The three-month time limit may be extended under section 26 of the Patent Rules.

An examiner's requisition will specify a six month or shorter time limit (paragraph 73(1)(a) of the Patent Act and subsection 30(2) of the Patent Rules). The six-month time limit cannot be extended. A shorter time limit may be extended under section 26 of the Patent

Rules, but cannot be extended beyond six months.

20.02.09
Appeals to the Federal Court

An appeal of a Commissioner's Decision to the Federal Court must be taken within three months of the date of mailing of the Commissioner's Decision to the applicant (subsection 18(2) of the Patent Act). The time limit for appeal may be extended under section 27 of the Patent Rules.

Where an application has been refused by the Commissioner pursuant to section 40 of the Patent Act, an appeal to the Federal Court must be initiated within six months of the mailing of the Commissioner's Decision to the applicant (section 41 of the Patent Act). This time limit cannot be extended.

20.02.10
Reinstatement of Abandoned Applications

Applications which have become abandoned under subsections 73(1) or (2) of the Patent Act may be reinstated within the twelve-month period from the date of abandonment (sections 98 and 152 of the Patent Rules). Occasionally applications may become abandoned for more than one reason. Where an application is abandoned for more than one failure to act, the applicant must comply with section 98 or 152 of the Patent Rules for each failure to act within twelve months of the date the application was deemed to be abandoned for that failure (sections 98 and 152 of the Patent Rules).

The time limit for reinstatement may be extended under section 26 of the Patent Rules provided that the request for the extension of time is made before the period for reinstatement expires. If the applicant takes no action prior to the expiry of the twelve-month reinstatement period, the application cannot be reinstated. No retroactive extensions are available.

20.02.11
Final Fee

Where an applicant receives a notice of allowance, the time limit for the payment of the final fee is set out in the notice and shall be six months from the date of the notice (paragraph 73(1)(f) of the Patent Act and subsection 30(6) of the Patent Rules).

The time limit for payment of the final fee is not extendable.

20.02.12
Reissue

A patentee may apply for a reissue of a patent within four years from the issue of the original patent (subsection 47(1) of the Act). This time limit is not extendable.

20.02.13
Maintenance Fees

The maintenance fees due and the time limits for their payments for patent applications

are given in Item 30, Part VI of Schedule II of the Patent Rules (sections 99 and 154 of the Patent Rules).

Any or all of the maintenance fees for a particular application or a patent resulting from that application may be paid in advance.

The maintenance fees for divisional applications are due on the same dates as for the parent application. Where maintenance fees are owing at the time of filing a divisional application, all of the fees which would have been due had the divisional application been filed on the filing date of the parent application must be paid at the time of filing of the divisional to avoid immediate abandonment (subsections 99(3) and 154(3) of the Patent Rules).

Maintenance fees for patents depend on the filing date of the applications from which they issued. For patents issued on the basis of an application filed after October 1, 1989, the maintenance fees and time limits are set out in Item 31, Part VI of Schedule II of the Patent Rules (sections 100, 101, 155 and 156 of the Patent Rules). Maintenance fees and time limits for patents issued after October 1, 1989 on the basis of an application filed before October 1, 1989 are given in Item 32, Part VI of Schedule II of the Patent Rules (subsections 182(1) and (3) of the Patent Rules).

Time limits for payment of maintenance fees are not extendable.

20.03
TIME LIMITS EXPRESSED IN "MONTHS"

Applications become abandoned or reinstated if certain actions are taken or not taken within definite time limits usually expressed in a certain number of months. When a requisition is made for an action to be taken within a fixed number of months and the final month has no date the same as the date of the requisition, then the last day of such month is the date the action must be completed. Thus an examiner's requisition with a time limit of six months which is issued on August 29, 30, or 31 must be replied to by February 28 (or February 29 in leap years). Similarly a requisition issued on March 31 setting three months for reply requires a response by June 30.

20.04
TIME LIMITS EXPIRING ON A DIES NON

When the last day upon which an applicant or a patentee may act on an application or patent falls on a day when the CPO is closed for business the action may be taken on the next day the CPO is open (section 78 of the Patent Act). If the failure to act sets up new time limits (such as a reinstatement period), the new period starts to run from the extended date, rather than from the original date when the action was due. For example, if a notice of allowance is issued on June 25, 1996 the final fee is due on December 27, 1996 (the CPO being closed December 25 and 26). If the final fee is not paid on or before December 27, 1996 the application is deemed to be abandoned on December 27, 1996 and can be reinstated by requesting reinstatement and paying the appropriate fees on or before December 29, 1997 (December 27, 1997 being a Saturday).

The CPO is closed for business on all Saturdays and Sundays as well as on the following designated holidays or, if these designated holidays fall on a weekend, the first normal working day following the weekend:

New Year's Day
Good Friday
Easter Monday

Victoria Day
St-Jean Baptiste Day
Canada Day
Labour Day
Thanksgiving
Remembrance Day
Christmas Day
Boxing Day

It should be noted that the CPO is not closed on the 1st Monday in August.

20.05
EXTENSIONS OF TIME

The time limits discussed in Section 20.02, above, which are indicated as extendable may be extended by the Commissioner (subsection 26(1) and subsection 27(1) of the Patent Rules). **The applicant must apply for the extension of time before the expiry of original time limit** and pay the extension fee set out in Item 22, Part IV of Schedule II of the Patent Rules. Where the Commissioner is satisfied that the circumstances justify the extension, an extension will be granted, and the applicant notified by letter. The applicant will also receive an office letter if the extension of time is refused. While no affidavit is required, the Commissioner requires reasons why the applicant is unable to complete the required actions within the time period originally set. Unreasonable numbers of extensions or unreasonable lengths of extensions will not be granted by the Commissioner.

20.06
WITHDRAWAL OF AN APPLICATION BY APPLICANT

An application may be withdrawn at any time. If an application which has never been opened to public inspection is withdrawn more than two months before expiry of the confidentiality period, it will not be opened to public inspection (subsection 10(5) of the Patent Act and sections 92 and 146 of the Patent Rules). Where an application is withdrawn during the last two months of the confidentiality period, the application will be laid open to public inspection unless there is sufficient time to stop the technical preparations to open the application to public inspection. A request for withdrawal must be in writing. Any fee which has been paid prior to the date of withdrawal is not refundable except under subsections 4(3) and (4) of the Patent Rules. An application which is withdrawn after being opened to public inspection, will remain in the search files of the CPO.

20.07
ABANDONMENT

An application is deemed to be abandoned under section 73 of the Patent Act if the applicant does not

(a) reply in good faith to any requisition of an examiner within the time limit specified;
(b) complete the application and pay the completion fee within the time limit specified;
(c) pay the prescribed maintenance fees within the time limit specified;

(d) make a request for examination and pay the prescribed fee within the time limit specified;
(e) make a request for examination and pay the prescribed fee, when required to do so by the Commissioner, within the time limit specified;
(f) pay the final fee within the time limit specified; or
(g) comply with any requisition of the Commissioner within the time limit specified (section 25 of the Patent Rules).

The time limits (or extended time limits) specified for the above actions are given in Section 20.02 of this manual.

An application may become abandoned for more than one failure to act as above (e.g. an application may become abandoned for failure to respond to an examiner's requisition and also be deemed abandoned for failure to pay a maintenance fee at a later date during the abandoned period for failure to respond to the examiner's requisition).

A notice of abandonment will normally be sent by the Office when an application is deemed abandoned. However, although a notice of abandonment (notice that the patent is about to lapse) has been sent in a particular case, it should not be assumed that notice will be sent in every case. Such notices are sent as a courtesy only and the CPO takes no responsibility for failure to send a notice in a particular situation. If an application is abandoned for more than one failure to act, additional notices will be sent for each failure during the time period within which the applicant can reinstate the application.

20.08
REINSTATEMENT

Where an application becomes abandoned under subsection 73(1) or (2) of the Patent Act, the applicant may reinstate the application according to section 73(3) of the Patent Act and section 98 or 152 of the Patent Rules within twelve months of the date the application was deemed abandoned by;

i) making a request for reinstatement,
ii) taking the action that should have been taken in order to avoid the abandonment, and
iii) paying the fee set out in Item 7, Part I of Schedule II of the Patent Rules.

Where an application is abandoned for more than one failure to act, the applicant must take the above actions for each failure to act within twelve months of each failure (sections 98 and 152 of the Patent Rules).

For example, an application may become abandoned on two grounds if applicant fails to respond to an examiner's requisition within the six month time limit and also fails to pay a maintenance fee that falls due during the time when the application was abandoned; for that the application to be reinstated, the applicant must request reinstatement, respond to the examiner's requisition, submit the maintenance fee and submit two reinstatement fees within twelve months of the abandonment for failing to respond to the examiner's requisition. If the applicant attempts to reinstate without paying the maintenance fee and the second reinstatement fee, the application will remain abandoned (for failure to pay the maintenance fee) but the time limit for reinstatement will be extended to the end of the twelve-month period from the date the maintenance fee was due. If the period for reinstatement has expired before payment of the reinstatement fee or before a request

for an extension of the reinstatement period is made, the application can never be reinstated.

20.09
LAPSED PATENT

A lapsed patent is one which no longer confers any patent rights to the patentee because the appropriate maintenance fees have not been paid.

Maintenance fees for patents issued on the basis of applications filed after October 1, 1989 are payable for each one-year period between the second and twentieth anniversaries of the date of filing of the application in Canada (sections 100, 101, 155, and 156 of the Patent Rules and Item 31, Part VI of Schedule II of the Patent Rules).

Maintenance fees are due before the first day of each of the one-year periods they cover. For example, payment is due on or before the eleventh anniversary for the one-year period ending on the twelfth anniversary.

Any or all of the maintenance fees for a particular application or a patent resulting from that application may be paid in advance.

Late payment of the maintenance fees for patents are also accepted by the office if the payment is made within the one-year period the fee covers and the prescribed late payment fee is also paid. For example, the maintenance fee for the one-year period ending on the seventeenth anniversary of the filing date can be made, with the additional fee for late payment, on or before the seventeenth anniversary date.
The time limits for payment of maintenance fees for patents cannot be extended (sections 102 and 157 of the Patent Rules).

Maintenance fees for patents issued on or after October 1, 1989 on the basis of an application filed before October 1, 1989 are payable for each one-year period between the second and the seventeenth anniversaries of the date on which the patent was issued. Section 182 of the Patent Rules and Item 32, Part VI of Schedule II of the Patent Rules specify the maintenance fees payable and the dates on which the payments are due. Payments are due before the first day of the one-year period the fee covers, or on or before the last day of the one-year period the fee covers if the late payment fee is also paid.

Any or all of the maintenance fees for a particular application or a patent resulting from that application may be paid in advance.

The time limits specified in Part VI of Schedule II of the Patent Rules cannot be extended (section 182(7) of the Patent Rules).

A patent is deemed to have lapsed at the expiration of the time specified in Schedule II of the Patent Rules (subsection 46(2) of the Patent Act). **A lapsed patent cannot be revived.**

Notification of lapsed patents will be published in the Canadian Patent Office Record.

20.10
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

lapse

Zeneca v Canada	66 CPR (3d)	169	1996

CHAPTER 21

FINAL ACTION PRACTICE

21.01 INTRODUCTION
21.02 THE FINAL ACTION REPORT
21.03 SATISFACTORY RESPONSES
21.04 UNSATISFACTORY RESPONSES
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21.08 AMENDMENTS SUBSEQUENT TO A FINAL ACTION
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CHAPTER 21
FINAL ACTION PRACTICE

21.01
INTRODUCTION

When the prosecution of a patent application has progressed to the point where the examiner has reasonable grounds to believe that the application does not comply with the Act or the Rules in respect to one or more of the defects referred to in previous requisitions and that the applicant will not amend the application to comply with the Act and the Rules, the examiner may reject the application in a Final Action. Section 30 of the Patent Rules, as it appears in Part 1 of the Regulations defines the final action requirements and applies to all pending applications regardless of their filing date.

21.02
THE FINAL ACTION REPORT

A final action is issued under the provisions of subsection 30(4) of the Patent Rules and the action must bear the notation "Final Action" or "Décision Finale".

The report must indicate the outstanding defects and must requisition the applicant to amend the application in order to comply with the Act and the Rules or to provide arguments as to why the application does comply, within the six-month period after the requisition is made or within any shorter period established by the Commissioner in accordance with paragraph 73(1)(a) of the Patent Rules.

A final action is not written unless the examiner has made a previous requisition on the same grounds. If, in addition to the earlier objections, new objections on fresh grounds are being made, the action is not made final.

The report identifies which claims are allowable and indicates clearly what is objectionable in the application. If the rejection is based on prior art, the examiner will clearly indicate which claims are considered to lack novelty or are rendered obvious by the references cited in the action. The report deals with any differences between the claims and the teaching of the prior art and indicate why the invention claimed fails to show any advance of an inventive nature over the applied art and common general knowledge in the art.

If the rejection is based on any other contravention of the Patent Act or Rules, the report clearly identifies the sections of the Act and Rules which have been contravened and gives the reasons therefor.

The final action report must be comprehensive and deal with every grounds for which the application is considered to be defective. The appeal process is restricted to the particular issues discussed in the final action and there is no further opportunity for the examiner to make objections which may have been missed in the final action. Similarly there is no opportunity for the applicant to amend the application other then to make any revisions required by a Commissioner's decision on the patentability of the case.

All final actions are posted by registered mail.

21.03
SATISFACTORY RESPONSES

Where in accordance with subsection 30(4) of the Patent Rules the applicant amends the application or provides arguments and the examiner has reasonable grounds to believe that the application complies with the Patent Act and the Patent Rules, the Commissioner notifies the applicant that the rejection is withdrawn and that the application has been found allowable (subsection 30(5) of the Patent Rules).

21.04
UNSATISFACTORY RESPONSES

Where the rejection is not withdrawn pursuant to subsection 30(5) of the Patent Rules because the examiner is not satisfied that an amendment and/or argument submitted in the applicant's response is sufficient to overcome the rejection, the application is forwarded to the Patent Appeal Board (PAB) to be reviewed and the applicant is given the opportunity to be heard.

21.05
PATENT APPEAL BOARD

The Patent Appeal Board (PAB) consists of one or more senior members of the CPO who have not participated in the examination of the application under review. The Board reviews the grounds for rejection in final actions and holds hearings under section 30(6) of the Patent Rules when requested by applicants and advises the Commissioner on these matters.

21.06
REVIEW BY PAB

In any instance when the examiner decides that a response to a final action does not overcome the grounds of the action, in whole or in part, the application is forwarded to the PAB. The examiner prepares a summary of the reasons why the response does not overcome the rejection for the Board's consideration. The PAB informs the applicant that the application has been submitted for its consideration. The PAB advises the applicant that applicant may request a hearing to develop a fuller statement of the reasons for contending that the application is not open to objection on the grounds stated by the examiner. At this stage, the applicant is not entitled to submit further amendments to the application (section 31 of the Patent Rules) and must restrict any arguments to the issues raised in the final action and any amendment which was submitted to the examiner in response to that action. After reviewing the facts, the PAB presents its findings to the Commissioner.

21.07
COMMISSIONER'S DECISION

The Commissioner reviews the findings of the PAB and if satisfied that:

(a) there is no patentable subject matter in the application, will refuse the

application under section 40 of the Patent Act and will inform the applicant of the reasons therefor;

(b) the examiner's rejection was not justified, the application will be returned to the examiner for further prosecution (subsection 31(b) of the Patent Rules, or

(c) certain amendments are necessary for compliance with the Patent Act or the Patent Rules, the applicant will be informed of the required amendments and the reasons therefor and will be given a three month period to effect the changes. Should the applicant not amend the application accordingly it will be refused under section 40 of the Patent Act.

The Commissioner's decision will provide the reasons why he arrived at that particular decision and will justify his findings with respect to the Patent Act, Patent Rules and pertinent jurisprudence. Such decisions form Patent Office policy and provide precedence for the guidance of applicants and patent examiners. The original signed copy of the decision is sent by registered mail to the applicant or agent. A Commissioner's decision becomes part of the prosecution file and therefore is open to public inspection. Commissioner's decisions (CD), grouped according to the grounds of objection in the Final Action, are available in the CPO. A notice of every CD will be published in the POR along with a summary except for applications filed prior to October 1, 1989 that were subsequently refused by the Commissioner. Such CD's may be published with the permission of the applicant.

21.08
AMENDMENTS SUBSEQUENT TO A FINAL ACTION

A rejected application may not be amended after the expiry of the time for responding to the examiner's requisition made pursuant to subsection 30(4) of the Patent Rules except

(a) where the rejection is withdrawn in accordance with subsection 30(5) of the Patent Rules;

(b) where the Commissioner is satisfied after review that the rejection is not justified and the applicant has been so informed; or

(c) where the Commissioner has informed the applicant that the amendment is necessary for compliance with the Act or the Rules; or

(d) by order of the Federal Court or the Supreme Court of Canada.

In the case of (a) above, where the examiner withdraws the final action under subsection 30(5) of the Patent Rules, the normal prosecution resumes and the application is allowed by the examiner, the grounds for rejection having been overcome. Any further amendment of the application by the applicant must take the form of an amendment after allowance and is subject to the conditions set forth for such amendments in 19.08.06 of this Manual.

In the case of (b) above, where the Commissioner is satisfied that the rejection was not justified, the applicant is so notified and the application is returned to the examiner and normal prosecution resumes. The application is normally allowed at this stage but may be amended voluntarily by the applicant (subsection 31(b) of the Patent Rules).

In the case of (c) above, where the Commissioner has informed the applicant that an amendment of the application is necessary for compliance with the Patent Act or the Patent Rules, the applicant must make the amendment required by the Commissioner but no further amendment will be accepted (subsection 31(c) of the Patent Rules).

In the case of (d) above where the applicant has appealed a Commissioner's refusal of an application under section 40 of the Patent Act to the Federal Court or the Supreme Court of Canada, the application may be amended in accordance with the decisions of those Courts (subsection 31(d) of the Patent Rules).

21.09
APPEALS

If the Commissioner refuses an application under section 40 of the Patent Act, the applicant in accordance with section 41 of the Patent Act, may appeal the refusal to the Federal Court Trial Division. The Federal Court Trial Division may in turn, be appealed to the Federal Court of Appeal and, with leave, the Supreme Court of Canada.

Whenever an appeal to the Federal Court is lodged, the applicant must serve Notice of Appeal on the Commissioner. The original Notice is placed in the Patent Office file of the application. Since the Federal Court Trial Division's decision may be further appealed, no further action is taken in the CPO until it has been verified that the appeal process has been terminated.

21.10
PROSECUTION AFTER COURT PROCEEDINGS

The examiner takes action in accordance with the final judgment of the courts.

CHAPTER 22

PATENT COOPERATION TREATY (PCT)

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CHAPTER 22
PATENT COOPERATION TREATY (PCT)

22.01
GENERAL DESCRIPTION OF THE PCT

The PCT is a multilateral treaty among States, concluded in 1970 and entered into force on January 24, 1978. Canada became bound by the PCT on January 2, 1990.

The PCT establishes a system of international cooperation under which an applicant can initiate patent protection procedures in several countries by filing **one** "international application". The PCT is a patent filing procedure only and does not provide for the granting of patents. The granting of patents is the responsibility of the individual member countries (Contracting States).

Under PCT, Canadians seeking patent protection in several countries start by filing an international application, in a standardized format in either French or English, in the Canadian Patent Office (CPO). The filing of the international application has the same effect as a regular national filing in as many member countries as the applicant desires patent protection. The provisions of the Treaty permit the applicant to opt for Chapter I of the PCT which provides for filing, search and publication of the application, or for Chapter II of the PCT, which in addition to the provisions of Chapter I, includes the procedure for preliminary examination of the international application.

As of September 1, 1996, PCT has 87 Contracting States.

Further useful material is contained in the Treaty itself, in the Applicant's Guide, in the PCT Receiving Office Guidelines, PCT Search Guidelines and PCT Preliminary Examination Guidelines, and in the Administrative Instructions. These publications are available from the World Intellectual Property Organization and Micromedia Limited, or may be consulted in the CIPO library.

22.01.01
PCT Definitions

The following terms frequently used in the PCT text are defined as follows:

a) **Receiving Office** means the office where the nationals or residents of a PCT member country can file international applications. For Canadian nationals, applications may be filed with the Canadian Patent Office (CPO) or the International Bureau;

b) **International Bureau (IB)** means the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva;

c) **Contracting States** means the states party to the PCT which include almost every industrialized country of the world;

d) **Designated Office** means the national office designated by an applicant under Chapter I;

e) **Elected Office** means the national office elected by an applicant under Chapter II;

f) **International Searching Authority (ISA)** means the office whose tasks include the establishing of international search reports; and

g) **International Preliminary Examining Authority (IPEA)** means the office that carries out the preparation of the international preliminary examination reports under Chapter II.

22.02 USEFULNESS OF THE PCT FOR APPLICANTS

Under PCT, an applicant files a single application and designates a number of countries where protection is sought. The effect of filing an international application is equivalent to filing a separate application in each of the designated States. Additionally, the PCT provides for an international search report which is established for each international application. The search report provides the applicant with invaluable information on which to decide whether further prosecution is warranted and improves applicant's prospects of obtaining "strong" patents.

If an applicant decides to continue with the international application to obtain national (or regional) patents, he can wait until the end of the 20th month after the filing of the international application or, where that application claims the priority of an earlier application, until the end of the 20th month after the priority date, to commence the national procedure before each designated State. This delay provides the applicant more time to prepare translations and other required documentation for prosecution at the national stage.

The PCT optionally provides, at applicant's request, a preliminary examination report. If preliminary examination is requested, applicant may delay the national phase of patent prosecution until 30 months from priority date or international filing date.

22.03 THE INTERNATIONAL PHASE FOR PROCESSING AN INTERNATIONAL PATENT APPLICATION

(A) International Phase

i) **Filing of the international application:** The applicant files a single international application in a single language with a receiving Office. The applicant designates in the international application all those PCT Contracting States in which he wants to obtain protection for the invention and pays the prescribed fees to the receiving Office. That application has the effect of a regular national application in all designated states (PCT Contracting States) where protection is desired.

ii) **International search report:** After conducting a prior art search, the ISA must establish a search report before the expiry of 16 months from either the priority date of the international application, or the international filing date, if no priority is requested.

iii) **Publication of international applications:** The IB publishes the international

application, any amendments, and the search report on the "publishing Tuesday" (WIPO publishes applications on alternate Tuesdays) following the expiry of the 18-month period from either the priority date of the international application, or the international filing date, if no priority is requested.

iv) **International preliminary examination report:** The applicant has the option to demand an international preliminary examination under Chapter II of the Treaty which postpones the entry to the national phase before the elected offices up to the expiry of 30 months from either the priority date of the international application, or the international filing date, if no priority is requested. While the elected Offices are not bound to follow the conclusion of the IPEA, the report contains a good indication of the chances for obtaining the desired protection for the invention.

22.03.01
Processing by the Receiving Office

The receiving Office carries out the following functions:

a) receives the international application and the related fees and notifies the applicant of the receipt of the international application indicating the date of actual receipt and the international application number e.g. PCT/CA94/00001 (see PCT Rule 20.5(c)).

b) checks the international application to determine whether it meets the requirements prescribed by the PCT (Article 11 of the PCT and PCT Rule 11) as to form and content (the checks performed by the receiving Office are of a formal nature and do not go into the substance of the invention);

c) communicates with the applicant in order to obtain corrections where the international application does not meet certain requirements as to fees, form and content;

d) accords the international filing date, where possible;

e) transmits copies of the international application and other related documents to the ISA and to the IB.

22.03.02
Requirements to Obtain an International Filing Date

The receiving Office must accord as the "international filing date" the date of receipt of the international application provided that at the time of receipt:

a) at least one of the applicants is a resident or national of Canada;

b) the international application is in English or French (only one copy is necessary); and

c) the international application contains at least the following elements:
   (i) an indication that it is intended as an international application;
   (ii) the designation of at least one Contracting State;

(iii) the name of the applicant;
(iv) a part which appears to be a description; and
(v) a part which appears to be a claim or claims (Article 11(1) of PCT).

When an international application does not, at the time of receipt, fulfill the above requirements, the receiving Office invites the applicant to file the required correction and fixes a reasonable time limit. If the correction is made within the time limit, the date of receipt of the required correction becomes the international filing date.

When an application refers to drawings in the description but the drawings are not included, the receiving Office notifies the applicant. In this situation, the international filing date which will be accorded to the application is the date on which the missing drawings are received (Article 14(2) of PCT).

The filing of an international application has the effect of filing a regular national application in each designated State. For purposes of the Paris Convention, the effect of an international application is equivalent to that of a national filing. Priority rights, for example, may be based on an international application. (Article 11(4) of PCT).

22.03.03
Fees Associated with Filing an International Application

Three types of fees are payable to a receiving Office when an applicant files an international application:

1. TRANSMITTAL FEE (PCT Rule 14)
   This fee is retained by the receiving Office for receiving and checking the international application, and for transmitting copies of it to the IB and the ISA.

2. INTERNATIONAL FEES (PCT Rule 15)
   The international fee comprises the BASIC FEE and DESIGNATION FEES, and accrues to the IB for doing the central docketing and for publishing the international application. There is a supplementary charge for each page over 30 pages in the application. The designation fee is payable for each country designated. The maximum of designation fees payable is 11. (Schedule of fees for PCT)

3. SEARCH FEE (PCT Rule 16)
   This fee accrues to the ISA for carrying out the search and issuing an international search report.

All fees, with the exception of designation fees, should be paid when the international application is filed, but are payable within one month after filing in order to maintain the original filing date. Designation fees can be paid within one year of the priority date of the application, if this period expires later than one month after the international filing date (PCT rule 15.4).

The search and international fees which accrue to the ISA and IB respectively may change as exchange rates fluctuate. A schedule of fees applicable to the PCT is published from time to time in the CPOR.

22.03.04
Elements of an International Application

The structure of an international application is governed by the Treaty and particularly the Treaty Regulations. The CPO is bound by the PCT provisions and cannot require the correction of informalities not expressly provided for in the Treaty.

Under Article 3, the Treaty specifies that an international application must be in a prescribed language (PCT Rule 12), therefore international applications filed in Canada as a receiving Office must be prepared either in English or in French. The international application must also comply with the prescribed physical requirements (PCT Rule 11), unity of invention requirements (PCT Rule 13), and is also subject to prescribed **fees**.

The international application must contain a **request, a description, claim(s), drawing(s)** (when required) and an **abstract**.

22.03.05
Designation of Countries and its Effect (PCT Rule 4.9)

The Contracting States in which patent protection may be sought are listed in the Request form. The applicant makes a designation by simply marking the check box next to the appropriate contracting state. An applicant must designate at least one state in order to get a filing date. Designations can only be made when the application is filed; none can be added later. However, it is possible to make a precautionary designation covering all other states at the time of filing. This precautionary designation must be confirmed in writing before the expiration of 15 months from the earliest priority date, or where there is no priority date, from the international filing date. There is an extra fee associated with the confirmation.

In certain cases, several States can be designated as a group. For example, an applicant may designate countries which belong to the European Patent Convention by marking the check box next to "European Patent".

22.03.06
Processing by the International Bureau

The IB administers the Treaty. The main procedural steps that an international application goes through at the IB are the following:

a) the IB monitors and keeps the record copy of international applications and all papers filed by applicants;

b) the applicant may amend the claims of the international application under Article 19 by means of communications addressed to the IB;

c) the IB sends copies of the international application and associated documents to the designated states;

d) the IB publishes the international application and search report with a publication number which shall be different from the international application number (e.g. WO95/12345); and

e) where a demand for international preliminary examination is filed, the IB notifies the elected offices, transmits the international preliminary examination report to them and makes a translation of that report into English when required.

22.03.07
Amendment of Claims Before the International Bureau (Article 19)

After receiving the international search report (see 21.03.11), the applicant has the right under PCT Chapter I (Article 19 and PCT Rule 46) to amend the claims, and only the claims, once. The time limit for making an amendment is normally 2 months after the search report is transmitted to the applicant, but may be extended to 3 months if the report is transmitted before 14 months from the priority date. Any such amendment must be filed with the IB.

The amendments shall not go beyond the description in the international application as filed i.e. no new matter may be added. Amendments may be made either by cancelling one or more entire claims, by adding one or more new claims and/or by amending the text of one or more of the claims as filed. Where a claim is cancelled, no renumbering of the other claims is required.

If the applicant wishes to amend the claims by changing the existing claims or cancelling entire sheets of claims, applicant must supply replacement sheets and a letter drawing attention to the differences between the replaced sheets and the replacement sheets. The applicant may, at the same time, file a brief statement under Article 19 of the PCT, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

22.03.08
International Publication

The IB publishes the international application, any amendments, and the international search report in the form of a pamphlet (rule 48.1(a) of the PCT) as soon as possible after 18 months from the priority date of the application. However, an applicant may ask the IB to publish the international application earlier. When the international application is withdrawn by the applicant before the completion of the technical preparations for publication, the international publication can be prevented.

If the international search report and any amendment under Article 19 are not available at the time of publication, they are published separately after they have been received by the IB. The pamphlet is printed in one of the six following languages: English, French, German, Japanese, Russian or Spanish. The abstract, title and search report always appear in English.

22.03.09
Processing by the International Searching Authority (ISA)

Every international patent application is subjected to an international search by an ISA. The objective of the international search is to discover relevant prior art for the purpose of assessing novelty and inventive step.

The international standards are prescribed in the PCT for the minimum documentation to

be consulted. Qualified staff and search methods of the ISA must be such that a very high quality search is provided.

The ISA carries out the following functions:

a) conducts search of claimed inventions;

b) checks for unity of invention and requests additional fees if unity is lacking;

c) establishes the international search report;

d) establishes a title and an abstract if either is missing or is inadequate; and

e) transmits copies of the international search report to the IB and the applicant.

Canada has selected the European Patent Office (EPO) as its ISA. Articles 15 to 18 of the PCT and PCT Rules 25 and 33 to 45 concerns the competent ISA and its responsibilities.

22.03.10
Excluded subject matter and Unity of invention

An ISA is not required to search an international application if the subject matter of the claims constitutes a subject excluded as specified under PCT Rule 39. The excluded subject matter is:

a) scientific and mathematical theories;

b) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes;

c) schemes, rules or methods of doing business, performing purely mental acts or playing games;

d) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods;

e) mere presentations of information; and

f) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. The ISA is responsible for reviewing the claims for unity of invention (Article 17(3)(b) and PCT Rules 13 and 40). If the ISA finds unity of invention is lacking, it invites the applicant to pay additional fees. This request for additional fees produces one of the following three results:

a) The applicant willingly pays the additional fees and the ISA establishes a search report for all claims.

b) The applicant pays the additional fees under protest. A special ISA board will review the protest and this review can result in a total or partial reimbursement of the additional fee, or in a rejection of the protest. Depending on the outcome of the review, a search report will be established for the appropriate claims.

c) The applicant does not pay the additional fees. The ISA establishes a search report with respect to the main invention only.

22.03.11
International Search Report

The results of the international search are recorded in the international search report, which is transmitted to the applicant and to the IB for publication (Article 18 of the PCT). The international search report must be established within three months from the receipt of the search copy by the ISA or nine months from the priority date, whichever time limit expires later (rule 42 of the PCT). The international search report for international applications filed in Canada is established by the EPO in either English or French, depending upon the language used in the application.

The report identifies the application concerned by its number, the name of the applicant, the international filing date, the priority date (if any), the date of the report, the international patent classification, the fields searched, and the documents constituting the relevant prior art (rule 43 of the PCT).

The documents are cited against claims to which they are relevant. The report indicates subject matter not searched because of lack of unity of invention, and applicant's failure to pay additional search fees.

The report also contains a copy of any title or abstract that may have been either revised or established by the ISA.

The international search report is always translated into English unless it was originally established in English (rule 45 of the PCT).

22.03.12
Processing by the International Preliminary Examining Authority (IPEA)

International preliminary examination of an international application may be requested under Chapter II of the PCT to obtain a preliminary and non-binding opinion on the question of whether the claimed invention appears to be novel, to involve an inventive step, and to be industrially applicable.

An applicant who is a resident or national of a Contracting State bound by Chapter II of the Treaty may make a demand for international preliminary examination (rule 53 of the PCT). The demand must be submitted directly with the International Preliminary Examining Authority (IPEA). The demand must specify the "elected States" where applicant intends to use the results of the international preliminary examination. Contracting States may be elected at the time of the demand or at a later date (rule 56 of the PCT).

The IPEA carries out the following functions:

a) receives the demand for international preliminary examination;

b) receives both handling and preliminary examination fees;

c) checks the demand for informalities (conformance with rules 53, 54 and 55 of the PCT on format of the demand, applicant entitlement and language requirement) and verify the payment of fees;

d) sends the original copy of the demand, and handling fees to the IB.

e) examines the international application for sufficiency of description, unity of invention, support of claims by the original description, and for patentability of claims in accordance with PCT criteria;

f) issues written opinions to which the applicant may respond with amendments or arguments;

g) prepares the preliminary examination report; and

h) transmits the report to the IB and the applicant.

Canada has selected the EPO as its IPEA. Articles 31 to 42 and Rules 53 to 78 of the PCT concern the IPEA and its responsibilities.

22.03.13
Fees Associated with International Examination

There are two kinds of fees which have to be paid in connection with a demand for an international preliminary examination:

1. THE PRELIMINARY EXAMINATION FEE
   This fee accrues to the IPEA, mainly for carrying out the international preliminary examination and for establishing the report.

2. THE HANDLING FEE
   This fee accrues to the IB for carrying out various tasks.

22.03.14
Amendments Before the IPEA (Article 34)

Any applicant contemplating making a demand for preliminary examination may choose not to amend the claims after receiving the international search report under the provisions of Article 19 of the PCT. The applicant may rather choose to wait and either submit amendments to the IPEA together with the demand, or amend the application after receiving the first written opinion from the IPEA. At this stage, the applicant may amend not only the claims, but other parts of the application as well (Article 34 and Rule 66 of the PCT). The amendments may not go beyond the description of the international application as filed i.e. no new matter may be added.

The applicant may have several opportunities to amend the international application during the preliminary examination process, depending on the time available. The limiting factor is the PCT requirement that the IPEA complete the international preliminary examination report before the expiry of 28 months from the priority date, or 28 months from the international filing date, *if there is no priority date.*

Amendments are made by providing replacement sheets, accompanied by a letter of explanation. The amendment and letter must be in the language in which the international application was filed (rule 66 of the PCT).

22.03.15
Excluded subject matter and Unity of Invention

Claims relating to inventions in respect of which no international search report has been established, because the claims relate to excluded subject matter or do not meet the requirements for unity of invention, will not be the subject of international preliminary examination. This will be indicated in any written opinion as well as the international preliminary examination report.

When the IPEA considers that the international application does not comply with the requirements of unity of invention (Article 34(3) and Rule 68 of the PCT), it may choose between two courses of action: 1) it may carry out the international preliminary examination on the entire international application and express its views on the lack of unity of invention in the report, or 2) it may invite the applicant to restrict the claims so as to comply with the requirement or pay additional fees. The request for additional fees produces one of the following four results:

a) The applicant restricts the claims as required, in which case the examination is carried out on the claims as restricted;

b) The applicant willingly pays the additional fees and the international examination is carried out on the claims for the main invention and on the claims in respect of which additional fees have been paid (rule 68.2 of the PCT);

c) The applicant pays the additional fees under protest; in this case, a special IPEA Board will review the protest. This review can result in a total or partial reimbursement of the additional fees, or in a rejection of the protest. Depending on the outcome of the review, an examination report will be established for the appropriate claims (rule 68.3 of the PCT);

d) The applicant neither restricts the claims nor pays additional fees, in which case, the examination is carried out on the main invention as identified by the IPEA or the applicant (article 34(C) of the PCT).

22.03.16
International Preliminary Examination Report

The international preliminary examination report must be established within 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date; otherwise, the time limit is nine months from the start of the international preliminary examination.

The international preliminary examination report is a non binding-opinion on the patentability of the claims. Under PCT rule 70, the international preliminary examination report includes:

a) identification of the IPEA *and the applicant*;

b) the applicable dates;

c) the basis of the report;

d) a simple yes or no statement with respect to each claim indicating whether the claims are thought to satisfy the criteria of patentability (novelty, inventive step and industrial applicability) and including an explanation and citation of references to support the conclusion contained in the statement;

e) the citation of certain published documents comprising applications or patents published after the international filing date but filed prior to the international filing date (prior art effect);

f) mention of certain defects under article 34(4) and rule 66.2 of the PCT;

g) remarks concerning unity of invention; and

h) an annex of any amendments filed during the examination process.

The report will express no opinion as to whether the claims are patentable under the national law of any elected country.

22.04
THE NATIONAL PHASE FOR PROCESSING AN INTERNATIONAL APPLICATION

On completion of the international phase, further action is required in order to obtain patent protection in the various countries designated in the international application at the time of filing. The applicant has to enter the **"national phase"**, that is, commence patent granting procedures in each designated or elected country according to the laws, rules and jurisprudence thereof.

22.04.01
Entry into the National Phase

In order to obtain patent protection in the various countries designated in the international application at the time of filing, the applicant has to enter the national phase, that is, commence patent granting procedures in each designated country and pay the prescribed national fees.

Applicants must comply with the terms of the PCT and the regulations under the PCT as well as Part II of the Canadian Rules respecting the Patent Act.

Part II of the Canadian rules respecting the Patent Act provides a connection between the Patent Cooperation Treaty and the Canadian Patent Act. It covers such items as time limits, language of applications, fees and terms and conditions relating to the national phase.

The effective filing date of a PCT national phase application is the international filing date, and not the date on which the PCT application enters the national phase in Canada.

To enter the national phase in Canada, an applicant must take steps to do so within 20 months from the priority date of the international application, or 20 months from the international filing date if no priority is claimed (paragraph 58(3)(a) of the Patent Rules).

However, if the applicant requests international preliminary examination before the expiration of 19 months from the priority date, and elects Canada as one of the countries in which the preliminary examination report is to be used, initiation of the national phase in Canada may be delayed up to 30 months from the priority date, or 30 months from the international filing date if there is no priority date (paragraph 58(3)(b) of the Patent Rules).

When an international application becomes a PCT national application, the application shall thereafter be deemed to be an application filed in Canada and the Patent Act and the Patent Rules shall thereafter apply in respect of that application (section 59 of the Patent Rules).

For the purposes of a citation under section 28.2(1)(c) and (d) of the Patent Act in the prosecution of another application, a PCT application will benefit from its filing date or priority date only after it has entered the national phase.

Under section 61 of the Patent Rules, the requirement that an application contain a petition does not apply to PCT national phase applications. The first page of the pamphlet published by the IB includes all the required information to enter the national phase.

22.04.02
Content of PCT National Phase Application Entering under Chapter I

When an international application becomes a PCT national phase application by entering the national phase in Canada under Chapter I of PCT, the CPO creates an examiner's file comprising:

a) a copy of the applicant's international application as communicated to the CPO by the IB;

b) a copy of the international search report or, alternatively, a statement by the ISA that no search report will be established (Article 17(2)(a) of the PCT); and

c) a copy of any amendment to the claims, and any statement made by the applicant under PCT Article 19 in light of the international search.

If the international application was published by the IB in a language other than English or French, the examiner's file must include the translation into either French or English which should have been provided by the applicant upon entering the national phase in Canada. The translation must correspond to the international application as filed or amended during the international phase. The translation of the amendments submitted during the international phase can be filed separately or incorporated in the translation of the Canadian application.

If the Commissioner has reasonable grounds to believe that the translation is not accurate, the Commissioner shall requisition the applicant to provide a statement by the translator to the effect that, to the best of the translator's knowledge, the translation is complete and faithful (subsection 58(4) of the Patent Rules).

22.04.03
Content of PCT National Phase Application Entering under Chapter II

When an international application becomes a PCT national phase application by entering the national phase in Canada under Chapter II of the PCT, the examiner's file in addition to the content under Chapter 1 should include the following:

d) a copy of the international preliminary examination report; and

e) a copy of replacement sheets containing amendments, if any.

All of the above items must be presented in either French or English.

Furthermore, if the applicant enters the national phase in Canada more than two years after the Canadian filing date, the applicant must also pay the first maintenance fee at the time of entry (subsection 58(2) of the Patent Rules).

22.04.04
Other Amendments Provided on or after National Entry

Under the terms of PCT, the applicant may amend the description, the claims and the drawings before national entry into any designated or elected Office (Articles 19 and 41 of the PCT).

However, once a PCT application enters the national phase in Canada, it is treated in exactly the same manner as any other application filed in Canada. Therefore, when a PCT national phase application includes voluntary amendments on entering the national phase which were not considered during the international phase, it must be accompanied by a written statement under section 34 of the Patent Rules. Moreover, voluntary amendments that are filed after the national entry on a PCT national phase application, must be accompanied by a written statement explaining the nature of the amendment and its purpose.

22.04.05
Late Entry into the National Phase

Under subsection 58(3) of the Patent Rules, where an applicant fails to enter the national phase within 20 months after the priority date, but pays the additional fee for late payment (set out in Schedule II, item 11 of the Patent Rules), and the required maintenance fee he may enter the national phase (under Chapter I) up to 32 months after the priority date. Where Canada is elected before the expiration of the 19th month, and the applicant fails to enter the national phase 30 months after the priority date, but pays the additional fee for late payment and the required maintenance fee (set out in Schedule II, item 11 of the Patent Rules), he may enter the national phase (under Chapter II) up to 42 months after the priority date.

22.04.06
Completion Requirements in the National Phase

An application which has entered the national phase in Canada according to the provisions of subsection 58(1) or (2) of the Patent Rules may still be incomplete. To provide a complete application section 62(1) of the Patent Rules specifies the following documents and information that must be provided to avoid abandonment under section 73(2) of the Patent Act:

a) the name and address of the inventor where that information has not already been provided;

b) a sequence listing, where required by paragraph 111(a) of the Patent Rules;

c) a copy of a sequence listing in computer readable form complying with section 131, where required by paragraph 111(b) of the Patent Rules;

d) an appointment of a patent agent, where required by section 20 of the Patent Rules;

e) an appointment of an associate patent agent, where required by section 21 of the Patent Rules; and

f) an appointment of a representative, where required by section 29 of the Patent Act.

The time by which the information and documents referred to in subsection 62(1) of the Patent Rules must be submitted is the expiry of the latest of

a) the 26-month period after the priority date;

b) where the election of Canada has been made before the expiry of the nineteenth month after the priority date, the 36-month period after the priority date; and

c) the six-month period after the applicant complies with the requirements of subsection 58(1) and, where applicable, subsection 58(2) of the Patent Rules.

No extension of the time limits given in paragraphs a), b) and c) above is permitted (subsection 62(3) of the Patent Rules).

The Commissioner may, at the request of the applicant, reinstate the international application which is deemed to have been abandoned if, within 12 months after the date on which it was deemed to have been abandoned, the applicant complies with the above requirements and pays the reinstatement fee (section 98(1) of the Patent Rules).

22.05
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

Celltech v Comm of Pat	55 CPR (3d)	59	1994
	46 CPR (3d)	424	1993

CHAPTER 23

AMENDMENTS TO PATENTS

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CHAPTER 23
AMENDMENTS TO PATENTS

23.00
CONTENTS OF CHAPTER

This chapter deals with the various statutory methods in which an issued patent may be amended. The topics covered include disclaimer 23.01, re-examination 23.02 to 23.02.10, reissue 23.03 to 23.03.14 and section 8 corrections 23.04.

23.01
DISCLAIMER

Disclaimer is a mechanism whereby a patentee may amend a patent to claim less than that which was claimed in the original patent.

Subsection 48(1) of the Patent Act provides the right for a patentee to disclaim anything included in the patent by mistake at any time during the term of the patent. Whenever a specification is too broad by claiming more than the inventor invented or claims subject matter to which the patentee had no lawful right, the patentee on payment of a prescribed fee may disclaim such parts as the patentee does not claim to hold by virtue of the patent (paragraph 48(1)(b) of the Patent Act and Schedule 2 Part 3 Item 13 of the Patent Rules). A disclaimer cannot be used to broaden the claims of a patent.

A disclaimer must follow the form and instructions for its completion set out in Form 2 of Schedule I of the Patent Rules to the extent applicable (section 44 of the Patent Rules). In completing Form 2, the patentee must follow the precise form of paragraphs 3(1) and 3(2) which specify the subject matter disclaimed.

Disclaimers do not normally affect any court action pending at the time they are made (subsection 48(3) of the Patent Act).

Following a disclaimer, the remaining claims are deemed to be valid for the matter not disclaimed (subsection 48(5) of the Patent Act).

23.02
RE-EXAMINATION

This section describes the practice that is followed when a request for re-examination of a patent is submitted.

23.02.01
Request

Any person including the patentee, may request re-examination of any claim or claims of a patent issued after October 1, 1989 at any time during the life of the patent on the basis of prior art only. The prior art shall consist of patents, applications for patents open to pubic inspection and printed publications only (subsection 48.1(1) of the Patent Act). The request, including copies of the prior art, must be provided in duplicate if the requester is not the patentee (section 45 of the Patent Rules). One copy is for a re-examination board

and the other copy is for the patentee. The requester must set forth the pertinency of the prior art and the manner of applying it to the claim(s) for which re-examination is requested. The request must be in writing and be accompanied by the prescribed fee.

23.02.02
Notification Procedure

Upon receipt of a request satisfactorily identifying the art, and the manner of applying it and the fee, the Commissioner will appoint a re-examination board (RXB) and will send a package which includes a copy of the request including the prior art and the composition of the re-examination board, to the patentee, unless the patentee is the requester, in which case only the composition of the RXB is sent (sections 48.1(3) and 48.2(1) of the patent Act).

23.02.03
Unacceptable Request

If the request does not fulfil all of the requirements of subsections 48.1(1) and (2) of the Patent Act and section 45 of the Patent Rules, the requester will be so notified. The notification letter will detail the reasons why the request is not acceptable. An example of an unacceptable request is one which does not detail the pertinency of the prior art against the claim or claims that are to be re-examined. The requester will be informed by the Commissioner that no further steps will be undertaken until the above requirements have been fulfilled.

Any unacceptable requests may be re-submitted in acceptable form without the payment of a further fee.

23.02.04
Completed Request

The completed request will become part of an initial re-examination CPO file which will consist of:

(a) the CPO file copy of the patent including the description, claim(s), drawings as issued and all prosecution correspondence,

(b) a copy of the request,

(c) copies of the prior art being relied on, and

(d) reasons supporting the request for re-examination.

This file is open to public inspection.

23.02.05
Re-examination Board

The Commissioner will establish a re-examination board which will normally be composed of three persons from the CPO. Within three months following its establishment, the re-examination board shall determine whether there are sufficient grounds for re-examination. Re-examination will be commenced only if the art submitted raises a substantial new question of patentability (subsection 48.2(2) of the Patent Act).

23.02.06
Refusal of Re-examination

If the board determines that re-examination should not proceed because a substantial new question of patentability of a claim of the patent concerned is not raised, the requester shall be so informed. The determination not to proceed is final and is not subject to appeal, either to the Commissioner or to the Courts (subsection 48.2(3) of the Patent Act).

23.02.07
Re-examination

The re-examination board, having decided to proceed with re-examination, shall notify the patentee and give the reasons therefor. Within three months of the date of the notice the patentee may make submissions on the question of the patentability of claim(s). Re-examination will commence upon receipt of the reply or, in the absence of a reply, within three months of the date of the notice. In either case re-examination shall be completed within 12 months of the commencement of re-examination (subsections 48.3(1), (2), and (3) of the Patent Act).

The re-examination board will not consider any matter except the claims in question in view of the supplied prior art. Further, the re-examination board will not make any changes to the description part of a patent, in that there is no statuary authority for such changes. During the re-examination period, the patentee may propose amendments to the patent claims (including submission of new claims), but the scope of the claim(s) may not be broadened. Any number of separate proposals from the patentee during this period is permissible(subsection 48.3(2) of the Patent Act). The Commissioner will acknowledge the correspondence from the patentee but will not reply to the proposals.

23.02.08
Certificate of Re-examination

Upon conclusion of re-examination, a Certificate will be issued in accordance with paragraph 48.4(1)(a), (b) or (c) of the Patent Act and attached to the patent. This certificate will affect the original patent by:

a) canceling any claim of the patent determined to be unpatentable during the re-examination;

b) confirming any claim of the patent determined to be patentable; or

c) incorporating in the patent any proposed amended claim determined to be patentable.

The effect of a certificate issued in respect of a patent under subsection 48.4(3) of the patent Act is as follows:

i) cancels any claim but not all claims of the patent, the patent shall be deemed to have been issued, from the date of grant, in the corrected form;

ii) cancels all claims of the patent, the patent shall be deemed never to

have been issued; or

iii) amends any claim of the patent or incorporates a new claim in the patent, the amended claim or new claim shall be effective, from the date of the certificate, for the unexpired term of the patent.

However the deemed results of paragraphs i), ii) and iii) above do not take effect until the time for taking an appeal has expired under subsection 48.5(2) of the Patent Act and, if an appeal is taken, the above-mentioned deemed results apply only to the extent provided in the final judgement on the appeal (subsection 48.4(4) of the Patent Act).

The re-examination board will send a copy of the certificate to the patentee (subsection 48.4(2) of the Patent Act). The board may also send to the requester, copies of the correspondence to the patentee generated during the re-examination procedure. A summary of the certificate will appear in the Canadian Patent Office Record.

23.02.09
Termination of Re-examination

Upon completion of re-examination, the contents of the re-examination file created under 23.04.02 will be sent to the CPO Storage files. The CPO search file will include a copy of the patent as re-examined.

23.02.10
Appeal Period

The patentee receives a copy of the certificate by registered mail, and may appeal the decision of the re-examination board to the Federal Court within three months of the date of mailing of the certificate.

23.03
REISSUE

Reissue is a mechanism whereby a defective patent can be corrected. It may result in broader or more restricted protection depending on the nature of the correction.

Subsection 47(1) of the Patent Act confers on a patentee the right to apply within four years from the date of issue of a patent for the reissue of a patent that "is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more or less than he/she had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake without any fraudulent or deceptive intention". The reissued patent must be for the same invention as the original.

A reissue must be confined to that invention which was completely conceived and formulated by the inventor before the application for the original patent was filed, and to the invention which the patentee attempted to describe and claim in the original application but which, owing to error arising from inadvertence, accident or mistake, he/she failed to do perfectly. Further, whenever a reissue contains claims that are broader than the claims in the original patent, they must be directed to what the patentee was attempting to protect in the original patent.

23.03.01
Division of a Reissue Application

Under subsection 47(3) of the Patent Act an applicant may file separate applications for distinct parts of the invention covered by the original patent being reissued. Reissue applications must be filed in the CPO within four years from the date of issue of the original patent. The separate reissue applications must also all have been filed before the effective date of surrender of the original patent grant; i.e. before the grant of a reissue patent based on any one of them.

The Commissioner will not call for division of a reissue application under subsection 36(2.1) of the Patent Act nor will an applicant be permitted to use the provisions of subsection 36(2) of the Patent Act during the reissue process under section 47 of the Patent Act.

23.03.02
Reissue of a Reissued Patent

A reissued patent may itself be reissued provided the application to reissue is filed within four years of the date of the original patent (not of the reissue patent), and provided the invention is that for which patent protection was sought in the original patent. A reissue patent may not be withdrawn after it has been issued in favour of the original patent.

23.03.03
Reissue and New Matter

The patentee must not add new subject matter to the description that was not part of the original invention. Subject matter that is properly inferable from the original specification or drawings and that could have been entered under subsection 38.2(2) of the Patent Act may be accepted. Under subsection 38.2(3) of the Patent Act, drawings may be amended to add matter reasonably inferrable from the original specification or drawings, or from matter that is admitted to be prior art. New matter discovered after the date of the filing of the original application may not be added by reissue, as there was no attempt to protect such subject matter in the original patent.

23.03.04
Claims in Reissue Patent

Not only may an applicant claim less than what was claimed in the original patent, but he/she may also claim more. In both instances the following conditions must be complied with;

(a) The new claims must be directed to the same invention that the applicant attempted to protect in the original patent.
(b) There must not have been a complete failure to describe in the original patent the invention which is the subject matter of the new claims.

23.03.05
Reissue having Claims of a Different Category

A reissue of the patent may be allowed in order to permit claims of different categories (product, process, apparatus and use of product) to be added provided that the new claims are for the same invention as in the original patent and the subject matters defined by the claims are so linked as to form a single general inventive concept in accordance with section 36 of the Patent Rules.

23.03.06
Reasons Warranting Reissue

The fundamental questions to be put in deciding whether a reissue is in order are (a) whether a bona fide mistake had been made resulting in a failure to obtain protection for the invention actually made by the inventor, and (b) whether there had been a complete failure to describe that invention in the original specification, including description and drawings. The answer to the first must be "yes", and to the second "no". It must be apparent from the petition or supporting documents that the inventor had intended to protect the invention that he seeks to protect by reissue. It must not be apparent that he had not intended to protect that invention.

The following are some examples of situations where a reissue would be in order (assuming the other requirements for reissue are satisfied).

23.03.07
Failure to Claim the Invention

The original patent did not accurately put into words what had been the intention of the patentee to protect at the time of issue, because the patent agent had failed to comprehend and claim the invention properly (Curl-Master v. Atlas Brush; S.C. May 23, 1967).

23.03.08
Failure to Claim Broadly

The patentee wishes to claim a subcombination which had been claimed only as part of a combination, provided the subcombination cannot perform in an environment different from that of the combination claimed.

The patentee wishes to add claims supported by the original description and intermediate in scope between broad claims cancelled during prosecution of the original application in view of art cited by the examiner and the broadest claim of the patent granted on the original application.

23.03.09
Claiming Too Broadly

The patentee wishes to narrow the scope of the invention protected by amendment of the specification to delete matter the patentee had no right to claim. For instance, he may wish to narrow the scope of the claims because of art discovered after the patent issued.

23.03.10
Adding Narrower Claims

The patentee wishes to add claims of narrower scope than those in the original patent while still retaining the broad claims of the patent, provided intent to protect the invention of the narrower claims in the original patent can be shown. This is treated as a case of "insufficient specification", since "specification" includes both description and claims.

23.03.11
Insufficient Description

The patentee wishes to amend the description of an original patent in which the invention had been claimed but not adequately shown or described.

23.03.12
Unacceptable Reasons for Reissue

Reissue is not permitted:

(a) to add newly discovered matter;

(b) to reassert claims deliberately cancelled during the prosecution of the original patent in the face of an objection from the examiner, and with full knowledge of the relevant facts;

(c) to insert claims broader in scope than claims deliberately cancelled during the prosecution of the original patent because of an objection made by the examiner, and with full knowledge of the relevant facts;

(d) to insert claims of the same scope as the original claims, and which provide the same protection as was provided by the original claims;

(e) to reassert claims divided out because of a requirement for division made during the prosecution of the original patent where the patentee had full knowledge of the relevant facts;

(f) to correct misjoinder of inventors; misjoinder per se is not a reason to reissue an application, but misjoinder may be corrected when reissuing a patent on other acceptable grounds irrespective of when the misjoinder was discovered;

(g) to obtain an earlier claim date under section 28.1 of the Patent Act.

(h) to take advantage of intervening legislation or court judgements, for example the amended Patent Act;

(i) to change the claims because the patent is being circumvented by others, unless the applicant can show intent to protect in the original patent what is claimed in the reissue, but with the failure to do so being by reason of error arising from inadvertence, accident or mistake.

There may well be other reasons advanced for reissue which are not acceptable. An overall consideration is whether the applicant intended to protect subject matter but unintentionally failed to do so.

23.03.13
The Petition for Reissue

The petition must set out fully the defects in respect of which the patent is defective or inoperative and the facts as to how the errors arose (See Section 43 and Schedule I, Form I of the Patent Rules). The applicant must satisfy the Commissioner that there was an intent to protect in the original patent that which is claimed in the reissue; otherwise reissue is not permitted. If this is not obvious from the original petition, the examiner requires evidence to that effect. The applicant may not make amendments based on facts not set forth in the petition, nor add new facts to the petition for reissue.

Parts (3), (4) and (5) of Schedule I, Form I may not be amended after the petition for reissue is filed, other than to correct simple typographical errors obvious from the document itself. If additional evidence supporting the facts presented in the petition is submitted, it may be put on file but not added to the petition itself. If the facts presented in parts (3), (4) and (5) of the petition subsequently prove to be incorrect, the only way to make corrections is to file a completely new application for reissue (if time still permits), and to pay new filing fees. Section 47 of the Patent Act does not provide for amendments of the petition which significantly change the "defect(s)" and the reasons therefor after the statutory four year time limit has expired.

23.03.14
Examination for Reissue Applications

If the petition for reissue is not acceptable, the applicant will be informed by a Commissioner's letter which will provide the grounds for non-compliance with the Patent Act. The Commissioner's letter is written under subsection 47(1) of the Patent Act and will specify a three month time limit for response (section 25 of the Patent Rules).

If items 3 and 4 of the petition for reissue are not in accordance with subsection 47(1) of the Patent Act, no amendment may be made thereto. However, the applicant may argue that the petition for reissue is in compliance with the Patent Act or file a new petition along with a further reissue fee provided that the four-year time period is not passed.

If the applicant replies within the time provided, but the Commissioner after consultation with the PAB has reasonable grounds to believe that the petition for reissue still does not comply with the Patent Act, the Commissioner will refuse to issue a new patent and the original patent will be returned to the petitioner.

Reissue applications are subject to examination and are given priority of examination. Examination takes place without a request for examination or the payment of an examination fee.

If the petition for reissue is found to be acceptable but the amended specification does not comply with the Patent Act and Patent Rules, the Commissioner will requisition the petitioner to comply. If new prior art is discovered which could have been applied against the original application, it will be applied against the claims of the reissue application. A review of the prosecution of the original patent is necessary when examining a reissue application. The Commissioner's requisition will be given a three month time limit for response under section 25 of the Patent Rules and failure to respond will result in a refusal to grant a new patent.

No maintenance fees apply to a reissue application (subsections 99(1) and (2) of the Patent Rules). However, maintenance fees are payable on the reissue patent under the same conditions as the original patent (subsections 101(1) and (2) of the Patent Rules).

23.04
SECTION 8 CORRECTIONS

Clerical errors in any instrument of record in the CPO may be corrected with the permission of the Commissioner under the provisions of section 8 of the Patent Act. An applicant or patentee may, upon payment of the prescribed fee, request correction of any clerical error appearing in the instrument (Schedule II, Part IV, Item 19 of the Patent Rules). The Commissioner will review the request under section 8, and will inform the requester that the correction has been made. The CPO records will be corrected accordingly and in the case of a patent or other document which may be available through sources other than the CPO, those sources will be supplied with corrected documents.

It should be noted that no instrument of record in the CPO is exempt from correction under section 8 of the Patent Act.

23.05
JURISPRUDENCE

The following decisions of the courts are of importance in considering the subject matter of this chapter:

clerical errors

Bayer v Comm of Patents	53 CPR (2d)	70	1980

disclaimer

BVD Co V Canadian Celanese	SCR	441	1937
	DLR	289	1939
Trubenizing v John Forsyth	2 CPR	1	1943
International v Mi-Cor Meter	9 CPR	97	1948
Monsanto v Comm of Pat	18 CPR (2d)	170	1975
Copper & Beatty v Alpha	49 CPR (2d)	145	1980
Standal v Swecan	28 CPR (3d)	261	1989
ICN Pharmaceuticals v Canada	66 CPR (3d)	45	1996

reissue

Bergeon v De Kermor	Ex CR	181	1927
Northern Electric v Photo	Ex CR	75	1936
	SCR	649	1936
Fuzo Electric v Canadian General	SCR	371	1940
Short Milling v George Weston	ExCR	69	1941
O'Cedar v Mallory Hardware	ExCR	299	1956
Farbwerke V Comm of Patents	SCR	604	1966
Curl Master v Atlas Brush	SCR	514	1967
Burton Parsons v Hewlet	17 CPR (2d)	97	1976
	1 SCR	555	1976
Re: Westinghouse	63 CPR (2d)	153	1980
Re: Khallil	2 CPR (3d)	343	1983
Speery v John Deere	82 CPR (2d)	1	1984
Brady v Letraset	7 CPR (3d)	82	1985
Hoffman-La Roch v Apotex	15 CPR (3d)	217	1987
	24 CPR (3d)	289	1989
Cabot Corp v 318602 Ont	20 CPR (3d)	132	1988
Creations 2000 v Canper Ind	22 CPR (3d)	389	1988
Re: Wahpeton Canvas	31 CPR (3d)	434	1989
Re: Hewlett-Packard	31 CPR (3d)	463	1989
Flexi-Coil v F.P. Bourgault	31 CPR (3d)	529	1990
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
Molnlycke v Kimberly-Clarke	36 CPR (3d)	493	1991
Mobil Oil v Hercules	57 CPR (3d)	488	1994
	63 CPR (3d)	473	1995

CHAPTER 24

MAINTENANCE FEES

24.01 SCOPE OF THIS CHAPTER
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- 24.02.01 Due Dates for Application Maintenance Fees
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24.03 MAINTENANCE OF PATENTS
- 24.03.01 Due Dates for Patent Maintenance Fees
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24.04 PART VI OF SCHEDULE II OF THE PATENT RULES

CHAPTER 24
MAINTENANCE FEES

24.01
SCOPE OF THIS CHAPTER

This chapter outlines CPO policy respecting the fees to be paid to maintain patent applications and patents, and the procedures and time limits relating to the payment of maintenance fees.

24.02
MAINTENANCE OF PATENT APPLICATIONS

An applicant who files a patent application in Canada after October 1, 1989 must pay maintenance fees for prescribed periods in order to keep the application in effect (subsection 27.1(1) of the Patent Act).

Divisional applications carry their own maintenance fees, separate from the parent application.

Applications filed under the provisions of the Patent Cooperation Treaty and entering the national phase in Canada must pay maintenance fees in accordance with part VI of Schedule 2 of the Patent Rules. It should be noted that the international filing date is the date on which the maintenance fee Schedule is based.

Maintenance fees do not have to be paid on an application for reissue of a patent (subsections 99(2) and 154(2) of the Patent Rules). The applicant must continue to pay maintenance fees on the patent being reissued.

24.02.01
Due Dates for Application Maintenance Fees

In order to maintain a patent application in effect, an applicant must pay maintenance fees for each one-year period from the second anniversary of the filing date of the application. Whether or not the application issues to patent the maintenance fees will continue to be due on the same schedule until the last payment is made before the nineteenth anniversary, which covers the period from the nineteenth anniversary to the twentieth anniversary, which represents the full term of the patent. The time limit for paying each maintenance fee is given in Item 30, Part VI of Schedule II of the Patent Rules. Part VI of Schedule II of the Patent Rules is reproduced in this manual as section 24.04.

The maintenance fee for an application must be paid before the first day of the one-year period the fee covers. For example, the maintenance fee covering the one-year period ending on the fifth anniversary of the filing of the application must be paid on or before

the fourth anniversary of the filing date.

Any or all of the maintenance fees for a particular application or a patent may be paid in advance.

Time limits for payment of maintenance fees cannot be extended.

24.02.02
Responsibility for Payment of Maintenance Fees for Applications

Only the applicant or the authorized correspondent shall pay maintenance fees. The amounts are set forth in Item 30, Part VI of Schedule II of the Patent Rules. The authorized correspondent is responsible for ensuring the timely payment of maintenance fees. The CPO will send a reminder to the authorized correspondent that the payment of the first maintenance fee is approaching. This will be a one time notice mailed approximately three months in advance of the second anniversary of the application's filing date.

24.02.03
Non-payment of Application Maintenance Fees

Non-payment of maintenance fees will result in abandonment of the application under subsection 73(1) of the Patent Act. The authorized correspondent will normally be advised in a notice of abandonment that applicant's application is abandoned for failure to pay the maintenance fee by the due date. For details on the reinstatement procedure for abandoned applications (see section 20.08 of this manual).

24.03
MAINTENANCE OF PATENTS

Maintenance fees for patents issued on the basis of applications filed after October 1, 1989 are payable for each one year period between the second and twentieth anniversaries of the date of filing of the application in Canada.

Maintenance fees for patents issued on or after October 1, 1989 on the basis of an application filed before October 1, 1989 are payable for each one year period between the second and the seventeenth anniversaries of the date on which the patent was issued.

No maintenance fee for a patent is due for any period where a maintenance fee was paid to maintain the patent application in effect.

Maintenance fees for reissue patents are due at the same times and for the same periods as the original patent for the unexpired term of the original patent. No fee to maintain the rights accorded to a reissue patent is payable for any period where a maintenance fee was paid to maintain the original patent or to maintain the application for the original patent (section 101 of the Patent Rules).

24.03.01
Due Dates for Patent Maintenance Fees

Maintenance fees are due before the first day of each of the one-year periods they cover. For example, payment is due on or before the eleventh anniversary for the one year period ending on the twelfth anniversary. The time limits for maintenance fees for patents are given in Items 31 and 32 of Part VI of Schedule II of the Patent Rules, included as section 24.04 of this manual.

Late payment of the maintenance fees for patents are also accepted by the office if the payment is made within the one year period the fee covers and the prescribed late payment fee is also paid. For example, the maintenance fee for the one year period ending on the seventeenth anniversary of the filing date can be made, with the additional fee for late payment, on or before the seventeenth anniversary date.
Any or all of the maintenance fees for a particular application or a patent resulting from that application may be paid in advance.

The time limits for payment of maintenance fees for patents cannot be extended.

24.03.02
Responsibility for Payment of Maintenance Fees

The patentee is responsible for ensuring the timely payment of maintenance fees. The CPO will not send a reminder to the patentee that a date for the payment of a maintenance fee is approaching.

24.03.03
Non-payment of Patent Maintenance Fee

A patent is deemed to have lapsed at the expiration of the time specified in Part VI of Schedule II of the Patent Rules (subsection 46(2) of the Patent Act) for payment of maintenance fees. A lapsed patent cannot be revived. See also Chapter 20, section 20.09 on Lapsed Patent. If the maintenance fee on a patent is not paid on or before the anniversary date the CPO will normally inform the patentee that a late payment fee must be paid within one year following the anniversary or the patent will lapse.

24.04
PART VI OF SCHEDULE II OF THE PATENT RULES

PART VI

MAINTENANCE FEES

Item	Column I Description	Column II Fee
30.	For maintaining an application filed on or after October 1, 1989 in effect, under sections 99 and 154 of these Rules:	
	(*a*) payment on or before the second anniversary of the filing date of the application in respect of the one-year period ending on the third anniversary:	
	(i) small entity	$ 50.00
	(ii) large entity	100.00
	(*b*) payment on or before the third anniversary of the filing date of the application in respect of the one-year period ending on the fourth anniversary:	
	(i) small entity	50
	(ii) large entity	100
	(*c*) payment on or before the fourth anniversary of the filing date of the application in respect of the one-year period ending on the fifth anniversary:	
	(i) small entity	50
	(ii) large entity	100.00
	(*d*) payment on or before the fifth anniversary of the filing date of the application in respect of the one-year period ending on the sixth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*e*) payment on or before the sixth anniversary of the filing date of the application in respect of the one-year period ending on the seventh anniversary:	
	(i) small entity	75
	(ii) large entity	150.00

Item	Column I Description	Column II Fee
	(*f*) payment on or before the seventh anniversary of the filing date of the application in respect of the one-year period ending on the eighth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*g*) payment on or before the eighth anniversary of the filing date of the application in respect of the one-year period ending on the ninth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00

Item	Column I Description	Column II Fee
	(*h*) payment on or before the ninth anniversary of the filing date of the application in respect of the one-year period ending on the tenth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*i*) payment on or before the tenth anniversary of the filing date of the application in respect of the one-year period ending on the eleventh anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*j*) payment on or before the eleventh anniversary of the filing date of the application in respect of the one-year period ending on the twelfth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*k*) payment on or before the twelfth anniversary of the filing date of the application in respect of the one-year period ending on the thirteenth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*l*) payment on or before the thirteenth anniversary of the filing date of the application in respect of the one-year period ending on the fourteenth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*m*) payment on or before the fourteenth anniversary of the filing date of the application in respect of the one-year period ending on the fifteenth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00

Item	Column I Description	Column II Fee
	(*n*) payment on or before the fifteenth anniversary of the filing date of the application in respect of the one-year period ending on the sixteenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*o*) payment on or before the sixteenth anniversary of the filing date of the application in respect of the one-year period ending on the seventeenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*p*) payment on or before the seventeenth anniversary of the filing date of the application in respect of the one-year period ending on the eighteenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*q*) payment on or before the eighteenth anniversary of the filing date of the application in respect of the one-year period ending on the nineteenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*r*) payment on or before the nineteenth anniversary of the filing date of the application in respect of the one-year period ending on the twentieth anniversary.	
	(i) small entity	200.00
	(ii) large entity	400.00
31.	For maintaining the rights accorded by a patent issued on the basis of an application filed on or after October 1, 1989, under sections 100, 101, 155 and 156 of these Rules:	
	(*a*) in respect of the one-year period ending on the third anniversary of the filing date of the application:	
	(i) fee, if payment on or before the second anniversary	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment after the second anniversary but on or before the third anniversary:	

Item	Column I Description	Column II Fee
	(A) small entity	250.00
	(B) large entity	300.00
	(*b*) in respect of the one-year period ending on the fourth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the third anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment after the third anniversary but on or before the fourth anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*c*) in respect of the one-year period ending on the fifth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fourth anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment after the fourth anniversary but on or before the fifth anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*d*) in respect of the one-year period ending on the sixth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fifth anniversary:	
	(A) small entity	75
	(B) large entity	150.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the fifth anniversary but on or before the sixth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*e*) in respect of the one-year period ending on the seventh anniversary of the filing date of the application:	
	(i) fee, if payment on or before the sixth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment after the sixth anniversary but on or before the seventh anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*f*) in respect of the one-year period ending on the eighth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the seventh anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment after the seventh anniversary but on or before the eighth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*g*) in respect of the one-year period ending on the ninth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the eighth anniversary:	
	(A) small entity	75
	(B) large entity	150.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the eighth anniversary but on or before the ninth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*h*) in respect of the one-year period ending on the tenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the ninth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment after the ninth anniversary but on or before the tenth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*i*) in respect of the one-year period ending on the eleventh anniversary of the filing date of the application:	
	(i) fee, if payment on or before the tenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment after the tenth anniversary but on or before the eleventh anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*j*) in respect of the one-year period ending on the twelfth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the eleventh anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the eleventh anniversary but on or before the twelfth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*k*) in respect of the one-year period ending on the thirteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the twelfth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment after the twelfth anniversary but on or before the thirteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*l*) in respect of the one-year period ending on the fourteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the thirteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment after the thirteenth anniversary but on or before the fourteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*m*) in respect of the one-year period ending on the fifteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fourteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the fourteenth anniversary but on or before the fifteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*n*) in respect of the one-year period ending on the sixteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fifteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment after the fifteenth anniversary but on or before the sixteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*o*) in respect of the one-year period ending on the seventeenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the sixteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment after the sixteenth anniversary but on or before the seventeenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*p*) in respect of the one-year period ending on the eighteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the seventeenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the seventeenth anniversary but on or before the eighteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*q*) in respect of the one-year period ending on the nineteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the eighteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment after the eighteenth anniversary but on or before the nineteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*r*) in respect of the one-year period ending on the twentieth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the nineteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment after the nineteenth anniversary but on or before the twentieth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
32.	For maintaining the rights accorded by a patent issued on or after October 1, 1989 on the basis of an application filed before that date, under subsections 182(1) and (3) of these Rules:	
	(*a*) in respect of the one-year period ending on the third anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the second anniversary:	
	(A) small entity	$ 50.00
	(B) large entity	100.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the second anniversary but on or before the third anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*b*) in respect of the one-year period ending on the fourth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the third anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment after the third anniversary but on or before the fourth anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*c*) in respect of the one-year period ending on the fifth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fourth anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment after the fourth anniversary but on or before the fifth anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*d*) in respect of the one-year period ending on the sixth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fifth anniversary:	
	(A) small entity	75
	(B) large entity	150.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the fifth anniversary but on or before the sixth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*e*) in respect of the one-year period ending on the seventh anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the sixth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment after the sixth anniversary but on or before the seventh anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*f*) in respect of the one-year period ending on the eighth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the seventh anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment after the seventh anniversary but on or before the eighth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*g*) in respect of the one-year period ending on the ninth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the eighth anniversary:	
	(A) small entity	75
	(B) large entity	150.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the eighth anniversary but on or before the ninth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*h*) in respect of the one-year period ending on the tenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the ninth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment after the ninth anniversary but on or before the tenth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*i*) in respect of the one-year period ending on the eleventh anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the tenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment after the tenth anniversary but on or before the eleventh anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*j*) in respect of the one-year period ending on the twelfth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the eleventh anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the eleventh anniversary but on or before the twelfth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*k*) in respect of the one-year period ending on the thirteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the twelfth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment after the twelfth anniversary but on or before the thirteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*l*) in respect of the one-year period ending on the fourteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the thirteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment after the thirteenth anniversary but on or before the fourteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*m*) in respect of the one-year period ending on the fifteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fourteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment after the fourteenth anniversary but on or before the fifteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*n*) in respect of the one-year period ending on the sixteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fifteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment after the fifteenth anniversary but on or before the sixteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*o*) in respect of the one-year period ending on the seventeenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the sixteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment after the sixteenth anniversary but on or before the seventeenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00

CHAPTER 25

TARIFF OF FEES

25.01 INTRODUCTION

CHAPTER 25
TARIFF OF FEES

25.01
INTRODUCTION

This chapter sets forth the various fees to be collected by the CPO for services rendered to its clients. The general provision for the charging of fees for service is section 12(1)(e), (f) and (g) of the Patent Act and section 3 of the Patent Rules. The fees are specified in Schedule II (Section 3) of the patent Rules.

The fees are as follows:

SCHEDULE II

(*Section 3*)

TARIFF OF FEES

PART I

APPLICATIONS

Item	Column I Description	Column II Fee
1.	On filing an application under subsection 27(2) of the Act:	
	(*a*) small entity	$ 150.00
	(*b*) large entity	300
2.	On completing an application under subsection 94(1) or on avoiding a deemed abandonment under subsection 148(1) of these Rules:	200
3.	On requesting examination of an application under subsection 35(1) of the Act:	
	(*a*) small entity	200
	(*b*) large entity	400

Item	Column I Description	Column II Fee
4.	On requesting the advance of an application for examination under section 28 of these Rules	100.00
5.	On filing an amendment under subsection 32(1) of these Rules, after a notice is sent pursuant to subsection 30(1) or (5) of these Rules	200.00
6.	Final fee under subsection 30(1) or (5) of these Rules:	
	(*a*) for applications filed on or after October 1, 1989:	
	(i) basic fee	
	(A) small entity	150.00
	(B) large entity	300.00
	(ii) plus, for each page of specification and drawings in excess of 100 pages	4.00
	(*b*) for applications filed before October 1, 1989	
	(i) basic fee	
	(A) small entity	350.00
	(B) large entity	700.00
	(ii) plus, for each page of specification and drawings in excess of 100 pages	4
7.	On requesting reinstatement of an abandoned application	200.00
8.	On applying for restoration of a forfeited application under subsection 73(2) of the Act as it read immediately before October 1, 1989	200.00

PART II
INTERNATIONAL APPLICATIONS

Item	Column I Description	Column II Fee
9.	Transmittal fee under subsection 55(1) of these Rules	$ 200.00

Item	Column I Description	Column II Fee
10.	Basic national fee under paragraph 58(1)(*c*) of these Rules	
	(*a*) small entity	150.00
	(*b*) large entity	300.00
11.	Additional fee for late payment under subsection 58(3) of these Rules	200.00

PART III

PATENTS

Item	Column I Description	Column II Fee
12.	On filing an application to reissue a patent under section 47 of the Act	$ 800.00
13.	On making a disclaimer to a patent under section 48 of the Act, or of the Act as it read immediately before October 1, 1989	100.00
14.	On requesting re-examination of a claim or claims in a patent under subsection 48.1(1) of the Act:	
	(*a*) small entity	1,000.00
	(*b*) large entity	2,000.00
15.	On requesting registration of a judgment under section 62 of the Act, or of the Act as it read immediately before October 1, 1989	50
16.	On presenting an application to the Commissioner under subsection 65(1) of the Act:	
	(*a*) for the first patent to which the application relates	2,000.00
	(*b*) for each additional patent to which the application relates	250
17.	On requesting an advertisement of an application under subsection 65(1) of the Act in the *Canadian Patent Office Record* in accordance with subsection 68(2) of the Act	200
18.	On requesting publication in the *Canadian Patent Office Record* of a notice listing the patent numbers of patents available for licence or sale, other than at the time of issuance of the patent, for each patent number listed	20

PART IV

GENERAL

Item	Column I Description	Column II Fee
19.	On requesting correction of a clerical error under section 8 of the Act, or of the Act as it read immediately before October 1, 1989	$ 200.00
20.	On giving notice to the Commissioner of a new representative or a change in address, or on supplying a new and correct address, under subsection 29(3) of the Act, or of the Act as it read immediately after October 1, 1989	20
21.	On requesting registration of a document under section 49 or 50 of the Act, or of the Act as it read immediately before October 1, 1989, or under sections 37, 38, 39 or 42 of these Rules:	
	(*a*) for the first patent or application to which the document relates	100
	(*b*) for each additional patent or application to which the document relates	50
22.	On applying for an extension of time under section 26 or 27 of these Rules	200

PART V

INFORMATION AND COPIES

Item	Column I Description	Column II Fee
23.	On requesting information respecting a pending application under section 11 of the Act	$ 100.00
24.	On requesting information on whether a patent has issued, on the basis of an application filed in Canada and identified by a serial number	20
25.	On requesting a copy of a document, for each page	0.5

Item	Column I Description	Column II Fee
26.	On requesting a certified copy of a document	
	(*a*) for the certificate	35.00
	(*b*) for each page	0.5
27.	On requesting a copy of a Canadian patent identified by any of serial numbers 1 to 445,930	4
28.	On requesting a copy of an audio magnetic tape	50
29.	On requesting a transcript of an audio magnetic tape, for each page in the transcript	50

PART VI

MAINTENANCE FEES

Item	Column I Description	Column II Fee
30.	For maintaining an application filed on or after October 1, 1989 in effect, under sections 99 and 154 of these Rules:	
	(*a*) payment on or before the second anniversary of the filing date of the application in respect of the one-year period ending on the third anniversary:	
	(i) small entity	$ 50.00
	(ii) large entity	100.00
	(*b*) payment on or before the third anniversary of the filing date of the application in respect of the one-year period ending on the fourth anniversary:	
	(i) small entity	50
	(ii) large entity	100.00
	(*c*) payment on or before the fourth anniversary of the filing date of the application in respect of the one-year period ending on the fifth anniversary:	
	(i) small entity	50
	(ii) large entity	100.00

Item	Column I Description	Column II Fee
	(*d*) payment on or before the fifth anniversary of the filing date of the application in respect of the one-year period ending on the sixth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*e*) payment on or before the sixth anniversary of the filing date of the application in respect of the one-year period ending on the seventh anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*f*) payment on or before the seventh anniversary of the filing date of the application in respect of the one-year period ending on the eighth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*g*) payment on or before the eighth anniversary of the filing date of the application in respect of the one-year period ending on the ninth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*h*) payment on or before the ninth anniversary of the filing date of the application in respect of the one-year period ending on the tenth anniversary:	
	(i) small entity	75
	(ii) large entity	150.00
	(*i*) payment on or before the tenth anniversary of the filing date of the application in respect of the one-year period ending on the eleventh anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00

Item	Column I Description	Column II Fee
	(*j*) payment on or before the eleventh anniversary of the filing date of the application in respect of the one-year period ending on the twelfth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*k*) payment on or before the twelfth anniversary of the filing date of the application in respect of the one-year period ending on the thirteenth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*l*) payment on or before the thirteenth anniversary of the filing date of the application in respect of the one-year period ending on the fourteenth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*m*) payment on or before the fourteenth anniversary of the filing date of the application in respect of the one-year period ending on the fifteenth anniversary:	
	(i) small entity	100.00
	(ii) large entity	200.00
	(*n*) payment on or before the fifteenth anniversary of the filing date of the application in respect of the one-year period ending on the sixteenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*o*) payment on or before the sixteenth anniversary of the filing date of the application in respect of the one-year period ending on the seventeenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00

Item	Column I Description	Column II Fee
	(*p*) payment on or before the seventeenth anniversary of the filing date of the application in respect of the one-year period ending on the eighteenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*q*) payment on or before the eighteenth anniversary of the filing date of the application in respect of the one-year period ending on the nineteenth anniversary:	
	(i) small entity	200.00
	(ii) large entity	400.00
	(*r*) payment on or before the nineteenth anniversary of the filing date of the application in respect of the one-year period ending on the twentieth anniversary.	
	(i) small entity	200.00
	(ii) large entity	400.00
31.	For maintaining the rights accorded by a patent issued on the basis of an application filed on or after October 1, 1989, under sections 100, 101, 155 and 156 of these Rules:	
	(*a*) in respect of the one-year period ending on the third anniversary of the filing date of the application:	
	(i) fee, if payment on or before the second anniversary	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the second anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*b*) in respect of the one-year period ending on the fourth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the third anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the third anniversary:	

Item	Column I Description	Column II Fee
	(A) small entity	250.00
	(B) large entity	300.00
	(*c*) in respect of the one-year period ending on the fifth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fourth anniversary:	
	(A) small entity	50
	(B) large entity	100
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fourth anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*d*) in respect of the one-year period ending on the sixth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fifth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fifth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*e*) in respect of the one-year period ending on the seventh anniversary of the filing date of the application:	
	(i) fee, if payment on or before the sixth anniversary:	
	(A) small entity	75
	(B) large entity	150.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the sixth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*f*) in respect of the one-year period ending on the eighth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the seventh anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the seventh anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*g*) in respect of the one-year period ending on the ninth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the eighth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the eighth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*h*) in respect of the one-year period ending on the tenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the ninth anniversary:	
	(A) small entity	75
	(B) large entity	150.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the ninth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*i*) in respect of the one-year period ending on the eleventh anniversary of the filing date of the application:	
	(i) fee, if payment on or before the tenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the tenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*j*) in respect of the one-year period ending on the twelfth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the eleventh anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the eleventh anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*k*) in respect of the one-year period ending on the thirteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the twelfth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the twelfth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*l*) in respect of the one-year period ending on the fourteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the thirteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the thirteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*m*) in respect of the one-year period ending on the fifteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fourteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fourteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*n*) in respect of the one-year period ending on the sixteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the fifteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fifteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*o*) in respect of the one-year period ending on the seventeenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the sixteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the sixteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*p*) in respect of the one-year period ending on the eighteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the seventeenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the seventeenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*q*) in respect of the one-year period ending on the nineteenth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the eighteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00

Item	Column I Description	Column II Fee
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the eighteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*r*) in respect of the one-year period ending on the twentieth anniversary of the filing date of the application:	
	(i) fee, if payment on or before the nineteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the nineteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
32.	For maintaining the rights accorded by a patent issued on or after October 1, 1989 on the basis of an application filed before that date, under subsections 182(1) and (3) of these Rules:	
	(*a*) in respect of the one-year period ending on the third anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the second anniversary:	
	(A) small entity	$ 50.00
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the second anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00

Item	Column I Description	Column II Fee
	(*b*) in respect of the one-year period ending on the fourth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the third anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the third anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*c*) in respect of the one-year period ending on the fifth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fourth anniversary:	
	(A) small entity	50
	(B) large entity	100.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fourth anniversary:	
	(A) small entity	250.00
	(B) large entity	300.00
	(*d*) in respect of the one-year period ending on the sixth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fifth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fifth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00

Item	Column I Description	Column II Fee
	(*e*) in respect of the one-year period ending on the seventh anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the sixth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the sixth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*f*) in respect of the one-year period ending on the eighth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the seventh anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the seventh anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*g*) in respect of the one-year period ending on the ninth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the eighth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the eighth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00

Item	Column I Description	Column II Fee
	(*h*) in respect of the one-year period ending on the tenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the ninth anniversary:	
	(A) small entity	75
	(B) large entity	150.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the ninth anniversary:	
	(A) small entity	275.00
	(B) large entity	350.00
	(*i*) in respect of the one-year period ending on the eleventh anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the tenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the tenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*j*) in respect of the one-year period ending on the twelfth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the eleventh anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the eleventh anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00

Item	Column I Description	Column II Fee
	(*k*) in respect of the one-year period ending on the thirteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the twelfth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the twelfth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*l*) in respect of the one-year period ending on the fourteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the thirteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the thirteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00
	(*m*) in respect of the one-year period ending on the fifteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fourteenth anniversary:	
	(A) small entity	100.00
	(B) large entity	200.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fourteenth anniversary:	
	(A) small entity	300.00
	(B) large entity	400.00

Item	Column I Description	Column II Fee
	(*n*) in respect of the one-year period ending on the sixteenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the fifteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the fifteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600.00
	(*o*) in respect of the one-year period ending on the seventeenth anniversary of the date on which the patent was issued:	
	(i) fee, if payment on or before the sixteenth anniversary:	
	(A) small entity	200.00
	(B) large entity	400.00
	(ii) fee, including additional fee for late payment, if payment within the period of grace of one year following the sixteenth anniversary:	
	(A) small entity	400.00
	(B) large entity	600

PART VII

PATENT AGENTS

Item	Column I Description	Column II Fee
33.	On applying for entry on the register of patent agents under section 15 of these Rules	$ 100.00
34.	On notifying the Commissioner pursuant to subsection 14(2) of these Rules of a proposal to sit for the whole or any part of the qualifying examination	200.00
35.	For maintaining the name of a patent agent on the register of patent agents pursuant to paragraph 16(1)(*a*) of these Rules	300.00

Item	Column I Description	Column II Fee
36.	On applying to the Commissioner for reinstatement on the register of patent agents under section 17 of these Rules	200.00